

Chapter 1200

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1217 RES JUDICATA

1201 Ownership of Mark

Under Section 1(a)(1) of the Trademark Act, 15 U.S.C. §1051(a)(1), an application based on use in commerce must be filed by the owner of the mark. A §1(a) application must include a verified statement that the applicant believes it is the owner of the mark sought to be registered. 15 U.S.C. §1051(a)(3)(A); 37 C.F.R. §2.33(b)(1). An application that is not filed by the owner is void. *See* TMEP §1201.02(b).

An application under §1(b) or §44 of the Act, 15 U.S.C. §1051(b) or §1126, must be filed by a party who is entitled to use the mark in commerce, and must include a verified statement that the applicant is entitled to use the mark in commerce and that the applicant has a bona fide intention to use the mark in commerce as of the application filing date. 15 U.S.C. §§1051(b)(3), 1126(d)(2) and 1126(e); 37 C.F.R. §2.33(b)(2). When the person designated as the applicant was not the person with a bona fide intention to use the mark in commerce, the application is void. *See* TMEP §1201.02(b). However, the examining attorney will not inquire into the bona fides, or good faith, of an applicant's asserted intent to use a mark in commerce during *ex parte* examination unless there is evidence in the record clearly indicating that the applicant does not have a bona fide intention to use the mark in commerce. *See* TMEP §1101.

In a §1(b) application, before the mark can be registered, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) (*see* TMEP §§1104 *et seq.*) or a statement of use under 15 U.S.C. §1051(d) (*see* TMEP §§1109 *et seq.*) that states that the applicant is using the mark in commerce on or in connection with the goods or services and that the applicant is the owner of the mark. 15 U.S.C. §§1051(b)(3)(A) and (B); 37 C.F.R. §§2.76(b)(1), and 2.88(b)(1).

In a §44 application, the applicant must be the owner of the foreign application or registration on which the United States application is based as of the filing date of the United States application. *See* TMEP §1005. In an application based solely on §44, the applicant does not have to allege use prior to registration. TMEP §1009.

1201.01 Claim of Ownership May Be Based on Use By Related Companies

In an application under §1 of the Trademark Act, an applicant may base its claim of ownership of a trademark or a service mark on:

- (1) its own exclusive use of the mark;
- (2) use of the mark solely by a related company whose use inures to the applicant's benefit (*see* TMEP §§1201.03 *et seq.*); or

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- (3) use of the mark both by the applicant and by a related company whose use inures to the applicant's benefit (*see* TMEP §1201.05).

Where the mark is used by a related company, the owner is the party who controls the nature and quality of the goods sold or services rendered under the mark. The owner is the only proper party to apply for registration of a mark. 15 U.S.C. §1051. *See* TMEP §§1201.03 *et seq.* for additional information about use by related companies.

The examining attorney should accept the applicant's statement regarding ownership of the mark unless it is clearly contradicted by information in the record. The Office does not inquire about the relationship between the applicant and other parties named on the specimens or elsewhere in the record, except when the reference to another party clearly contradicts the applicant's verified statement that it is the owner of the mark or entitled to use the mark. Moreover, where the application states that use of the mark is by related companies, the examining attorney should not require any explanation of how the applicant controls such use.

The above provisions also apply to service marks, collective marks and certification marks, except that, by definition, collective marks and certification marks are not used by the owner of the mark, but are used by others under the control of the owner. 15 U.S.C. §§1053 and 1054. *See* TMEP §§1303.01, 1304.03 and 1306.01(a).

See TMEP §1201.04 for information about when an examining attorney should issue an inquiry or refusal with respect to ownership.

1201.02 Identifying the Applicant in the Application

1201.02(a) Identifying the Applicant Properly

The applicant may be any person or entity capable of suing and being sued in a court of law. *See* TMEP §§803 *et seq.* for the appropriate format for identifying the applicant and setting forth the relevant legal entity. *See* TMEP §1201.03(a) regarding the form for indicating that the mark is used solely by a related company.

1201.02(b) Application Void if Wrong Party Identified as the Applicant

An application must be filed by the party who is the owner of (or is entitled to use) the mark as of the application filing date. *See* TMEP §1201.

An application based on use in commerce under 15 U.S.C. §1051(a) must be filed by the party who owns the mark on the application filing date. If the applicant does not own the mark on the application filing date, the application is *void*. 37 C.F.R. §2.71(d). *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988).

If the record indicates that the applicant is not the owner of the mark, the examining attorney should refuse registration on that ground. The statutory basis for this refusal is §1 of the Trademark Act, 15 U.S.C. §1051, and, where related-company issues are

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relevant, §§5 and 45, 15 U.S.C. §§1055 and 1127. The examining attorney should not have the filing date cancelled or refund the application filing fee.

In an application under §1(b) or §44 of the Trademark Act, 15 U.S.C. §1051(b) or §1126, the applicant must be entitled to use the mark in commerce on the application filing date, and the application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce. 15 U.S.C. §§1051(b)(3)(A), 1051(b)(3)(B), 1126(d)(2) and 1126(e). When the person designated as the applicant was not the person with a bona fide intention to use the mark in commerce at the time the application was filed, the application is void. *American Forests v. Sanders*, 54 USPQ2d 1860 (TTAB 1999), *aff'd*, 232 F.3d 907 (Fed. Cir. 2000) (intent-to-use application filed by an individual held void, where the entity that had a bona fide intention to use the mark in commerce on the application filing date was a partnership composed of the individual applicant and her husband). However, the examining attorney will not inquire into the bona fides, or good faith, of an applicant's asserted intention to use a mark in commerce during *ex parte* examination, unless there is evidence in the record clearly indicating that the applicant does not have a bona fide intention to use the mark in commerce. *See* TMEP §1101.

When an application is filed in the name of the wrong party, this defect cannot be cured by amendment or assignment. 37 C.F.R. §2.71(d); TMEP §803.06. However, if the application was filed by the owner, but there was a mistake in the manner in which the applicant's name is set forth in the application, this may be corrected. *See* TMEP §1201.02(c) for examples of correctable and non-correctable errors.

1201.02(c) Correcting Errors in How the Applicant Is Identified [R-1]

If the party applying to register the mark is in fact the owner of the mark, but there is a mistake in the manner in which the name of the applicant is set out in the application, the mistake may be corrected by amendment. *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r Pats. 1974). However, the application may *not* be amended to designate another entity as the applicant. 37 C.F.R. §2.71(d); TMEP §803.06. An application filed in the name of the wrong party is void and cannot be corrected by amendment. *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991).

The following are examples of correctable errors in identifying the applicant:

- (1) If the applicant identifies itself by a name under which it does business, which is not its name as a legal entity, then amendment to state the applicant's correct legal name is permitted.
- (2) If the applicant mistakenly names an operating division that is not a legal entity as the owner, then the applicant's name may be amended. *See* TMEP §1201.02(d).
- (3) Clerical errors such as the mistaken addition or omission of "The" or "Inc." in the applicant's name may be corrected by amendment.

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- (4) If the record is ambiguous as to who owns the mark, *e.g.*, an individual and a corporation are each identified as the owner in different places in the application, the application may be amended to indicate the proper applicant.
- (5) If the owner of a mark legally changed its name before filing an application, but mistakenly lists its former name on the application, the error may be corrected because the correct party filed, but merely identified itself incorrectly. *In re Techsonic Industries, Inc.*, 216 USPQ 619 (TTAB 1982).
- (6) If the applicant has been identified as “A and B, doing business as The AB Company, a partnership,” and the true owner is a partnership organized under the name The AB Company and composed of A and B, the applicant’s name should be amended to “The AB Company, a partnership composed of A and B.”

To correct an obvious mistake of this nature, a verification or declaration is not normally necessary.

The following are examples of non-correctable errors in identifying the applicant:

- (1) If the president of a corporation is identified as the owner of the mark when in fact the corporation owns the mark, the application is void as filed because the applicant is not the owner of the mark.
- (2) If an application is filed in the name of entity A, when the mark was assigned to entity B before the application filing date, the application is void as filed because the applicant was not the owner of the mark at the time of filing. *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988) (application filed by an individual two days after ownership of the mark was transferred to a newly formed corporation held void).
- (3) If the application is filed in the name of a joint venturer when the mark is owned by the joint venture, the application cannot be amended. *In re Tong Yang Cement Corp.*, *supra*.
- (4) If an application is filed in the name of corporation A and a sister corporation (corporation B) owns the mark, the application is void as filed because the applicant is not the owner of the mark.

1201.02(d) Operating Divisions

An operating division that is not a legal entity that can sue and be sued does not have standing to own a mark or to file an application to register a mark. The application must be filed in the name of the company of which the division is a part. *In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1660 n.1 (TTAB 1986). An operating division’s use is considered to be use by the applicant and not use by a related

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company; therefore, reference to related-company use is permissible but not necessary.

1201.02(e) Changes in Ownership After Application Is Filed

See TMEP Chapter 500 regarding changes of ownership and changes of name subsequent to filing an application for registration, and recordation in the Office's Assignment Services Division of assignment documents, certificates of merger, certificates of change of name, security agreements, etc.

Recording a document with the Assignment Services Division does not change the owner of record in the TRAM (Trademark Reporting and Monitoring) System. The new owner must also notify the examining attorney that ownership has changed, to ensure that the registration issues in the name of the new owner. 37 C.F.R. §3.85. See TMEP §502.01 regarding the procedure for requesting that a certificate of registration be issued in the name of an assignee or in an applicant's new name.

1201.03 Use by Related Companies

Section 5 of the Trademark Act, 15 U.S.C. §1055, states, in part, as follows:

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public.

Section 45 of the Act, 15 U.S.C. §1127, defines "related company" as follows:

The term "related company" means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

Thus, §5 of the Act permits applicants for registration to rely on use of the mark by related companies. Either a natural person or a juristic person may be a related company. 15 U.S.C. §1127.

The essence of related-company use is the control exercised over the nature and quality of the goods or services on or in connection with which the mark is used. When a mark is used by a related company, use of the mark inures to the benefit of the party who controls the nature and quality of the goods or services. This party is the owner of the mark and, therefore, is the only party that may apply to register the mark. *Smith International, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

Reliance on related-company use requires, *inter alia*, that the related company use the mark in connection with the same goods or services recited in the application. *In re Admark, Inc.*, 214 USPQ 302 (TTAB 1982) (related-company use not at issue where

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the applicant sought registration of a mark for advertising agency services and the purported related company used the mark for retail store services).

A related company is different from a successor in interest who is in privity with the predecessor in interest for purposes of determining the right to register. *Wells Cargo, Inc. v. Wells Cargo, Inc.*, 197 USPQ 569 (TTAB 1977), *aff'd*, 606 F.2d 961, 203 USPQ 564 (C.C.P.A. 1979).

See TMEP §1201.03(c) regarding wholly owned related companies, §1201.03(d) regarding corporations with common stockholders, directors or officers, §1201.03(e) regarding sister corporations, and §1201.03(f) regarding license and franchise situations.

1201.03(a) Use Solely by Related Company Must be Disclosed

If the mark is not being used by the applicant but is being used by one or more related companies whose use inures to the benefit of the applicant under §5 of the Act, then these facts must be disclosed in the application. 37 C.F.R. §2.38(b). See *Pease Woodwork Co., Inc. v. Ready Hung Door Co., Inc.*, 103 USPQ 240 (Comm'r Pats. 1954); *Industrial Abrasives, Inc. v. Strong*, 101 USPQ 420 (Comm'r Pats. 1954). Use that inures to the applicant's benefit is a proper and sufficient support for an application and satisfies the requirement of 37 C.F.R. §2.33(b)(1) that a §1(a) application specify that the *applicant* has adopted and is using the mark.

The party who controls the nature and quality of the goods or services on or in connection with which the mark is used should be set forth as the applicant. In an application under §1(a) of the Trademark Act, the applicant should state in the body of the application that the applicant has adopted and is using the mark *through its related company* (or equivalent explanatory wording). In a §1(b) application, the statement that the applicant is using the mark through a related company should be included in the amendment to allege use under 15 U.S.C. §1051(c) (see TMEP §§1104 *et seq.*) or statement of use under 15 U.S.C. §1051(d) (see TMEP §§1109 *et seq.*).

The applicant is not required to give the name of the related-company user unless it is necessary to explain information in the record that clearly contradicts the applicant's verified claim of ownership of the mark.

The applicant may claim the benefit of use by a related company in an amendment to the application. *Greyhound Corp. v. Armour Life Insurance Co.*, 214 USPQ 473, 475 (TTAB 1982).

If the applicant and a related company both use the mark, and it is the applicant's own use of the mark that is relied on in the application, then the applicant does not have to include a reference to use by a related company in the application. See TMEP §1201.05.

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1201.03(b) No Explanation of Applicant's Control Over Use of Mark by Related Companies Required

Where the application states that use of the mark is by a related company or companies, the Office does not require an explanation of how the applicant controls the use of the mark.

Similarly, the Office does not inquire about the relationship between the applicant and other parties named on the specimens or elsewhere in the record, except when the reference to another party clearly contradicts the applicant's verified statement that it is the owner of the mark or entitled to use the mark. *See* TMEP §1201.04.

1201.03(c) Wholly Owned Related Companies

Related-company use includes situations where a wholly owned related company of the applicant uses the mark or the applicant is wholly owned by a related company that uses the mark.

Frequently, related companies comprise parent and wholly owned subsidiary corporations. Either a parent corporation or a subsidiary corporation may be the proper applicant, depending on the facts concerning ownership of the mark. The Office will consider the filing of the application in the name of either the parent or the subsidiary to be the expression of the intention of the parties as to ownership in accord with the arrangements between them.

Either an individual or a juristic entity may own a mark that is used by a wholly owned related company. *See In re Hand*, 231 USPQ 487 (TTAB 1986).

1201.03(d) Common Stockholders, Directors or Officers

Corporations are not "related companies" within the meaning of §5 of the Trademark Act, 15 U.S.C. §1055, merely because they have the same stockholders, directors or officers, or because they occupy the same premises. *In re Raven Marine, Inc.*, 217 USPQ 68, 69 (TTAB 1983) (statement that both the applicant corporation and the corporate user of the mark have the same principal stockholder and officer held insufficient to show that the user is a related company).

If an individual applicant is not the sole owner of the corporation that is using the mark, the question of whether the corporation is a "related company" depends on whether the applicant maintains control over the nature and quality of the goods or services such that use of the mark inures to the applicant's benefit. A formal written licensing agreement between the parties is not necessary, nor is its existence sufficient to establish ownership rights. The critical question is whether the applicant sufficiently controls the nature and quality of the goods or services with which the mark is used. *See Pneutek, Inc. v. Scherr*, 211 USPQ 824 (TTAB 1981) (detailed written agreement and substantial evidence in the record indicating that the applicant, an individual, exercised control over the nature and quality of the goods sold under

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the mark by the user corporation held sufficient to show that the corporation was a related company).

Similarly, where an individual applicant is not the sole owner of the corporation that is using the mark, the fact that the individual applicant is a stockholder, director of officer in the corporation is insufficient by itself to establish that the corporation is a related company. The question depends on whether the applicant maintains control over the nature and quality of the goods or services.

See TMEP §1201.03(c) regarding use by wholly owned related companies.

1201.03(e) Sister Corporations

The fact that two sister corporations are controlled by a single parent corporation does not mean that they are related companies. Where two corporations are wholly owned subsidiaries of a common parent, use by one sister corporation is not considered to inure to the benefit of the other unless the applicant sister corporation exercises appropriate control over the nature and quality of the goods or services on or in connection with which the mark is used. *In re Pharmacia Inc.*, 2 USPQ2d 1883 (TTAB 1987); *Greyhound Corp. v. Armour Life Insurance Co.*, 214 USPQ 473 (TTAB 1982).

See TMEP §1201.03(c) regarding use by wholly owned related companies.

1201.03(f) License and Franchise Situations

The Office accepts applications by parties who claim to be owners of marks through use by controlled licensees, pursuant to a contract or agreement. *Pneutek, Inc. v. Scherr*, 211 USPQ 824, 833 (TTAB 1981).

A controlled licensing agreement may be recognized whether oral or written in form. *In re Raven Marine, Inc.*, 217 USPQ 68, 69 (TTAB 1983).

If the application indicates that use of the mark is pursuant to a license or franchise agreement, and the record contains nothing that contradicts the assertion of ownership by the applicant (*i.e.*, the licensor or franchisor), the examining attorney will not inquire about the relationship between the applicant and the related company (*i.e.*, the licensee or franchisee).

Ownership rights in a trademark or service mark may be acquired and maintained through the use of the mark by a controlled licensee even when the only use of the mark has been made, and is being made, by the licensee. *Turner v. HMH Publishing Co., Inc.*, 380 F.2d 224, 154 USPQ 330, 334 (5th Cir. 1967), *cert. denied*, 389 U.S. 1006, 156 USPQ 720 (1967); *Central Fidelity Banks, Inc. v. First Bankers Corp. of Florida*, 225 USPQ 438, 440 (TTAB 1984) (use of the mark by petitioner's affiliated banks considered to inure to the benefit of petitioner bank holding company, even though the bank holding company could not legally render banking services and thus could not use the mark).

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Joint applicants enjoy rights of ownership to the same extent as any other “person” who has a proprietary interest in a mark. Therefore, joint applicants may license others to use a mark and, by exercising sufficient control and supervision of the nature and quality of the goods or services to which the mark is applied, the joint applicants/licensors may claim the benefits of the use by the related company/licensee. *In re Diamond Walnut Growers, Inc. and Sunsweet Growers Inc.*, 204 USPQ 507, 510 (TTAB 1979).

Stores that are operating under franchise agreements from another party are considered “related companies” of that party, and use of the mark by the franchisee/store inures to the benefit of the franchisor. *Mr. Rooter Corp. v. Morris*, 188 USPQ 392, 394 (E.D. La. 1975); *Southland Corp. v. Schubert*, 297 F. Supp. 477, 160 USPQ 375, 381 (C.D. Cal. 1968).

In all franchise and license situations, the key to ownership is the nature and extent of the control by the applicant of the goods or services to which the mark is applied. A trademark owner who fails to exercise necessary controls over licensees or franchisees may be found to have abandoned its rights in the mark. *See Hurricane Fence Co. v. A-1 Hurricane Fence Co. Inc.*, 468 F. Supp. 975, 208 USPQ 314, 325-27 (S.D. Ala. 1979).

In general, where the application states that a mark is used by a licensee or franchisee, the Office does not require an explanation of how the applicant controls the use. *See* TMEP §1201.03(b).

1201.04 Inquiry Regarding Parties Named on Specimens or Elsewhere in Record

The Office does not inquire about the relationship between the applicant and other parties named on the specimens or elsewhere in the record, except when the reference to another party clearly contradicts the applicant’s verified statement that it is the owner of the mark or entitled to use the mark.

The examining attorney should inquire about another party if the record specifically states that another party is the owner of the mark, or if the record specifically identifies the applicant in a manner that contradicts the claim of ownership, for example, as a licensee. In these circumstances, registration should be refused under §1 of the Trademark Act, on the ground that the applicant is not the owner of the mark. Similarly, when the record indicates that the applicant is a United States distributor, importer or other distributing agent for a foreign manufacturer, the examining attorney should require the applicant to establish its ownership rights in the United States in accordance with TMEP §1201.06(a).

Where the specimen of use indicates that the goods are manufactured in a country other than the applicant’s home country, the examining attorney normally should not inquire whether the mark is used by a foreign manufacturer. *See* TMEP §1201.06(b). Also, where the application states that use of the mark is by related companies, an

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explanation of how the applicant controls use of the mark by the related companies is not required. *See* TMEP §1201.03(b).

1201.05 Acceptable Claim of Ownership Based on Applicant's Own Use

An applicant's claim of ownership of a mark may be based on the applicant's own use of the mark, even though there is also use by a related company. The applicant is the owner by virtue of the applicant's own use, and the application does not have to refer to use by a related company.

An applicant may claim ownership of a mark when the mark is applied on the applicant's instruction. For example, if the applicant contracts with another party to have goods produced for the applicant and instructs the party to place the mark on the goods, that is the equivalent of the applicant itself placing the mark on its own goods and reference to related-company use is not necessary.

1201.06 Special Situations Pertaining to Ownership

1201.06(a) Applicant Is Merely Distributor or Importer

A distributor, importer or other distributing agent of the goods of a manufacturer or producer does not acquire a right of ownership in the manufacturer's or producer's mark merely because it moves the goods in trade. *In re Bee Pollen from England Ltd.*, 219 USPQ 163 (TTAB 1983); *AudioSon Vertriebs - GmbH v. Kirksaeter AudioSonics, Inc.*, 196 USPQ 453 (TTAB 1977); *Jean D'Albret v. Henkel-Khasana G.m.b.H.*, 185 USPQ 317 (TTAB 1975); *In re Lettmann*, 183 USPQ 369 (TTAB 1974); *Bakker v. Steel Nurse of America Inc.*, 176 USPQ 447 (TTAB 1972). A party that merely distributes goods bearing the mark of a manufacturer or producer is neither the owner nor a related-company user of the mark.

If the applicant merely distributes or imports goods for the owner of the mark, registration must be refused under §1 of the Trademark Act, *except* in the following situations:

- (1) If a parent and wholly owned subsidiary relationship exists between the distributor and the manufacturer, then the applicant's statement that such a relationship exists disposes of an ownership issue. *See* TMEP §1201.03(c).
- (2) If an applicant is the United States importer or distribution agent for a foreign manufacturer, then the applicant can register the foreign manufacturer's mark in the United States, if the applicant submits one of the following:
 - (a) written consent from the owner of the mark to registration in the applicant's name, or

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- (b) written agreement or acknowledgment between the parties that the importer or distributor is the owner of the mark in the United States, or
- (c) an assignment (or true copy) to the applicant of the owner's rights in the mark as to the United States together with the business and good will appurtenant thereto.

See In re Pharmacia Inc., 2 USPQ2d 1883 (TTAB 1987); *In re Geo. J. Ball, Inc.*, 153 USPQ 426 (TTAB 1967).

1201.06(b) Goods Manufactured in a Country Other than Where Applicant Is Located

Where a specimen of use indicates that the goods are manufactured in a country other than the applicant's home country, the examining attorney normally should not inquire whether the mark is used by a foreign manufacturer. If, however, information in the record clearly contradicts the applicant's verified claim of ownership (*e.g.*, a statement in the record that the mark is owned by the foreign manufacturer and that the applicant is only an importer or distributor), then registration must be refused under §1, 15 U.S.C. §1051, unless registration in the United States by the applicant is supported by the applicant's submission of one of the documents listed in TMEP §1201.06(a).

1201.07 Related Companies and Likelihood of Confusion

1201.07(a) "Single Source" -- "Unity of Control"

Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), requires that the examining attorney refuse registration when an applicant's mark, as applied to the specified goods or services, so resembles a registered mark as to be likely to cause confusion. In general, registration of confusingly similar marks to separate legal entities is barred by §2(d). *See, e.g., In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985); *In re Champion International Corp.*, 220 USPQ 478 (TTAB 1982); *In re Air Products, Inc.*, 124 USPQ 81 (TTAB 1960). However, the Court of Appeals for the Federal Circuit has held that, where the applicant is related in ownership to a company that owns a registered mark that would otherwise give rise to a likelihood of confusion, the examining attorney must consider whether, in view of all the circumstances, use of the mark by the applicant is likely to confuse the public about the source of the applicant's goods because of the resemblance of the applicant's mark to the mark of the other company. The Court stated that:

The question is whether, despite the similarity of the marks and the goods on which they are used, the public is likely to be confused about the source of the hair straightening products carrying the trademark "WELLAstrate." In other words, is the public likely to believe that the source of the product is Wella U.S. rather than the German company or the Wella organization.

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In re Wella A.G., 787 F.2d 1549, 1552, 229 USPQ 274, 276 (Fed. Cir. 1986). The Court remanded the case to the Board for consideration of the likelihood of confusion issue.

In ruling on that issue, the Board concluded that there was no likelihood of confusion, stating as follows:

[A] determination must be made as to whether there exists a likelihood of confusion as to *source*, that is, whether purchasers would believe that particular goods or services emanate from a single source, when in fact those goods or services emanate from more than a single source. Clearly, the Court views the concept of “source” as encompassing more than “legal entity.” Thus, in this case, we are required to determine whether Wella A.G. and Wella U.S. are the same source or different sources....

The existence of a related company relationship between Wella U.S. and Wella A.G. is not, in itself, a basis for finding that any “WELLA” product emanating from either of the two companies emanates from the same source. Besides the existence of a legal relationship, there must also be a unity of control over the use of the trademarks. “Control” and “source” are inextricably linked. If, notwithstanding the legal relationship between entities, each entity exclusively controls the nature and quality of the goods to which it applies one or more of the various “WELLA” trademarks, the two entities are in fact separate sources. Wella A.G. has made of record a declaration of the executive vice president of Wella U.S., which declaration states that Wella A.G. owns substantially all the outstanding stock of Wella U.S. and “thus controls the activities and operations of Wella U.S., including the selection, adoption and use of the trademarks.” While the declaration contains no details of how this control is exercised, the declaration is sufficient, absent contradictory evidence in the record, to establish that control over the use of all the “WELLA” trademarks in the United States resides in a single source.

In re Wella A.G., 5 USPQ2d 1359, 1361 (TTAB 1987) (emphasis in original), *rev’d on other grounds*, 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988).

Therefore, in some limited circumstances, the close relationship between related companies will obviate any likelihood of confusion in the public mind because the related companies constitute a single source. *See* TMEP §1201.07(b) *et seq.* for further information.

1201.07(b) Appropriate Action with Respect to Assertion of Unity of Control

First, it is important to note that analysis under *Wella* is not triggered until an applicant affirmatively asserts that a §2(d) refusal is inappropriate because the

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applicant and the registrant, though separate legal entities, constitute a single source, or the applicant raises an equivalent argument. Examining attorneys should issue §2(d) refusals in any case where an analysis of the marks and the goods or services of the respective parties indicates a bar to registration under §2(d). The examining attorney should not attempt to analyze the relationship between an applicant and registrant until an applicant, in some form, relies on the nature of the relationship to obviate a refusal under §2(d).

Once an applicant has made this assertion, the question is whether the specific relationship is such that the two entities constitute a “single source,” so that there is no likelihood of confusion. The following guidelines may assist the examining attorney in resolving questions of likelihood of confusion when the marks are owned by related companies and the applicant asserts unity of control. (Of course, in many of these situations, the applicant may choose to attempt to overcome the §2(d) refusal by submitting a consent agreement or other conventional evidence to establish no likelihood of confusion. See *In re Sumitomo Electric Industries, Ltd.*, 184 USPQ 365 (TTAB 1974). Another way to overcome a §2(d) refusal is to assign all relevant registrations to the same party.)

1201.07(b)(i) When Either Applicant or Registrant Owns All of the Other Entity

If the applicant or the applicant’s attorney represents that *either* the applicant or the registrant owns *all* of the other entity, and there is no contradictory evidence, then the examining attorney should conclude that there is unity of control, a single source and no likelihood of confusion. This would apply to an individual who owns all of the stock of a corporation, and to a corporation and a wholly owned subsidiary. In this circumstance, additional representations or declarations should generally *not* be required, absent contradictory evidence.

1201.07(b)(ii) When Either Applicant or Registrant Owns Substantially All of the Other Entity

In *Wella*, the applicant provided a declaration stating that the applicant owned *substantially all* of the stock of the registrant and that the applicant thus controlled the activities of the registrant, including the selection, adoption and use of trademarks. The Board concluded that this declaration alone, absent contradictory evidence, established unity of control, a single source and no likelihood of confusion. Therefore, if *either* the applicant or the registrant owns substantially all of the other entity and asserts control over the activities of the other entity, including its trademarks, and there is no contradictory evidence, the examining attorney should conclude that unity of control is present, that the entities constitute a single source, and that there is no likelihood of confusion under §2(d). In such a case the applicant should generally provide these assertions in the form of an affidavit or declaration under 37 C.F.R. §2.20.

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1201.07(b)(iii) When the Record Does Not Support a Presumption of Unity of Control

If neither the applicant nor the registrant owns all or substantially all of the other entity, the applicant bears a more substantial burden to establish that unity of control is present. For instance, if both the applicant and the registrant are wholly owned by a third common parent, the applicant would have to provide detailed evidence to establish how one sister corporation controlled the trademark activities of the other to establish unity of control to support the contention that the sister corporations constitute a single source. *See In re Pharmacia Inc.*, 2 USPQ2d 1883 (TTAB 1987); *Greyhound Corp. v. Armour Life Ins. Co.*, 214 USPQ 473 (TTAB 1982). Likewise, where an applicant and registrant have certain stockholders, directors or officers in common, the applicant must demonstrate with detailed evidence or explanation how those relationships establish unity of control. *See Pneutek, Inc. v. Scherr*, 211 USPQ 824 (TTAB 1981). The applicant's evidence or explanation should generally be supported by an affidavit or a declaration under 37 C.F.R. §2.20.

1201.07(b)(iv) When the Record Contradicts an Assertion of Unity of Control

In contrast to those circumstances where the relationship between the parties may support a presumption of unity of control or at least afford an applicant the opportunity to demonstrate unity of control, some relationships, by their very nature, contradict any claim that unity of control is present. For instance, if the relationship between the parties is that of licensor and licensee, unity of control will ordinarily not be present. The licensing relationship suggests ownership in one party and control by that one party over only the use of a specific mark or marks, but not over the operations or activities of the licensee generally. Thus, there is no unity of control and no basis for concluding that the two parties form a single source. Precisely because unity of control is absent, a licensing agreement is necessary. The licensing agreement enables the licensor/owner to control specific activities to protect its interests as the sole source or sponsor of the goods or services provided under the mark. Therefore, in these situations, it is most unlikely that an applicant could establish unity of control to overcome a §2(d) refusal.

1202 Use of Subject Matter as Trademark

In an application under §1 of the Act, the examining attorney must determine whether the subject matter for which registration is sought is used as a trademark by reviewing all evidence (*e.g.*, the specimens of use and any promotional material) of record in the application. *See In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992) (examining attorney should look primarily to specimens to determine whether a designation would be perceived as a source indicator, but may also consider other evidence, if there is other evidence of record).

The Trademark Trial and Appeal Board has noted that “not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so and not everything that is recognized or

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associated with a party is necessarily a registrable trademark.” As the Court of Customs and Patent Appeals observed in *In re Standard Oil Co.*, 275 F.2d 945, 947, 125 USPQ 227, 229 (C.C.P.A. 1960):

The Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration. Words are not registrable *merely* because they do not happen to be descriptive of the goods or services with which they are associated.

Sections 1 and 2 of the Trademark Act, 15 U.S.C. §§1051 and 1052, require that the subject matter presented for registration be a “trademark.” Section 45 of the Act, 15 U.S.C. §1127, defines that term as follows:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof--

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Thus, §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, provide the statutory basis for refusal to register on the Principal Register subject matter that, due to its inherent nature or the manner in which it is used, does not function as a mark to identify and distinguish the applicant’s goods. The statutory basis for refusal of registration on the Supplemental Register of matter that does not function as a trademark because it does not fit within the statutory definition of a trademark is §§23 and 45, 15 U.S.C. §§1091 and 1127.

When the examining attorney refuses registration on the ground that the subject matter is not used as a trademark, the examining attorney should explain the specific reason for the conclusion that the subject matter is not used as a trademark. *See* TMEP §§1202.01 through 1202.15 for a discussion of situations in which it may be appropriate, depending on the circumstances, for the examining attorney to refuse registration on the ground that the asserted trademark does not function as a trademark, *e.g.*, TMEP §§1202.01 (trade names), 1202.02(a) *et seq.* (functionality), 1202.03 (ornamentation), 1202.04 (informational matter), 1202.05 (color marks), 1202.06 (goods in trade), 1202.07 (columns or sections of publications), 1202.08 (title of single creative work), 1202.09 (names of artists and authors), 1202.10 (model or grade designations), 1202.11 (background designs and shapes), 1202.12 (varietal and cultivar names).

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The presence of the letters “SM” or “TM” cannot transform an otherwise unregistrable designation into a mark. *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987); *In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984); *In re Minnetonka, Inc.*, 212 USPQ 772 (TTAB 1981).

See TMEP §§1301.02 *et seq.* regarding use of subject matter as a service mark; TMEP §§1302 through 1304 regarding use of subject matter as a collective mark; and TMEP §1306 regarding use of subject matter as a certification mark.

1202.01 Refusal of Matter Used Solely as a Trade Name

The name of a business or company is a trade name. The Trademark Act distinguishes trade names from trademarks by definition. While a trademark is used to identify and distinguish the trademark owner’s goods from those manufactured or sold by others and to indicate the source of the goods, “trade name” and “commercial name” are defined in §45 of the Act, 15 U.S.C. §1127, as follows:

The terms “trade name” and “commercial name” mean any name used by a person to identify his or her business or vocation.

The Trademark Act does not provide for registration of trade names. *See In re Letica Corp.*, 226 USPQ 276, 277 (TTAB 1985) (“[T]here was a clear intention by the Congress to draw a line between indicia which perform only trade name functions and indicia which perform or also perform the function of trademarks or service marks.”).

If the examining attorney determines that matter for which registration is requested is merely a trade name, registration must be refused both on the Principal Register and on the Supplemental Register. The statutory basis for refusal of trademark registration on the ground that the matter is used merely as a trade name is found in §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, and, in the case of matter sought to be registered for services, §§1, 3, and 45, 15 U.S.C. §§1051, 1053 and 1127.

A designation may function as both a trade name and a trademark or service mark. *See In re Walker Process Equipment Inc.*, 233 F.2d 329, 332, 110 USPQ 41, 43 (C.C.P.A. 1956), *aff’g* 102 USPQ 443 (Comm’r Pats. 1954).

A determination of whether matter serves solely as a trade name rather than as a mark requires consideration of the way the mark is used, as evidenced by the specimens. Therefore, no refusal on that ground will be issued in an intent-to-use application until the applicant has submitted specimens of use in conjunction with either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d).

If subject matter presented for registration in an application is a trade name or part of a trade name, the examining attorney must determine whether it is also used as a trademark or service mark by examining the specimens and other evidence of record

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in the application file. *See In re Diamond Hill Farms*, 32 USPQ2d 1383 (TTAB 1994) (DIAMOND HILL FARMS, as used on containers for goods, found to be a tradename that identifies applicant as a business entity rather than a mark that identifies applicant's goods and distinguishes them from those of others).

Whether matter that is a trade name or a portion thereof also performs the function of a trademark depends on the manner of its use and the probable impact of the use on customers. *See In re Unclaimed Salvage & Freight Co., Inc.*, 192 USPQ 165, 168 (TTAB 1976) ("It is our opinion that the foregoing material reflects use by applicant of the notation 'UNCLAIMED SALVAGE & FREIGHT CO.' merely as a commercial, business, or trade name serving to identify applicant as a viable business entity; and that this is or would be the general and likely impact of such use upon the average person encountering this material under normal circumstances and conditions surrounding the distribution thereof."); *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308 (TTAB 1960) ("LYTLE' is applied to the container for applicant's goods in a style of lettering distinctly different from the other portion of the trade name and is of such nature and prominence that it creates a separate and independent impression.")

The presence of an entity designator in a name sought to be registered and the proximity of an address are both factors to be considered in determining whether a proposed mark is merely a trade name. *In re Univar Corp.*, 20 USPQ2d 1865, 1869 (TTAB 1991) ("[T]he mark 'UNIVAR' independently projects a separate commercial impression, due to its presentation in a distinctively bolder, larger and different type of lettering and, in some instances, its additional use in a contrasting color, and thus does more than merely convey information about a corporate relationship.") *See also Book Craft, Inc. v. BookCrafters USA, Inc.*, 222 USPQ 724, 727 (TTAB 1984) ("That the invoices ... plainly show ... service mark use is apparent from the fact that, not only do the words 'BookCrafters, Inc.' appear in larger letters and a different style of print than the address, but they are accompanied by a design feature (the circularly enclosed ends of two books).").

1202.02 Registration of Trade Dress

When an applicant applies to register a product's design, product packaging, color, or other trade dress for goods or services, the examining attorney must consider two issues: (1) functionality; and (2) distinctiveness. *See TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1004-1005 (2001); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775, 23 USPQ2d 1081, 1086 (1992) (only nonfunctional distinctive trade dress is protected). *See* TMEP §§1202.02(a) *et seq.* regarding functionality, TMEP §§1202.02(b) and 1212 *et seq.* regarding distinctiveness, and TMEP §1202.02(c) regarding separate treatment of the two issues procedurally. With respect to the functionality and distinctiveness issues in the specific context of color as a mark, *see* TMEP §§1202.05 and 1202.05(f).

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1202.02(a) Functionality

1202.02(a)(i) Statutory Basis for Functionality Refusal

Before October 30, 1998, there was no specific statutory reference to functionality as a ground for refusal, and functionality refusals were thus issued as failure-to-function refusals under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127.

Effective October 30, 1998, the Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, §201, 112 Stat. 3064, 3069, amended the Trademark Act to expressly prohibit registration on either the Principal or Supplemental Register of matter that is functional:

- Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5), prohibits registration on the Principal Register of “matter that, as a whole, is functional.”
- Section 2(f) of the Act, 15 U.S.C. §1052(f), provides that matter that, as a whole, is functional may not be registered even on a showing that it has become distinctive.
- Section 23(c) of the Act, 15 U.S.C. §1091(c), provides that a mark that, as a whole, is functional may not be registered on the Supplemental Register.
- Section 14(3) of the Act, 15 U.S.C. §1064(3), lists functionality as a ground that can be raised in a cancellation proceeding more than five years after the date of registration.
- Section 33(b)(8) of the Act, 15 U.S.C. §1115(b)(8), lists functionality as a statutory defense to infringement in a suit involving an incontestable registration.

These amendments codified case law and the longstanding Office practice of refusing registration of matter that is functional.

1202.02(a)(ii) Purpose of Functionality Doctrine

The functionality doctrine, which prohibits registration of functional product features, is intended to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. As the Supreme Court explained, in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164, 34 USPQ2d 1161, 1163 (1995):

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new

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product designs or functions for a limited time, 35 U.S.C. §§154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

In other words, the functionality doctrine ensures that protection for utilitarian product features be properly sought through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration. Upon expiration of a utility patent, the invention covered by the patent enters the public domain, and the functional features disclosed in the patent may then be copied by others – thus encouraging advances in product design and manufacture. In *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 34-35, 58 USPQ2d 1001, 1007 (2001), the Supreme Court reiterated this rationale, also noting that the functionality doctrine is not affected by evidence of acquired distinctiveness:

The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.

Thus, even where the evidence establishes that consumers have come to associate a functional product feature with a single source, trademark protection will not be granted in light of the public policy reasons just stated. *Id.*

1202.02(a)(iii) Definitions

1202.02(a)(iii)(A) Functionality [R-1]

Functional matter cannot be protected as trade dress or a trademark. 15 U.S.C. §§1052(e)(5) and (f), 1091(c), 1064(3), and 1115(b). A feature is functional as a matter of law if it is “essential to the use or purpose of the product or if it affects the cost or quality of the product.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995); *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, 214 USPQ 1, 4 n.10 (1982).

While some courts had developed a definition of functionality that focused solely on “competitive need” – thus finding a particular product feature functional only if competitors needed to copy that design in order to compete effectively – the Supreme Court held that this “was incorrect as a comprehensive definition” of functionality. *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1006. The Court emphasized that where a product feature meets the traditional functionality definition – that is, it is essential to the use or purpose of the product or affects the cost or quality of the product – then the feature is functional. *Id.* However, an inquiry into competitive need for the

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product design or feature at issue may be appropriate in cases where the mark sought to be registered is a color or other matter that does not easily fit within the “utilitarian” definition of functionality. *Id.* at 1006-07 (stating that inquiring into the issue of “significant non-reputation-related disadvantage” (*i.e.*, competitive need) would be appropriate in cases of “aesthetic functionality,” such as *Qualitex*). See TMEP §§1202.02(a)(iii)(C) and 1202.05 regarding the issues of “aesthetic functionality” and color as a mark.

The determination that a proposed mark is functional constitutes, for public policy reasons, an absolute bar to registration on either the Principal Register or the Supplemental Register – regardless of evidence showing that the proposed mark has acquired distinctiveness. *TrafFix*, 532 U.S. at 29, 58 USPQ2d at 1006. See also *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002); *In re Controls Corp. of America*, 46 USPQ2d 1308, 1311 (TTAB 1998).

See TMEP §§1202.02(a)(v) *et seq.* regarding evidentiary considerations pertaining to functionality refusals.

1202.02(a)(iii)(B) “De Jure” and “De Facto” Functionality [R-1]

Prior to this revision of the TMEP, the Office used the terms “*de facto*” and “*de jure*” in assessing whether “subject matter” (usually a product feature or the configuration of the goods) presented for registration was functional. This distinction originated with the Court of Customs and Patent Appeals’ *Morton-Norwich* decision, which was discussed by the Federal Circuit in *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1425 (Fed. Cir. 2002):

Our decisions distinguish *de facto* functional features, which may be entitled to trademark protection, from *de jure* functional features, which are not. ‘In essence, *de facto* functional means that the design of a product has a function, *i.e.*, a bottle of any design holds fluid.’ *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984). *De facto* functionality does not necessarily defeat registrability. *Morton-Norwich*, 671 F.2d [1332,] at 1337, 213 USPQ [9] at 13 [(C.C.P.A. 1982)] (A design that is *de facto* functional, *i.e.*, ‘functional’ in the lay sense ... may be legally recognized as an indication of source.’). *De jure* functionality means that the product has a particular shape ‘because it works better in this shape.’ *Smith*, 734 F.2d at 1484, 222 USPQ at 3.

However, in the three recent Supreme Court decisions which discuss functionality-- *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161 (1995), *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), and *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001) -- the Court has not used the “*de facto/de jure*” distinction. Nor were these terms used when the Trademark Act was amended to expressly prohibit registration of matter that is “functional.” Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, §201, 112 Stat. 3064, 3069 (1998). Accordingly, in

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general, examining attorneys will no longer make this distinction in Office actions which refuse registration based on functionality.

De facto functionality is not a ground for refusal. *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1282 (TTAB 2000); *In re Parkway Machine Corp.*, 52 USPQ2d 1628, 1631 n.4 (TTAB 1999).

1202.02(a)(iii)(C) Aesthetic Functionality

The concept of “aesthetic functionality” (as opposed to “utilitarian functionality”) has for many years been the subject of much confusion as to its precise meaning, as well as whether it is even a viable legal principle. While the Court of Customs and Patent Appeals (the predecessor to the Court of Appeals for the Federal Circuit) appeared to reject the doctrine of aesthetic functionality in *In re DC Comics, Inc.*, 689 F.2d 1042, 215 USPQ 394 (C.C.P.A. 1982), the Supreme Court more recently referred to aesthetic functionality as a valid legal concept in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001). In discussing the proper definition of “functionality,” the Court distinguished its previous decision in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161 (1995), specifically contrasting the fact that, unlike the issue currently before the Court, in *Qualitex* “aesthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.” *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1006-07. Although the references to aesthetic functionality in the *TrafFix* decision are *dicta*, the Court’s use of this terminology appears to indicate that the concept of aesthetic functionality – at least when used properly – is a viable legal principle.

The confusion regarding this concept stems from widespread misuse of the term “aesthetic functionality” in cases involving ornamentation issues, with some courts having mistakenly expanded the category of “functional” marks to include matter that is solely ornamental, essentially on the theory that such matter serves an “aesthetic function” or “ornamentation function.” It is this incorrect use of the term “aesthetic functionality” in connection with ornamentation cases that was rejected by the Court of Customs and Patent Appeals. *See In re DC Comics, Inc.*, 689 F.2d 1042, 215 USPQ 394, 397, 399-401 (majority opinion and Rich, J., concurring) (C.C.P.A. 1982) (holding, in a case involving features of toy dolls, that the Board had improperly “intermingled the concepts of utilitarian functionality and what has been termed ‘aesthetic functionality’”; and rejecting the concept of aesthetic functionality where it is used as a substitute for “the more traditional source identification principles of trademark law,” such as the ornamentation and functionality doctrines).

Where the issue presented is whether the proposed mark is ornamental in nature, it is improper to refer to “aesthetic functionality,” because the doctrine of “functionality” is inapplicable to such cases. The proper refusal is on the basis that the matter is ornamental and thus does not function as a mark under §§1, 2 and 45 of the

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Trademark Act, 15 U.S.C. §§1051, 1052 and 1127. *See* TMEP §§1202.03 *et seq.* regarding ornamentation.

The Supreme Court's use of the term "aesthetic functionality" in the *Traffix* case appears limited to cases where the issue is one of actual functionality, but where the nature of the proposed mark makes it difficult to evaluate the functionality issue from a purely utilitarian standpoint. This is the case with color marks and product features that enhance the attractiveness of the product. The color or feature does not normally give the product a truly utilitarian advantage (in terms of making the product actually perform better), but may still be found to be functional because it provides other real and significant competitive advantages and thus should remain in the public domain.

For example, in *Qualitex, supra*, referred to as an "aesthetic functionality" case in *Traffix, supra*, the Supreme Court considered whether a green-gold color used on the pads for dry cleaning presses was barred from trademark protection under the functionality doctrine. While the Court ultimately concluded that the color at issue was not functional, the Court evaluated the proposed mark not only in light of the traditional "utilitarian" definition of functionality (*i.e.*, whether the proposed mark is essential to the use or purpose of the product or affects the cost or quality of the product), but also in terms of whether there was a competitive need for the color in that industry, stating that the color would be considered functional if its exclusive use "would put competitors at a significant non-reputation-related disadvantage."

Qualitex, 514 U.S. 165, 34 USPQ2d at 1163-65. *See also Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994) (affirming the Board's determination that the color black for outboard motors was functional because while it had no utilitarian effect on the mechanical working of the engines, it nevertheless provided other identifiable competitive advantages – *i.e.*, ease of coordination with a variety of boat colors and reduction in the apparent size of the engines.

In *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001), the Board considered the proper use of the aesthetic functionality doctrine in connection with product designs for metal ventilating ducts and vents for tile or concrete roofs:

This case seems to involve elements of both utilitarian and aesthetic functionality. Here, for example, there is evidence of utility in applicant's patent application, as well as statements touting the superiority of applicant's design in applicant's promotional literature, and statements that applicant's design results in reduced costs of installation. On the other hand, there is no question that applicant's roof designs which match the appearance of surrounding roof tiles are more pleasing in appearance because the venting tiles in each case are unobtrusive.

M-5 Steel, 61 USPQ2d at 1096. Citing extensively from the *Traffix*, *Qualitex* and *Brunswick* cases, the Board concluded that the product designs were functional for a combination of utilitarian and aesthetic reasons:

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[W]e agree with opposer that applicant's product designs are functional in the sense that these configurations blend in or match the roof tiles with which they are used better than alternative products. As in *Brunswick*, these configurations do not make the roof vents work better because they are in these shapes. Rather, like the advantages of color compatibility and reduction in apparent engine size afforded by the color black, applicant's designs are compatible with the roof tiles with which they are used and supply applicant with a competitive advantage in each case. Because applicant's vents match the contours of the roof vents with which they are used, alternatives will not have this advantage. Applicant's patent application and other evidence of record, including applicant's promotional literature and applicant's own testimony, tout the designs' unobtrusive appearance, state that they are "functional in design," camouflage the existence of the vents and are aesthetically pleasing. Applicant also represents in its promotional material that its vents are cheaper to install. We conclude that applicant's product design are, as a whole, functional, and that registration by applicant would hinder competition by placing competitors at a substantial competitive disadvantage.

M-5 Steel, 61 USPQ2d at 1097.

Note that this type of functionality determination – while employed in connection with a normally "aesthetic" feature such as color – is a proper use of the functionality doctrine, necessitating a §2(e)(5) refusal where the evidence establishes that a color or other matter at issue provides identifiable competitive advantages and thus should remain in the public domain. This is the opposite of an ornamentation refusal, where the matter at issue serves no identifiable purpose other than that of pure decoration.

Generally speaking, examining attorneys should exercise caution in the use of the term "aesthetic functionality," in light of the confusion that historically has surrounded this issue. In most situations, reference to aesthetic functionality will be unnecessary, since a determination that the matter sought to be registered is purely ornamental in nature will result in an ornamentation refusal under §§1, 2 and 45, and a determination that the matter sought to be registered is functional will result in a functionality refusal under §2(e)(5). Use of the term "aesthetic functionality" may be appropriate in limited circumstances where the proposed mark presents issues similar to those involved in the *M-5 Steel* and *Brunswick* cases, *supra* – i.e., where the issue is one of true functionality under §2(e)(5), but where the nature of the mark makes the functionality determination turn on evidence of particular competitive advantages that are not necessarily categorized as "utilitarian" in nature. Any such use of the term "aesthetic functionality" should be closely tied to a discussion of specific competitive advantages resulting from use of the proposed mark at issue, so that it is clear that the refusal is properly based on the functionality doctrine and not on an incorrect use of "aesthetic functionality" to mean ornamentation.

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See TMEP §§1202.05 and 1202.05(f) for additional discussion and case references regarding the functionality issue in connection with color marks.

1202.02(a)(iv) Burden of Proof in Functionality Determinations [R-1]

The examining attorney must establish a *prima facie* case that the trade dress sought to be registered is functional. The burden then shifts to the applicant to present sufficient evidence to rebut the examining attorney's *prima facie* case of functionality. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1257 n.5 (TTAB 1993).

The functionality determination is a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997). While there is no set amount of evidence that an examining attorney must present to establish a *prima facie* case of functionality, it is clear that there must be evidentiary support for the refusal in the record. *See, e.g., In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 16-17 (C.C.P.A. 1982) (admonishing both the examining attorney and the Board for failing to support the functionality determination with even "one iota of evidence").

If the trade dress sought to be registered as a mark is the subject of a utility patent that discloses the feature's utilitarian advantages, then the applicant bears an especially "heavy burden of overcoming the strong evidentiary inference of functionality." *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1005 (2001). *See* TMEP §1202.02(a)(v).

1202.02(a)(v) Evidence and Considerations Regarding Functionality Determinations [R-1]

Trade dress is functional if it is essential to the use or purpose of a product or if it affects the cost or quality of the product. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, 214 USPQ 1, 4 n. 10 (1982).

In *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1005 (2001), the Supreme Court resolved a circuit split regarding the proper weight to be afforded a utility patent in the functionality determination, stating:

A utility patent is strong evidence that the features claimed therein are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

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See also In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); *In re Visual Communications Co., Inc.*, 51 USPQ2d 1141 (TTAB 1999); *In re Edward Ski Products, Inc.*, 49 USPQ2d 2001 (TTAB 1999); *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997).

The Court in *TrafFix* went on to hold that where the evidence includes a utility patent that claims the product features at issue, it is unnecessary to consider evidence relating to the availability of alternative designs:

There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.

TrafFix, 532 U.S. at 23, 58 USPQ2d at 1007 (citation omitted).

Therefore, in those instances where the examining attorney is presented with facts similar to those in *TrafFix* – *i.e.*, where there is a utility patent establishing the utilitarian nature of the product design at issue – the examining attorney may properly issue a final functionality refusal based primarily on the utility patent.

In relevant cases, the examining attorney should ask the applicant to provide copies of any patent(s) or any pending or abandoned patent application(s). *See Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1429 (Fed. Cir. 2002) (“We agree with the Board that an abandoned patent application should be considered under the first Morton-Norwich factor, because an applied-for utility patent that never issued has evidentiary significance for the statements and claims made in the patent application concerning the utilitarian advantages, just as an issued patent has evidentiary significance.”).

It is important to read the patent to determine whether the patent actually claims the features presented in the proposed mark. If it does not, or if the features are referenced in the patent, but only as arbitrary or incidental features, then the probative value of the patent as evidence of functionality is substantially diminished or negated entirely. *TrafFix*, 532 U.S. at 34, 58 USPQ2d at 1007 (where a manufacturer seeks to protect arbitrary, incidental or ornamental aspects or features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, functionality will not be established if the manufacturer can prove that those aspects do not serve a purpose within the terms of utility patent); *see also Black & Decker Inc. v. Hoover Service Ctr.*, 886 F.2d 1285, 12 USPQ2d 1250 (Fed. Cir. 1989); *In re Zippo Mfg. Co.*, 50 USPQ2d 1852 (TTAB 1999); *In re Weber-Stephen Products Co.*, 3 USPQ2d 1659 (TTAB 1987).

It is not necessary that the utility patent be owned by the applicant; a third-party utility patent is also relevant to the functionality determination if the patent claims the

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features in the product design sought to be registered. *See In re Virshup*, 42 USPQ2d 1403 (TTAB 1997); *In re American National Can Co.*, 41 USPQ2d 1841 (TTAB 1997); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990). Therefore, the examining attorney may also search the Office's patent records to see if there are utility patents owned by third parties that disclose the functional advantages of the product design that the applicant seeks to register.

Statements regarding utilitarian advantages of the design made in the course of the prosecution of the patent application can be very strong evidence of functionality. *TrafFix*, 532 U.S. at 32, 58 USPQ2d at 1006 ("These statements [regarding specific functional advantages of the product design] made in the patent applications and in the course of procuring the patents demonstrate the functionality of the design. MDI does not assert that any of these representations are mistaken or inaccurate, and this is further strong evidence of the functionality of the dual-spring design.").

Where a utility patent claims more than what is sought to be registered, this fact does not establish the nonfunctionality of the product design if the patent shows that the part claimed as a trademark is an essential or integral part of the invention and has utilitarian advantages. *Cf. TrafFix*, 532 U.S. at 31, 58 USPQ2d at 1006.

The fact that the proposed mark is *not* the subject of a utility patent does not establish that the product feature is nonfunctional. *TrafFix*, 532 U.S. at 31, 58 USPQ2d at 1006; *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1950 n. 3, (TTAB 2001). If the patent does not disclose utilitarian advantages of the design features at issue, or if no utility patent/application is of record, the evidence normally involves consideration of one or more of the other factors commonly known as the "*Morton-Norwich* factors:"

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
- (2) advertising by the applicant that touts the utilitarian advantages of the design;
- (3) facts pertaining to the availability of alternative designs; and
- (4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9, 15-16 (C.C.P.A. 1982).

Moreover, even in the absence of a utility patent or utility patent application, it is not necessary to consider all these factors in every case. The Supreme Court held that "[w]here the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature."

TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001). *See also Gibson Guitar Corp., supra* (where there was no utility patent, and no evidence that applicant's guitar configuration resulted from a simpler or cheaper method of manufacture, these factors did not weigh in Board's decision).

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Relevant technical information is usually more readily available to an applicant. *In re Witco Corp.*, 14 USPQ2d 1557, 1560 (TTAB 1990). Therefore, the applicant will often be the source of most of the evidence relied upon by the examining attorney in establishing a *prima facie* case of functionality in an *ex parte* case. *In re Teledyne Industries Inc.*, 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982). When there is reason to believe the proposed mark may be functional, in the first Office action the examining attorney should require the applicant to provide information necessary to permit an informed determination concerning the registrability of the proposed mark. *See* 37 C.F.R. §2.61(b); *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990) (registration properly refused where applicant failed to comply with examining attorney's request for copies of patent applications and other patent information). In addition to requesting whether the proposed mark is or has been the subject of a utility patent or a pending or abandoned patent application, the examining attorney should require an applicant to provide advertising or promotional materials. The examining attorney should also inquire whether the feature makes the product easier or cheaper to manufacture and whether alternative designs are available.

It is important that the inquiry focus on the utility of the feature or combination of features that is claimed as protectible trade dress, and not on the usefulness of the article overall. *Morton-Norwich*, 671 F.2d at 1338, 213 USPQ at 13. Generally, dissecting the design into its individual features and analyzing the utility of each separate feature does not establish that the overall design is functional. 15 U.S.C. §1052(e)(5); *Teledyne Industries Inc.*, 696 F.2d at 971, 217 USPQ at 11. However, it is sometimes helpful to analyze the design from the standpoint of its various features. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 2 (Fed. Cir. 1984) (affirming the functionality determination, where the Board had initially considered the six individual features of the design, and then had concluded that the design as a whole was functional); *In re Controls Corp. of America*, 46 USPQ2d 1308, 1312 (TTAB 1998) (finding the entire configuration at issue functional because it consisted of several individual features, each of which was functional in nature). *See also Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 1579-80, 36 USPQ2d 1417, 1422-23 (Fed. Cir. 1995) (rejecting the argument that the combination of individually functional features in the configuration resulted in an overall nonfunctional product design).

Where the evidence shows that the overall design is functional, the inclusion of a few arbitrary or otherwise nonfunctional features in the design will not change the result. *See Textron, Inc. v. U.S. International Trade Commission*, 753 F.2d 1019, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 368 (TTAB 1985).

A design patent is a factor that weighs against a finding of functionality because design patents by definition protect only ornamental and nonfunctional features. However, ownership of a design patent does not in and of itself establish that a product feature is nonfunctional, and can be outweighed by other evidence supporting the functionality determination. *R.M. Smith, Inc.*, 734 F.2d at 1485, 222 USPQ at 3;

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American National Can Co., 41 USPQ2d at 1843; *Caterpillar Inc.*, 43 USPQ2d at 1339; *Witco Corp.*, 14 USPQ2d at 1559.

1202.02(a)(v)(A) Advertising, Promotional or Explanatory Material in Functionality Determinations [R-1]

The examining attorney should examine the specimens of record, and should also ask an applicant to provide any available advertising, promotional or explanatory material concerning the goods/services, particularly any material specifically related to the features embodied in the proposed mark. The examining attorney should also check to see if the applicant has a website on which the product is advertised or described.

The applicant's own advertising touting the utilitarian aspects of its design is often strong evidence supporting a functionality refusal. *See, e.g., In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001); *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001); *In re Visual Communications Co., Inc.*, 51 USPQ2d 1141 (TTAB 1999); *In re Edward Ski Products, Inc.*, 49 USPQ2d 2001 (TTAB 1999); *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254 (TTAB 1993); *In re Witco Corp.*, 14 USPQ2d 1557 (TTAB 1989).

An applicant will often assert that statements in its promotional materials touting the utilitarian advantages of the product feature are mere "puffery" and thus entitled to little weight in the functionality analysis. However, where the advertising statements clearly emphasize specific utilitarian features of the design claimed as a mark, the Board will reject such assertions of "puffing." *See, e.g., In re Gibson Guitar Corp., supra*; *Goodyear Tire and Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705, 1716-17 (TTAB 1998); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1260 (TTAB 1993); *In re Witco Corp.*, 14 USPQ2d 1557, 1559-61 (TTAB 1989).

In *Gibson Guitar*, the Board found the design of a guitar body to be functional, noting that applicant's literature clearly indicated that the shape of applicant's guitar produced a better musical sound. Applicant's advertisements stated that "This unique body shape creates a sound which is much more balanced and less 'muddy' than other ordinary dreadnought acoustics." 61 USPQ2d at 1951.

The examining attorney may also check trade publications and computer databases to determine whether others have written about the applicant's design and its functional features or characteristics. In *Gibson Guitar*, the record included an advertisement obtained from the website of a competitor whose guitar appeared to be identical in shape to applicant's configuration, touting the acoustical advantages of the shape of the guitar.

1202.02(a)(v)(B) Availability of Alternative Designs in Functionality Determinations [R-1]

An applicant attempting to rebut a *prima facie* case of functionality will often submit evidence of alternative designs to demonstrate that there is no "competitive need" in

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the industry for the applicant's particular product design. *See* TMEP §1202.02(a)(iii)(A).

However, in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001), the Supreme Court clearly indicated that if the record shows that a design is essential to the use or purpose of a product, or if it affects the cost or quality of the product, it is unnecessary to consider whether there is a competitive need for the product feature. The Court explained:

[W]e have said “in general terms, a product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” Expanding upon the meaning of this phrase, we have observed that a functional feature is one the “exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.” The Court of Appeals in the instant case seemed to interpret this language to mean that a necessary test for functionality is “whether the particular product configuration is a competitive necessity.” . . . This was incorrect as a comprehensive definition. As explained in *Qualitex, supra*, and *Inwood, supra*, a feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device . . . *Where the design is functional under the Inwood formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.*

* * *

There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted (emphasis added).

TrafFix, 58 USPQ2d at 1006-1007 (citations and additional internal quotations omitted).

Thus, where the evidence clearly establishes the utilitarian nature of the trade dress at issue in view of a utility patent and/or advertising statements and facts showing a positive effect on the cost or quality of manufacture, it is unnecessary to consider whether alternative designs are available. *See Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002) discussing the Supreme Court's decision in *TrafFix* (“once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available.”).

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Evidence of the availability of alternative designs may be helpful where the record is otherwise unclear regarding the utilitarian functionality of the design at issue. *Id.* Accordingly, examining attorneys may continue to request information about alternative designs in the initial Office action, *i.e.*, inquire whether alternative designs are available for the feature embodied in the proposed mark, and whether the alternatives are more costly to produce. *See* TMEP 1212.02(a)(v).

In *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001), the Board found that the applicant had not shown that there were alternative guitar shapes that could produce the same sound as applicant's configuration. The Board noted that the record contained an advertisement obtained from the website of a competitor whose guitar appeared to be identical in shape to applicant's configuration, stating that the shape of the guitar produces a better sound.

In order to be probative, the alternative design evidence must pertain to the same category of goods as the applicant's goods. *See, e.g., In re Zippo Mfg. Co.*, 50 USPQ2d 1852, 1854 (TTAB 1999); *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1919 (TTAB 1997).

1202.02(a)(v)(C) Ease or Economy of Manufacture in Functionality Determinations

As noted in TMEP §1202.02(a)(iii)(A), a product feature is "functional" if it is essential to the use or purpose of the product *or if it affects the cost or quality of the product*. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, 214 USPQ 1, 4 n.10 (1982). Therefore, a showing that a design results from a comparatively simple or inexpensive method of manufacture will support a finding that the design is functional.

In most cases, there is little or no evidence pertaining to this factor. However, the examining attorney should still ask the applicant for information as to whether the subject design makes the product simpler or less costly to manufacture, since evidence on this issue weighs strongly in favor of a finding of functionality. *See, e.g., TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001); *In re Virshup*, 42 USPQ2d 1403 (TTAB 1997). Statements pertaining to the cost or ease of manufacture may sometimes also be found in informational or advertising materials submitted by the applicant. *See M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1097 (TTAB 2001) (statements in promotional material that applicant's design results in reduced costs of installation found to be evidence of functionality of applicant's configurations of metal ventilating ducts and vents for tile or concrete roofs).

While evidence showing that the product feature results from a comparatively simple or inexpensive method of manufacture supports a finding that the design is functional, the opposite is not necessarily the case – *i.e.*, assertions by the applicant that its design is more expensive or more difficult to make will not establish that the configuration is not functional.

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1202.02(b) Distinctiveness of Trade Dress [R-1]

In *Wal-Mart Stores, Inc. v Samara Brothers, Inc.*, 529 U.S. 205, 215, 54 USPQ2d 1065, 1069 (2000) the Supreme Court distinguished between two types of trade dress—product design and product packaging. If the trade dress falls within the category of “product design,” it can never be inherently distinctive. *Id.* 529 U.S. at 212, 54 USPQ2d at 1068 (“It seems to us that design, like color, is not inherently distinctive.”). Moreover, the Court held that in close cases in which it is difficult to determine whether the trade dress at issue is product packaging or product design, “courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.” *Id.* at 215, 54 USPQ2d at 1070. (Note: If the trade dress is functional, it cannot be registered despite acquired distinctiveness. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1007 (2001)).

The statutory basis for refusal of registration on the Principal Register on the ground that the trade dress is nondistinctive is 15 U.S.C. §§1051, 1052, and 1127.

1202.02(b)(i) Distinctiveness and Product Design Trade Dress

In addition to determining whether a proposed mark is functional, the examining attorney must refuse to register, on the Principal Register, any mark that consists of a product design, unless the applicant establishes that the mark has acquired distinctiveness under §2(f). *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 210, 54 USPQ2d 1065, 1068 (2000). Features of a product’s design can never be inherently distinctive and are registrable only upon a showing of secondary meaning. *Id.* at 213–14, 54 USPQ2d at 1069. The Supreme Court noted that product design almost invariably serves purposes other than source identification, and that consumers are aware that even the most unusual product design (such as a cocktail shaker shaped like a penguin) is intended not to identify the source, but to render the product itself more useful or appealing. *Id.*

The examining attorney must issue this refusal in *all* applications seeking registration of a product design unless the application is filed under the provisions of §2(f) and includes sufficient evidence to show that the mark has secondary meaning. The ground for refusal is that the proposed mark consists of a nondistinctive product design, and thus does not function as a mark under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127. If the product design is not functional, the mark may be registered on the Supplemental Register, or, if the applicant shows that the product design has acquired distinctiveness, on the Principal Register under §2(f). See TMEP §1202.02(a) regarding functionality, TMEP §§815 and 816 *et seq.* regarding the Supplemental Register, and TMEP §§1212 *et seq.* regarding acquired distinctiveness.

For applications based on §1(b) of the Trademark Act, 15 U.S.C. §1051(b), the examining attorney must issue the refusal even if the applicant has not filed an

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amendment to allege use or statement of use. *See* TMEP §1202.02(e) regarding examination of intent-to-use applications.

1202.02(b)(ii) Distinctiveness and Product Packaging Trade Dress for Goods or Services

Where a proposed mark consists of product packaging trade dress for goods or services, the examining attorney must determine whether the proposed mark is inherently distinctive. If it is not inherently distinctive, the examining attorney must refuse registration on the Principal Register on the ground that the proposed mark is nondistinctive trade dress under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, for trademark applications; or §§1, 3 and 45 of the Act, 15 U.S.C. §§1051, 1053 and 1127, for service mark applications.

In *Wal-Mart Stores, Inc., v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), the Supreme Court discussed the distinction between the trade dress at issue in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992), and the product design trade dress (designs for children's clothing) under consideration in *Wal-Mart*:

Two Pesos unquestionably establishes the legal principle that trade dress can be inherently distinctive, but it does not establish that *product design* trade dress can be. *Two Pesos* is inapposite to our holding here because the trade dress at issue, the decor of a restaurant, seems to us not to constitute *product design*. It was either product packaging – which, as we have discussed, normally is taken by the consumer to indicate origin – or else some *tertium quid* that is akin to product packaging.

Wal-Mart, 529 U.S. at 215, 54 USPQ2d at 1069.

Thus, unlike product design trade dress, trade dress constituting product packaging may be inherently distinctive for goods or services and registrable on the Principal Register without a showing of acquired distinctiveness. However, the examining attorney should be mindful of the Supreme Court's admonishment that where there are close cases, trade dress should be classified as product design for which secondary meaning is always required. *Id.*, 529 U.S. at 215, 54 USPQ2d at 1070.

"[A] mark is inherently distinctive if '[its] intrinsic nature serves to identify a particular source.'" *Id.* at 210, 54 USPQ2d at 1068 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 USPQ2d 1081 (1992)). The test for determining inherent distinctiveness set forth in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977), although not applicable to product design trade dress, is still viable in the examination of product packaging trade dress. The examining attorney should consider the following "*Seabrook*" factors. Whether the proposed mark is:

- (1) a "common" basic shape or design;

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- (2) unique or unusual in the field in which it is used;
- (3) a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods;
- (4) capable of creating a commercial impression distinct from the accompanying words.

Id. See also *Yankee Candle Co. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 59 USPQ2d 1720 (1st Cir. 2001) (trade dress for common elements of candle labels was nondistinctive product packaging for which insufficient evidence of acquired distinctiveness was shown; also insufficient evidence of acquired distinctiveness for trade dress comprised of label elements, candle holders, display systems, and candle containers); *Tone Brothers, Inc. v. Sysco Corp.*, 28 F.3d 1192, 1205, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994) (citing *Seabrook*); *In re Hudson News Co.*, 39 USPQ2d 1915, 1923 (TTAB 1996), *aff'd per curiam*, 114 F.3d 1207 (Fed. Cir. 1997) (“[f]or the ‘blue motif’ of a retail store to be registrable on the Principal Register without resort to Section 2(f), the trade dress would have to be immediately recognizable as a distinctive way of identifying the source of the store services.”); *In re File*, 48 USPQ2d 1363, 1367 (TTAB 1998) (novel tubular lights used in connection with bowling alley services would be perceived by customers as “simply a refinement of the commonplace decorative or ornamental lighting... and would not be inherently regarded as a source indicator.”); *In re J. Kinderman & Sons Inc.*, 46 USPQ2d 1253, 1255 (TTAB 1998) (“... while the designs applicant seeks to register [the packaging for electric lights for Christmas trees] may be unique in the sense that we have no evidence that anyone else is using designs which are identical to them, they are nonetheless not inherently distinctive.”).

Unlike §1(b) applications for product design trade dress, §1(b) applications for product packaging trade dress generally will not be refused registration on the ground of nondistinctiveness until the applicant has filed an amendment to allege use or a statement of use. See TMEP §1202.02(e).

Regardless of the bases for filing, if a proposed mark is inherently distinctive, it may be registered on the Principal Register. See *In re Creative Beauty Innovations, Inc.*, 56 USPQ2d 1203 (TTAB 2000) (bottle configuration found inherently distinctive); *In re Fre-Mar Industries, Inc.*, 158 USPQ 364, 367 (TTAB 1968) (“[A]lthough the particular shape is a commonplace one for flashlights, it is nevertheless so unique and arbitrary as a container in the tire repair field that it may be inherently distinctive and, therefore, by reason of its shape alone, serve to identify applicant’s goods and distinguish them from like goods of others.”); *In re International Playtex Corp.*, 153 USPQ 377 (TTAB 1967) (container configuration having the appearance of an ice cream cone found inherently distinctive as a trademark for baby pants).

If a proposed mark is *not* inherently distinctive, the mark may be registered on either the Principal Register under §2(f) or on the Supplemental Register. Secondary meaning is acquired when the public views its primary significance as identifying the

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source of the product rather than the product itself. *Wal-Mart*, 529 U.S. at 211, 54 USPQ2d at 1068. In the following cases, the applicant's evidence was found to be sufficient to support a claim of acquired distinctiveness: *In re World's Finest Chocolate, Inc.*, 474 F.2d 1012, 177 USPQ 205 (C.C.P.A. 1973) (package design found to identify applicant's candy bars and distinguish them from those of others); *Ex parte Haig & Haig Ltd.*, 118 USPQ 229, 230 (Comm'r Pats. 1958) ("The decree recited that because of the original, distinctive and peculiar appearance of the 'Pinched Decanter' the brand of whiskey in such bottles had come to be known and recognized by the public, by dealers and by consumers; and that the whiskey contained in such bottles had come to be identified with the 'Pinched Decanter' in the minds of the public generally.")

In *In re Usher, S.A.*, 219 USPQ 920, 921 (TTAB 1983), the evidence of secondary meaning was insufficient. (The configuration of a package for mint candies was not functional but the package design was not shown to possess secondary meaning).

See TMEP §§1212 *et seq.* regarding acquired distinctiveness and TMEP §§815 and 816 *et seq.* regarding the Supplemental Register.

1202.02(c) Distinctiveness and Functionality are Separate Issues

As stated in TMEP §1202.02, in an application for trade dress, distinctiveness and functionality are two separate issues, both of which must be considered by the examining attorney.

In many cases, registration is refused on both grounds. In any case where a product design or product packaging is refused because it is functional, registration should also be refused on the ground that the proposed mark is nondistinctive.

In appropriate cases, the issues of functionality and acquired distinctiveness should be argued in the alternative. For example, if the examining attorney has determined that a mark is functional and the applicant has made a claim of acquired distinctiveness, the examining attorney must determine whether the showing of acquired distinctiveness would be sufficient to warrant registration if the examining attorney's decision on the functionality issue is reversed. Of course, if the mark is ultimately determined to be functional, evidence of acquired distinctiveness is irrelevant and registration will be refused. *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1007 (2001).

1202.02(d) Drawing and Description of Mark in Trade Dress Applications

In an application to register a mark with three-dimensional features, the applicant must submit a drawing that depicts the mark in a single rendition. 37 C.F.R. §2.52(a)(2)(iii). If the mark comprises the design of only a portion of a product or container, broken lines should be used in the drawing to indicate that portion of the product or container that is not claimed as part of the mark. 37 C.F.R. §2.52(a)(2)(ii). See *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980); *In re*

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Famous Foods, Inc., 217 USPQ 177 (TTAB 1983). The matter that is shown in broken (dotted) lines does not have to be disclaimed, because it does not form part of the mark. If the drawing does not meet the requirements of 37 C.F.R. §2.52, the examining attorney should require the applicant to submit a substitute drawing.

If an acceptable statement describing the mark is not in the record, the examining attorney *must* require the applicant to submit a description to clarify what the applicant seeks to register. The description of the mark should include a statement that the matter shown in broken lines is not part of the mark. *See* 37 C.F.R. §§2.37, 2.52(a)(2)(iii) and 2.52(a)(2)(vi); TMEP §§808 *et seq.* The description is printed in the *Official Gazette* and on the registration certificate. Examples of acceptable language are, “The mark consists of the design of the blade portion of a flyswatter,” and “The mark consists of the design of a perfume or cologne bottle and cap therefor, both having a ‘V’ shape as viewed from above.” The description must adequately describe the mark, with unnecessary matter kept to a minimum. If applicable, the description must clearly indicate the portion of the product or container that the mark comprises. An example of acceptable language for this purpose is, “The mark consists of a red button positioned on the lower front area of a shirt. The dotted outline of the shirt is not part of the mark but is merely intended to show the position of the mark.” As in this example, the description should make it clear what the dotted lines represent. The examining attorney should indicate in the file that the description statement should be printed.

See TMEP §1202.05(d)(i) and (d)(ii) regarding drawings in applications for color marks consisting solely of one or more colors.

1202.02(e) Trade Dress in Intent-to-Use Applications

Distinctiveness and Product Design

A product design trademark can never be inherently distinctive and is registrable only upon a showing of secondary meaning. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 212, 54 USPQ2d 1065, 1069 (2000); TMEP §1202.02(b)(i). Therefore, if the mark is comprised of a product design, the examining attorney will refuse registration on the Principal Register on the ground that the proposed mark consists of a nondistinctive product design under 15 U.S.C. §§1051, 1052 and 1127. The examining attorney will make this refusal even in an intent-to-use application under 15 U.S.C. §1051(b) for which no statement of use or amendment to allege use has been filed.

Distinctiveness and Product Packaging

If the mark comprises product packaging trade dress for goods or services, the examining attorney must determine whether the mark is inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992). This requires consideration of the context in which the mark is used and the impression it would make on purchasers. Generally, no refusal based on lack of inherent

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distinctiveness will be issued in an intent-to-use application until the applicant has submitted specimens with an amendment to allege use or a statement of use. However, if appropriate, the examining attorney has discretion to issue this refusal before specimens are submitted.

Functionality

To determine whether a proposed mark is functional, the examining attorney must consider how the asserted mark is used. Generally, in a §1(b) application the examining attorney will not issue a refusal on the ground that the mark is functional until the applicant has filed either an amendment to allege use under §1(c), or a statement of use under §1(d), 15 U.S.C. §§1051(c) or (d).

Advisory Statement

In a §1(b) application for which no specimens have been submitted, if the examining attorney anticipates that a refusal based on functionality or nondistinctive trade dress will be made, the potential refusal should be brought to the applicant's attention in the first action issued by the Office. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the Office is not precluded from refusing registration on this basis.

1202.03 Refusal on Basis of Ornamentation

Subject matter that is merely a decorative feature does not identify and distinguish the applicant's goods and, thus, does not function as a trademark. A decorative feature may include words, designs, slogans or other trade dress. This matter should be refused registration because it is merely ornamentation and, therefore, does not function as a trademark as required by §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127.

Generally, the ornamentation refusal applies only to trademarks, not to service marks. See TMEP §§1301.02 *et seq.* regarding matter that does not function as a service mark.

Matter that serves primarily as a source indicator, either inherently or as a result of acquired distinctiveness, and that is only incidentally ornamental or decorative, can be registered as a trademark. *In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 184 USPQ 345 (C.C.P.A. 1975); *In re Paramount Pictures Corp.*, 213 USPQ 1111 (TTAB 1982).

With regard to registrability, ornamental matter may be categorized along a continuum ranging from ornamental matter that is registrable on the Principal Register, to purely ornamental matter that is incapable of trademark significance and unregistrable under any circumstances, as follows:

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- (1) Ornamental matter that serves as an identifier of a “secondary source” is considered an arbitrary symbol and is registrable on the Principal Register. For example, ornamental matter on a T-shirt (*e.g.*, the designation “NEW YORK UNIVERSITY”) can convey to the purchasing public the “secondary source” of the T-shirt (rather than the manufacturing source). Thus, even where the T-shirt is distributed by a party other than that identified by the designation, sponsorship or authorization by the identified party is indicated. *See* TMEP §1202.03(c).
- (2) Ornamental matter that is neither inherently distinctive nor a secondary source indicator may be registered on the Principal Register under §2(f) if the applicant establishes that the subject matter has acquired distinctiveness as a mark in relation to the goods. *See* TMEP §1202.03(d).
- (3) Ornamental matter that is neither inherently distinctive nor an indicator of secondary source, and has not acquired distinctiveness, but is capable of attaining trademark significance, may be registered on the Supplemental Register.
- (4) Some matter is determined to be purely ornamental and thus incapable of trademark significance and unregistrable on either the Principal Register or the Supplemental Register. *See* TMEP §1202.03(a).

The examining attorney should consider the following factors to determine whether ornamental matter can be registered: (1) the commercial impression of the proposed mark; (2) the relevant practices of the trade; (3) secondary source, if applicable; and (4) evidence of distinctiveness. These factors are discussed in the following sections.

1202.03(a) Commercial Impression

The examining attorney must determine whether the overall commercial impression of the proposed mark is that of a trademark. Matter that is purely ornamental or decorative does not function as a trademark and is unregistrable on either the Principal Register or the Supplemental Register.

The significance of the proposed mark is a factor to consider when determining whether ornamental matter serves a trademark function. Common expressions and symbols (*e.g.*, the peace symbol, “smiley face,” or the phrase “Have a Nice Day”) are normally not perceived as marks.

The examining attorney must also consider the size, location and dominance of the proposed mark, as applied to the goods, to determine whether ornamental matter serves a trademark function. *In re Dimitri’s Inc.*, 9 USPQ2d 1666, 1667 (TTAB 1988); *In re Astro-Gods Inc.*, 223 USPQ 621, 623 (TTAB 1984). A small, neat and discrete word or design feature (*e.g.*, small design of animal over pocket or breast portion of shirt) may be likely to create the commercial impression of a trademark, whereas a larger rendition of the same matter emblazoned across the front of a garment (or a tote bag, or the like) may be likely to be perceived merely as a

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decorative or ornamental feature of the goods. However, a small, neat and discrete word or design feature will not necessarily be perceived as a mark in all cases.

1202.03(b) Practices of the Trade

In determining whether a proposed mark is inherently distinctive, factors to be considered include whether the subject matter is unique or unusual in a particular field or whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods that would be viewed by the public as a dress or ornamentation for the goods. *See, e.g., In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 184 USPQ 345 (C.C.P.A. 1975) (pentagon-shaped repetitive design applied to the entire surface of soccer balls); *In re General Tire & Rubber Co.*, 404 F.2d 1396, 160 USPQ 415 (C.C.P.A. 1969) (three narrow white concentric rings of approximately equal width applied to the outer surface of a dark sidewall tire); *In re Chung, Jeanne & Kim Co., Inc.*, 226 USPQ 938 (TTAB 1985) (stripe design applied to sides of sport shoes)).

Even if a proposed mark is not inherently distinctive, it may be registered on the Principal Register if it has become distinctive of the applicant's goods in commerce. *See* TMEP §1202.03(d). The practices of the trade may be relevant in assessing the applicant's burden of proving that the proposed mark has become distinctive. Typically, more evidence is required if the proposed mark is a type of ornamental matter used so frequently in the relevant industry that consumers would be less apt to discern a source-indicating significance from its use. *See Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 USPQ 288 (TTAB 1969) (cornflower design recognized as a trademark for coffee percolators and culinary vessels and utensils). *Cf. In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451, 1454 (TTAB 1987) (affirming refusal to register design of morning glories and leaves for tableware, the Board noting that the design "has not been shown to be other than another decorative pattern without trademark significance....").

If the applicant cannot show that the proposed mark has acquired distinctiveness, the mark may be registered on the Supplemental Register if it is "capable of distinguishing the applicant's goods or services." 15 U.S.C. §1091. The practices of the trade may be relevant in determining a proposed mark is capable of distinguishing the goods or services. If the practices of the trade suggest that certain matter performs the function of a trademark by signifying to purchasers and prospective purchasers the goods of a particular entity and distinguishing the goods from those of others (*e.g.*, design on hip pockets of jeans or design on athletic shoes), the matter is assumed to be capable of distinguishing the applicant's goods and, therefore, may be registered on the Supplemental Register. *See In re Todd Co., Inc.*, 290 F.2d 597, 129 USPQ 408 (C.C.P.A. 1961) (repeating pattern of green lines, used to cover the entire back surface of safety paper products (*e.g.*, checks), held registrable on the Supplemental Register for safety paper products, where the record showed that it had long been the practice in the industry to use distinctive overall surface designs to indicate origin of the products).

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1202.03(c) “Secondary Source”

To show that a proposed mark that is used on the goods in a decorative or ornamental manner also serves a source-indicating function, the applicant may submit evidence that the proposed mark would be recognized as a mark through its use with goods or services other than those identified in the application. To show secondary source, the applicant may show: (1) ownership of a U.S. registration on the Principal Register of the same mark for other goods or services based on use in commerce under §1 of the Trademark Act; (2) non-ornamental use of the mark in commerce on other goods or services; or (3) ownership of a pending use-based application for the same mark, used in a non-ornamental manner, for other goods or services. Ownership of an intent-to-use application for which no allegation of use has been filed is not sufficient to show secondary source. If the applicant establishes that the proposed mark serves as an identifier of a secondary source, the matter is registrable on the Principal Register.

See In re Paramount Pictures Corp., 213 USPQ 1111 (TTAB 1982), in which MORK & MINDY was held registrable for decals, because applicant had a television series of that name and had previously registered MORK & MINDY for various goods and services. The Board found that the *primary* significance of the term MORK & MINDY to a prospective purchaser of decals was to indicate the television series and the principal characters of the television series. *Id.* at 1112. The Board held that the case was controlled by its decision in *In re Olin Corp.*, 181 USPQ 182 (TTAB 1973) (stylized “O” design registrable for T-shirts, where applicant had previously registered the “O” design for skis), in which that Board had stated:

It is a matter of common knowledge that T-shirts are “ornamented” with various insignia ... or ... various sayings such as “Swallow Your Leader.” In that sense what is sought to be registered could be construed to be ornamental. If such ornamentation is without any meaning other than as mere ornamentation it is apparent that the ornamentation could not and would not serve as an indicia of source. Thus, to use our own example, “Swallow Your Leader” probably would not be considered as an indication of source.

The “ornamentation” of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source....

181 USPQ at 182.

In *Paramount*, applying the test set forth in *Olin*, the Board found that “the paired names ‘MORK & MINDY,’ while certainly part of the ornamentation of the decal, also indicate source or origin in the proprietor of the Mork & Mindy television series in the same sense as the stylized ‘O’ in *Olin*.” 213 USPQ at 1113. The Board noted that “while purchasers may be accustomed to seeing characters’ names and images as part of the ornamentation of decals, T-shirts and the like, they are also accustomed to seeing characters’ names and images used as trademarks to indicate source” *Id.* at 1114.

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See also In re Watkins Glen International, Inc., 227 USPQ 727 (TTAB 1985) (stylized checkered flag design registrable for patches and clothing items, where applicant had previously registered WATKINS GLEN and checkered flag design (with “WATKINS GLEN” disclaimed) for services); *In re Expo ‘74*, 189 USPQ 48 (TTAB 1975) (EXPO ‘74 registrable for handkerchiefs and T-shirts, where applicant, organizer of the 1974 World’s Fair, had previously registered EXPO ‘74 for goods and services).

A series of ornamental uses of the subject matter on various items will not establish that the subject matter functions as an indicator of secondary source; use as a trademark for the other goods or services must be shown. *See In re Astro-Gods Inc.*, 223 USPQ 621 (TTAB 1984) (refusal to register ASTRO GODS and design for T-shirts affirmed despite applicant’s ornamental use of the proposed mark on other goods and appearance of applicant’s trade name “Astro Gods Inc.” on the T-shirt as part of a copyright notice).

1202.03(d) Evidence of Distinctiveness

As noted above, even if a proposed mark is not inherently distinctive, it may nevertheless be registered on the Principal Register under §2(f), 15 U.S.C. §1052(f), if it becomes distinctive of the applicant’s goods in commerce. *See* TMEP §§1212 *et seq.* regarding acquired distinctiveness.

1202.03(e) Ornamentation with Respect to Intent-to-Use Applications

Generally, the issue of ornamentation is tied to the use of the mark as evidenced by the specimens. Therefore, no ornamentation refusal will be issued in an intent-to-use application until the applicant has submitted specimens of use with either an amendment to allege use under §1(c), or a statement of use under §1(d), 15 U.S.C. §§1051(c) or (d).

1202.03(f) Ornamentation: Case References

The following cases show the various ways in which ornamental matter was found not to function as a mark.

1202.03(f)(i) Slogans or Words Used on the Goods

Slogans or phrases used on items such as t-shirts and sweatshirts, jewelry, and ceramic plates have been refused registration as ornamentation that purchasers will perceive as conveying a message rather than indicating source of the goods. *See Damn I’m Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 212 USPQ 684 (S.D.N.Y. 1981) (“DAMN I’M GOOD,” inscribed in large letters on bracelets and used on hang tags affixed to the goods, found to be without any source-indicating significance); *In re Pro-Line Corp.*, 28 USPQ2d 1141 (TTAB 1993) (BLACKER THE COLLEGE SWEETER THE KNOWLEDGE primarily ornamental slogan that is not likely to be

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perceived as source indicator); *In re Dimitri's Inc.*, 9 USPQ2d 1666 (TTAB 1988) (“SUMO,” as used in connection with stylized representations of sumo wrestlers on applicant’s T-shirts and baseball-style caps); *In re Astro-Gods Inc.*, 223 USPQ 621, 624 (TTAB 1984) (“[T]he designation ‘ASTRO GODS’ and design is not likely to be perceived as anything other than part of the thematic whole of the ornamentation of applicant’s shirts.”); *In re Original Red Plate Co.*, 223 USPQ 836 (TTAB 1984) (“YOU ARE SPECIAL TODAY” for ceramic plates found to be without any source-indicating significance).

See also TMEP §1202.04 regarding informational matter.

1202.03(f)(ii) Designs Used on the Goods

See *In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 184 USPQ 345 (C.C.P.A. 1975) (evidence of record insufficient to establish distinctiveness of pentagon-shaped repetitive design applied to the entire surface of soccer balls); *In re General Tire & Rubber Co.*, 404 F.2d 1396, 160 USPQ 415 (C.C.P.A. 1969) (three narrow white concentric rings of approximately equal width applied to the outer surface of a dark sidewall tire considered just a refinement of a general ornamental concept rather than a trademark); *In re David Crystal, Inc.*, 296 F.2d 771, 132 USPQ 1 (C.C.P.A. 1961) (two parallel colored bands at the top of the sock, the upper band red and the lower band blue, for men’s ribbed socks); *In re Sunburst Products, Inc.*, 51 USPQ2d 1843 (TTAB 1999) (combination of matching color of watch bezel and watch band and contrasting colors of watch case and watch bezel for sports watches found to be nothing more than a mere refinement of a common or basic color scheme for sports watches and therefore would not immediately be recognized or perceived as a source indicator); *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987) (floral pattern design of morning glories and leaves for tableware not distinctive and not shown to be other than decorative pattern without trademark significance).

1202.03(f)(iii) Trade Dress on the Containers for the Goods

See *In re J. Kinderman & Sons Inc.*, 46 USPQ2d 1253 (TTAB 1998) (design of container for Christmas decorations that resembles a wrapped Christmas gift not inherently distinctive); *In re F.C.F. Inc.*, 30 USPQ2d 1825 (TTAB 1994) (rose design used on cosmetics packaging is essentially ornamental or decorative background and does not function as mark); *In re Petersen Mfg. Co.*, 2 USPQ2d 2032 (TTAB 1987) (design representing the rear panel of a container for hand tools held unregistrable as merely ornamental, notwithstanding §2(f) claim).

1202.03(g) Ornamentation Cases and Acquired Distinctiveness

In the following cases, subject matter sought to be registered was found to have acquired distinctiveness as a trademark: *In re Jockey International, Inc.*, 192 USPQ 579 (TTAB 1976) (inverted Y design used on underwear found to have acquired distinctiveness, where evidence showed extensive use on packaging and in

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advertising in a manner calculated to draw the attention of prospective purchasers to the design and for them to look at the design as a badge of origin); *Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 USPQ 288 (TTAB 1969) (blue cornflower design for coffee percolators and culinary vessels and utensils found to have acquired distinctiveness, where evidence showed extensive and prominent use of the design in advertising, use of the design on pins and aprons worn by sales promotion representatives in the course of their duties, and surveys and statements of purchasers indicating that they recognized the design as indicating origin in applicant).

1202.04 Informational Matter

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998) (DRIVE SAFELY perceived as an everyday, commonplace safety admonition that does not function as mark); *In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) (THINK GREEN and design found unregistrable for weatherstripping and paper products, the Board stating, “[R]ather than being regarded as an indicator of source, the term ‘THINK GREEN’ would be regarded simply as a slogan of environmental awareness and/or ecological consciousness”); *In re Southbrook Entertainment Corp.*, 8 USPQ2d 1166 (TTAB 1988) (HI-YO-SILVER, for videotapes and cassettes, held to be a well known expression closely linked to a character, but did not function as a trademark for the goods); *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987) (PROUDLY MADE IN USA, for electric shavers, held incapable of functioning as a mark, notwithstanding use of letters “TM” in connection with prominent display of slogan on packages for the goods and claim of acquired distinctiveness); *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984) (WATCH THAT CHILD held not to function as a mark for construction material notwithstanding long use, where the only use was on the bumpers of construction vehicles in which the goods were transported); *In re Schwauss*, 217 USPQ 361 (TTAB 1983) (FRAGILE used on labels and bumper stickers does not function as a mark).

See TMEP §1301.02(a) regarding informational matter that does not function as a service mark, and TMEP §1202.03(f)(i) regarding slogans used on goods.

A slogan can function as a trademark if it is not merely descriptive or informational. See e.g., *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970) (affirming the Board’s dismissal of an opposition to the registration of HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE for a hair coloring preparation); *In re The Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967) (QUALITY THROUGH CRAFTSMANSHIP found registrable for radio equipment). See TMEP §1202.03(f)(i) regarding ornamental slogans used on goods.

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1202.05 Color as a Mark

Color marks are marks that consist *solely* of one or more colors used on particular objects. For marks used in connection with goods, the color may be used on the entire surface of the goods, on a portion of the goods, or on all or part of the packaging for the goods. For example, a color trademark might consist of purple used on a salad bowl, or pink used on the handle of a shovel, or a blue background and a pink circle used on all or part of a product package. *See Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) (green-gold used on dry cleaning press pads held to be a protectible trademark, where the color had acquired secondary meaning); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (the color pink as applied to fibrous glass residential insulation registrable where the evidence showed the color had acquired secondary meaning). Similarly, service marks may consist of color used on all or part of materials used in the advertising and rendering of the services.

The registrability of a color mark depends on the manner in which the proposed mark is used. *In re Owens-Corning*, 227 USPQ at 419, 774 F.2d at 1120. A color(s) takes on the characteristics of the object or surface to which it is applied, and the commercial impression of a color will change accordingly. *See In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001) (“a word mark retains its same appearance when used on different objects, but color is not immediately distinguishable as a service mark when used in similar circumstances”).

Color marks are never inherently distinctive, and cannot be registered on the Principal Register without a showing of acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000). *See* TMEP §1202.05(a) and cases cited therein.

Color, whether a single overall color or multiple colors applied in a specific and arbitrary fashion, is usually perceived as an ornamental feature of the goods or services. *In re Owens-Corning*, 227 USPQ at 422, 774 F.2d at 1124; *In re Hudson News Co.*, 39 USPQ2d 1915, 1923 (TTAB 1996), *aff’d per curiam*, 114 F.3d 1207 (Fed. Cir. 1997) (“blue motif” used in retail stores would likely be perceived by prospective purchasers as “nothing more than interior decoration” that “could be found in any number of retail establishments. Undoubtedly such features are usually perceived as interior decoration or ornamentation.”) However, color can function as a mark if it is used in the manner of a trademark/service mark and if it is perceived by the purchasing public to identify and distinguish the goods or services on or in connection with which it is used and to indicate their source. The United States Supreme Court has held that color alone may sometimes meet the basic legal requirements for a trademark. When it does, there is no rule that prevents color from serving as a mark. *Qualitex*, 514 U.S. at 161, 34 USPQ2d at 1162. If a color is not functional and is shown to have acquired distinctiveness on or in connection with the applicant’s goods or services, it is registrable as a mark.

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Functional color marks are not registrable. *See* TMEP §1202.05(b) and cases cited therein.

1202.05(a) Color Marks Never Inherently Distinctive

Color marks are never inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-163, 34 USPQ2d 1161, 1162-1163 (1995)); *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001). Therefore, the examining attorney must refuse to register a color mark on the Principal Register unless the applicant establishes that the mark has acquired distinctiveness under §2(f). The examining attorney must issue this refusal in *all* color mark applications where acquired distinctiveness has not been shown, regardless of the filing basis of the application. The ground for refusal is that the color is not inherently distinctive and thus does not function as a trademark under §§1, 2 and 45, or does not function as a service mark under §§1, 3 and 45.

If the proposed color mark is not functional, it may be registrable on the Principal Register if it is shown to have acquired distinctiveness under §2(f). If it is not distinctive, it is registrable only on the Supplemental Register. *See In re Hudson News Co.*, 39 USPQ2d 1915 (TTAB 1996), *aff'd per curiam*, 114 F.3d 1207 (Fed. Cir. 1997) (“blue motif” applied to retail store services not registrable on Principal Register without resort to Section 2(f)); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142 (TTAB 1990) (the color green, as uniformly applied to medical instruments, not barred from registration on the basis of functionality; however, evidence failed to establish that the color had become distinctive of the goods); *In re Deere & Co.*, 7 USPQ2d 1401 (TTAB 1988) (the colors green and yellow, as applied to body and wheels of machines, respectively, not barred from registration on the basis of functionality; evidence held to establish that the colors had become distinctive of the goods).

The burden of proving that a color mark has acquired distinctiveness is substantial. *See In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (the color pink, as uniformly applied to fibrous glass residential insulation, shown to have acquired distinctiveness as a trademark for the goods); *In re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB 1998) (evidence insufficient to establish that green rectangular background design had acquired distinctiveness as applied to clothing and footwear); *In re American Home Products Corp.*, 226 USPQ 327 (TTAB 1985) (tri-colored, three-dimensional circular-shaped design found to have become distinctive of analgesic and muscle relaxant tablets); *In re Star Pharmaceuticals, Inc.*, 225 USPQ 209 (TTAB 1985) (evidence found insufficient to establish that two-colored drug capsules and multi-colored seeds or granules contained therein had become distinctive of methyltestosterone).

As noted above, the commercial impression of a color may change depending on the object to which it is applied. Therefore, evidence submitted to demonstrate acquired distinctiveness of a color may show consumer recognition with respect to certain

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objects, but not for other objects. *See In re Thrifty, Inc.*, 61 USPQ2d at 1124. *Cf. Qualitex*, 514 U.S. at 163, 34 USPQ2d at 1162-1163 (“The imaginary word ‘Suntost,’ or the words ‘Suntost Marmalade,’ on a jar of orange jam immediately would signal a brand or a product ‘source’; the jam’s orange color does not do so. But, over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm’s insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods -- *i. e.*, ‘to indicate’ their ‘source...’”)

1202.05(b) Functional Color Marks Not Registrable

A color mark is not registrable on the Principal Register under §2(f), or the Supplemental Register, if the color is functional. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985). A color may be functional if it yields a utilitarian or functional advantage, for example, yellow or orange for safety signs. *Brunswick Corp. v. British Seagull*, *supra* (holding the color black functional for outboard motors because while the color did not provide utilitarian advantages in terms of making the engines work better, it nevertheless provided recognizable competitive advantages in terms of being compatible with a wide variety of boat colors and making the engines appear smaller); *In re Ferris Corporation*, 59 USPQ2d 1587 (TTAB 2000) (color pink used on surgical wound dressings is functional because the actual color of the goods closely resembles Caucasian human skin); *In re Orange Communications, Inc.*, 41 USPQ2d 1036 (TTAB 1996) (colors yellow and orange held to be functional for public telephones and telephone booths, since they are more visible under all lighting conditions in the event of an emergency); *In re Howard S. Leight & Associates Inc.*, 39 USPQ2d 1058 (TTAB 1996) (color coral held to be functional for earplugs, because it is more visible during safety checks). A color may also be functional if it is more economical to manufacture or use. For example, a color may be a natural by-product of the manufacturing process for the goods. In such a case, appropriation of the color by a single party would place others at a competitive disadvantage by requiring them to alter the manufacturing process.

See also In re Pollak Steel Co., 314 F.2d 566, 136 USPQ 651 (C.C.P.A. 1963) (reflective color on fence found to be functional); *R.L. Winston Rod Co. v. Sage Mfg. Co.*, 838 F. Supp. 1396, 29 USPQ2d 1779 (D. Mont. 1993) (color green used on graphite fishing rods found to be functional); *Russell Harrington Cutlery Inc. v. Zivi Hercules Inc.*, 25 USPQ2d 1965 (D. Mass. 1992) (color white used on cutlery handles found to be functional); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501 (TTAB 1993) (color green used as wrapper for saw blades is functional when the color is one of the six colors used in a color-coding system to identify the type of blade).

The doctrine of “aesthetic functionality” may apply in some cases where the evidence indicates that the color at issue provides specific competitive advantages that, while

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not necessarily categorized as purely “utilitarian” in nature, nevertheless dictate that the color remain in the public domain. *Brunswick Corp. v. British Seagull, supra*. See also *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (in which the Supreme Court discussed aesthetic functionality, distinguishing *Qualitex, supra*, as a case where “aesthetic functionality was the central question...”). See TMEP §1202.02(a)(iii)(C) regarding the “aesthetic functionality” doctrine.

1202.05(c) Color as a Separable Element [R-1]

As with all trademarks, a color mark may contain only those elements that make a separable commercial impression. See TMEP §807.14(b). Accordingly, an applicant may not seek to register the color of the wording or design apart from the words or designs themselves if the color does not create a separate commercial impression. For example, an applicant may not register the color of words that make up its mark apart from the words themselves, if the color does not create a separate commercial impression apart from the words. However, the applicant may register the color of the background material on which the words or design appear apart from the words or design. See TMEP §1202.11.

The commercial impression of a color may change depending on the object to which it is applied. *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001); *In re Hayes*, 62 USPQ2d 1443 (TTAB 2002). An application seeking registration of color in the abstract, without considering the manner or context in which the color is used, would be contrary to law and public policy because it would result in an unlimited number of marks being claimed in a single application. Cf. *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 1368, 51 USPQ2d 1513, 1517-18 (Fed. Cir. 1999) (mark with changeable or “phantom” element unregistrable because it would “encompass too many combinations and permutations to make a thorough and effective search possible,” and, therefore, would not provide adequate notice to the public); *In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001) (hologram used on trading cards in varying shapes, sizes, contents and positions constitutes more than one “device” as contemplated by §45 of the Trademark Act). Only one mark can be registered in a single application. TMEP §807.04.

1202.05(d) Drawings of Color Marks Required

All marks, other than sound and scent marks, require a drawing. TMEP §807. An application for a color mark that is filed without a drawing will be denied a filing date. 37 C.F.R. §2.21(a)(3). Similarly, an application for a color mark with a proposed drawing page that states “no drawing” or sets forth only a written description of the mark will be denied a filing date. The drawing provides notice of the nature of the mark sought to be registered. Only marks that are not capable of representation in a drawing, such as sound or scent marks, are excluded from the requirement for a drawing. Color marks are visual, and should be depicted in a black

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and white drawing, accompanied by a detailed written description of the color and how it is used. 37 C.F.R. §2.52(a)(2)(v); TMEP §§807.09(a) and (c).

1202.05(d)(i) Drawings of Color Marks in Trademark Applications

In most cases, the drawing will consist of a representation of the product or product package. The drawing of the mark must be a substantially exact representation of the mark as used or intended to be used on the goods. 37 C.F.R. §2.51. A depiction of the object on which the color is used is needed to meet this requirement.

The object depicted on the drawing should appear in broken lines. The broken lines inform the viewer where and how color is used on the product or package, while at the same time making it clear that the shape of the product, or the shape of the package, is not claimed as part of the mark. 37 C.F.R. §2.52(a)(2)(ii); TMEP §807.10. In the absence of a broken-line drawing, the Office will assume that the mark is a composite mark consisting of the product shape, or the packaging shape, in a particular color.

Color used on multiple goods

If the mark is used on multiple goods, the drawing required will depend on the nature of the goods. The drawing of the mark must be a substantially exact representation of the mark as used or intended to be used on the goods. 37 C.F.R. §2.51. A drawing consisting of a depiction of only one of the goods will be accepted if the goods, or the portions of the goods on which color appears, are similar in form and function so that a depiction of only one of the products is still a substantially exact representation of the mark as used on all of the products. For example, if the mark is the color purple used on refrigerators and freezers, a drawing of a freezer (in broken lines, with a description of the mark indicating the color purple is used on the mark) would be sufficient. Or, if the mark is the color pink used on the handles of rakes, shovels and hoes, a drawing of any of those items (in dotted lines with a description of the mark stating the handle is pink) would be sufficient. Or, if the mark consists of packaging for various food items that is always blue with a pink circle, a drawing of any one of the packages (in dotted lines with a description of the colors) would be sufficient.

If the mark is used on multiple goods that are dissimilar or unrelated, or if color is used in different ways on different goods, so that a depiction of one of the goods is not a substantially exact representation of the mark as used on all of the goods (for example, the color purple used on microscopes and vending machines), a separate application must be submitted for each item.

Color used on liquids or powders

Sometimes a color mark consists of color(s) used on liquids or powders. For example, the mark might consist of fuchsia body oil or red, white and blue granular washing machine detergent. In these cases, the nature of the drawing will depend on the manner of use of the liquid or powder. If the liquid or powder is visible through the product package, then the drawing should consist of the shape of the product

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package in broken lines, with the description of the mark identifying the color of the liquid or powder.

1202.05(d)(ii) Drawings of Color Marks in Service Mark Applications

It is difficult to anticipate all of the issues that may arise, because there are a myriad of ways that color can be used in connection with services. However, the following general guidelines will be used to determine the sufficiency of drawings in these cases:

- The purpose of a drawing is to provide notice to the public of the nature of the mark. As with color used on goods, a color service mark does not consist of color in the abstract. Rather, the mark consists of color used in a particular manner, and the context in which the color is used is critical to provide notice of the nature of the mark sought to be registered. Therefore, as with color marks used on goods, a drawing, supplemented with a written description, is required.
- The drawing must display the manner in which the mark is used in connection with the services. As with any application, only one mark can be registered in a single application. TMEP §807.04. The mark depicted on the drawing must, as used on the specimens, make a separate and distinct commercial impression to be considered one mark. *See In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001); *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). *See* TMEP §1202.05(a) regarding color as a separable element.
- If color is used in a variety of ways, but in a setting that makes a single commercial impression, such as a retail outlet with various color features, a broken-line drawing of the setting must be submitted, with a detailed description of the color(s).
- If an applicant seeks to register a single color as a service mark used on a variety of items not viewed simultaneously by purchasers, *e.g.*, stationery, uniforms, pens, signs, shuttle buses, the store awning and the walls of the store, the drawing must display a solid-colored square with a dotted peripheral outline and include a detailed description of the mark. *Thrifty*, 274 F.3d at 1353, 61 USPQ2d at 1124. Applicant will receive a filing date for its application. However, as yet, the issues raised by the use of this type of drawing, *e.g.*, sufficient notice and phantom marks, have not yet been decided by the Office. *Cf. In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 1368, 51 USPQ2d 1513, 1517-18 (Fed. Cir. 1999). *See* TMEP §1202.05(c).
- The commercial impression of a color may change depending on the object on which it is applied. *See Thrifty*, 61 USPQ2d at 1124.

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1202.05(d)(iii) Drawings for Marks Including Both Color and Words or Design

Sometimes a product or advertisement for a service will include both color and words or a design. For example, the surface of a toaster might be green, with the trademark “ABC” and design displayed on the toaster. In this situation, the applicant must decide whether to seek registration for the color green used on toasters, the letters “ABC” with or without the design, the design, or some combination of those elements. If applicant only seeks registration for the use of the color, no word or design elements should appear on the drawing.

1202.05(e) Written Explanation of a Color Mark [R-1]

The drawing of a color mark must be supplemented with a written description of the mark, explaining the color(s) and where they appear on the mark. 37 C.F.R. §§2.37 and 2.52(a)(2)(v); TMEP §807.09(c).

The description of the mark must be clear and specific, use ordinary language, and identify the mark as consisting of the particular color as applied to the goods or services. This description of the mark must appear both in the heading of the drawing, and in the written application. If the color is applied only to a portion of the goods, the description must indicate the specific portion. Similarly, if the mark includes gradations of color, the description should so indicate. If the applicant is claiming a shade of color, the shade must be described in ordinary language, for example, “maroon,” “turquoise,” “navy blue,” “reddish orange.” This is required even if the applicant also describes the color using a commercial coloring system.

The applicant may not amend the description of the mark if the amendment is a material alteration of the mark on the drawing filed with the original application. 37 C.F.R. §§2.52(a) and 2.72. *See In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001); *cf. In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997). *See* TMEP §807.14(a) regarding material alteration.

The description of a color mark must be limited to a single mark, because only one mark can be registered in a single application. *See In re International Flavors & Fragrances Inc.*, 83 F.3d 1361 51 USPQ2d 1513 (Fed. Cir. 1999); *In re Hayes*, 62 USPQ2d 1443 (TTAB 2002). *See* TMEP §1202.05(a) regarding color as a separable element. *Cf.* TMEP §807.04 (drawing must be limited to a single mark).

1202.05(f) Specimens for Color Marks

An application for a color mark must be supported by a specimen that shows use of the color mark depicted in the drawing. Therefore, an applicant who applies to register a color mark must submit a specimen showing use of color, either with a §1(a) application or with an allegation of use in a §1(b) application. If a black and white specimen is submitted, the examining attorney will require a substitute specimen. *See* TMEP §904.02(a).

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See TMEP §§904.04 *et seq.* regarding trademark specimens and TMEP §§1301.04 *et seq.* regarding service mark specimens.

1202.05(g) Special Considerations for Service Mark Applications

No service mark registrations have issued for a single color *per se*. Although the applicant in *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001) argued that it applied for the color blue *per se* as a service mark, the Court determined that the drawing controlled, such that the application was for the color blue applied to a building. Although the Court did not reach the issue of color *per se* as a service mark, the Court acknowledged the special evidentiary problem associated with showing acquired distinctiveness in this context. *Thrifty*, 274 F.3d at 1353, 61 USPQ2d at 1124 (“... [E]vidence submitted to demonstrate acquired distinctiveness of a color may show consumer recognition with respect to certain objects (e.g., blue vehicle rental centers), but not for other objects (e.g., blue rental cars)”). Accordingly, any claim to color *per se* needs to be specific as to use and include evidence of acquired distinctiveness for each claimed use.

1202.05(h) Applications for Color Marks Based on Intent-to-Use

As discussed in TMEP §1202.05, a color mark can never be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-163, 34 USPQ2d 1161, 1162-1163 (1995)); TMEP §1202.05. Therefore, the examining attorney must refuse to register a color mark on the Principal Register unless the applicant establishes that the mark has acquired distinctiveness under §2(f). The ground for refusal is that the color is not inherently distinctive and thus does not function as a trademark under §§1, 2 and 45, or does not function as a service mark under §§1, 3 and 45.

The issue of whether the proposed mark is functional requires consideration of the manner in which the mark is used. Generally, no refusal on these grounds will be issued in a §1(b) application until the applicant has submitted specimens of use with an amendment to allege use or statement of use. See TMEP §§1102.01, 1202.02(e) and 1202.03(e). In appropriate cases, the examining attorney will bring the potential refusal to the applicant’s attention in the initial Office action. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the Office is not precluded from refusing registration on this basis.

1202.06 Goods in Trade

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines a “trademark” as a “word, name, symbol, or device, or any combination thereof” that is used or intended to be used in commerce to *identify and distinguish his or her goods* (emphasis added).” Before rights in a term as a trademark can be established, the subject matter to which

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the term is applied must be “goods in trade.” Incidental items that an applicant uses in conducting its business (such as letterhead, invoices and business forms), as opposed to items sold or transported in commerce for use by others, are not “goods in trade.” See *In re Shareholders Data Corp.*, 495 F.2d 1360, 181 USPQ 722 (C.C.P.A. 1974) (reports not goods in trade, where applicant is not engaged in the sale of reports, but solely in furnishing financial reporting services, and reports are merely conduit through which services are rendered); *In re Compute-Her-Look, Inc.*, 176 USPQ 445 (TTAB 1972) (reports and printouts not goods in trade, where they are merely the means by which the results of a beauty analysis service is transmitted and have no viable existence separate and apart from the service); *Ex parte Bank of America National Trust and Savings Association*, 118 USPQ 165 (Comm’r Pats. 1958) (mark not registrable for passbooks, checks and other printed forms, where forms are used only as necessary tools in the performance of banking services, and the applicant is not engaged in printing or selling forms as commodities in trade).

1202.06(a) Goods Must Have Utility to Others

Affixing a mark to an item that is transported in commerce does not in and of itself establish that the mark is used on “goods.” While a formal sale is not always necessary, items sold or transported in commerce are not “goods in trade” unless they have utility to others as the type of product named in the application.

Example: Holiday greeting cards sent by a law firm to its clients are not “goods,” where applicant is merely sending its own cards through the mail as a holiday greeting, and the cards are not suitable for use by the recipients as a greeting card.

See *Gay Toys, Inc. v. McDonald’s Corp.*, 585 F.2d 1067, 199 USPQ 722 (C.C.P.A. 1978) (plaster mockup of toy truck not goods in trade, where there is no evidence the mockup is actually used as a toy); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994), *aff’d*, 108 F.3d 1392 (Fed. Cir. 1997) (mark not registrable for games, where purported games are advertising flyers used to promote applicant’s services and have no real utilitarian function or purpose as games); *In re Douglas Aircraft Co., Inc.*, 123 USPQ 271 (TTAB 1959) (books, pamphlets and brochures that serve only to explain and advertise the goods in which applicant deals are not “goods”). Cf. *In re Snap-On Tools Corp.*, 159 USPQ 254 (TTAB 1968) (ball point pens used to promote applicant’s tools are goods in trade, where they have a utilitarian function and purpose, and have been sold to applicant’s franchised dealers and transported in commerce under mark); *In re United Merchants & Manufacturers, Inc.*, 154 USPQ 625 (TTAB 1967) (calendar used to promote applicant’s plastic film constitutes goods in trade, where calendar has a utilitarian function and purpose in and of itself, and has been regularly distributed in commerce for several years).

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1202.06(b) Registration Must Be Refused if Trademark Not Used on Goods in Trade

If the specimens, identification of goods, or other evidence in the record indicate that the applicant uses the mark only on items incidental to conducting its own business, as opposed to items intended to be used by others, the examining attorney should refuse registration on the Principal Register under §§1, 2 and 45 of the Trademark Act; 15 U.S.C. §§1051, 1052 and 1127, on the ground that the mark is not used on “goods in trade.”

If a mark is not used on “goods in trade,” it is not registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f), or on the Supplemental Register.

If some, but not all of the items listed in the identification of goods are found not to be “goods in trade,” it is not necessary to refuse registration of the entire application, but the examining attorney should require that these items be deleted from the identification of goods.

1202.06(c) “Goods in Trade” in Intent-to-Use Applications

In an intent-to-use application under §1(b) of the Trademark Act, the question of whether a mark is used on goods in trade usually does not arise until the applicant files an allegation of use under §1(c) or §1(d) of the Act, because this issue is based on the manner in which the mark is used. However, if the identification of goods in an intent-to-use application includes items that do not appear to be goods in trade, the potential refusal should be brought to the applicant’s attention in the first action issued by the Office. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the Office is not precluded from refusing registration on this basis.

1202.07 Marks That Identify Columns or Sections of Publications

1202.07(a) Marks That Identify Columns or Sections of Printed Publications

A column, section or supplement of a printed publication is normally not considered to be separate “goods” or “goods in trade” unless it is sold, syndicated, or offered for syndication separate and apart from the larger publication in which it appears. *In re Broadcasting Publications, Inc.*, 135 USPQ 374 (TTAB 1962); *Ex parte Meredith Publishing Co.*, 109 USPQ 426 (Comm’r Pats. 1956). This is true even of a removable or separable “pullout” section of a newspaper or other publication. In *Meredith*, the issue was analyzed as follows:

The basic question is whether or not, under the circumstances of use, the section title is a name adopted and used by the publisher to identify his goods and distinguish them from those of others. The “goods” actually are magazines-not sections of magazines. When the magazine is

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purchased, the purchaser receives the sections whether he wants them or not, and it is doubtful that magazine readers *ordinarily* purchase a magazine merely to receive a section of it, or think of a magazine merely in terms of a section title. Sections of magazines are not in and of themselves articles of commerce other than as a part of an integrated whole; and we must therefore be concerned with whether a section title actually identifies and distinguishes, and if so, what it distinguishes. Under these circumstances it becomes necessary to ask: Was the mark adopted to identify a section of applicant's magazine and distinguish it from sections of other publishers' magazines, or was it adopted to distinguish one section of applicant's magazine from the other sections of its magazine? *Ordinarily*, it is the latter (emphasis in original).

109 USPQ 426.

1202.07(a)(i) Syndicated Columns and Sections

Columns or sections that are separately sold, syndicated, or offered for syndication do constitute goods in trade. A mark that identifies a column or section that is separately syndicated or offered for syndication is registrable on the Principal Register without resort to §2(f) of the Trademark Act, 15 U.S.C. §1052(f), if registration is not barred by other sections of the Act.

1202.07(a)(ii) Non-Syndicated Columns and Sections

A column or section of a printed publication that is not separately sold, syndicated, or offered for syndication is not, in and of itself, considered to be separate goods in trade. Therefore, where the specimens, identification of goods, or other evidence in the record indicates that the mark identifies a column or section of a printed publication that is not separately sold, syndicated, or offered for syndication, the examining attorney should refuse registration on the Principal Register under §§1, 2 and 45 of the Trademark Act; 15 U.S.C. §§1051, 1052 and 1127, on the ground that the mark is not used on separate goods in trade.

Marks that identify non-syndicated columns or sections of printed publications are registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f), if the column or section is shown to have acquired separate recognition and distinctiveness. The applicant who seeks registration on the Principal Register bears the burden of establishing, through evidence of promotion, long use, advertising expenditures, and breadth of distribution or sales figures, that the public has come to recognize the proposed mark as an indicator of source.

The evidence of acquired distinctiveness must show that the column or section title is used and promoted to distinguish applicant's column or section from the columns or sections of other publishers' publications rather than merely to distinguish applicant's column or section from other columns or sections of applicant's publication. *Metro*

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Publishing v. San Jose Mercury News, 987 F.2d 637, 25 USPQ2d 2049 (9th Cir. 1993); *In re Broadcasting Publications, Inc.*, 135 USPQ 374 (TTAB 1962).

The amount of evidence needed to establish distinctiveness must be evaluated by the examining attorney on a case-by-case basis, in light of the type of column or supplement. If the mark identifies a removable or pull-out section, a lesser degree of evidence might be required to establish distinctiveness. Of course, the amount of evidence needed to establish distinctiveness in any particular case will also vary depending on the strength or weakness of the mark. TMEP §1212.04(a).

Marks that identify non-syndicated columns or sections of printed publications, but have not yet acquired distinctiveness and therefore are not registrable under §2(f) of the Act, are registrable on the Supplemental Register, if registration is not barred by other sections of the Act. *Ex parte Meredith Publishing Co.*, 109 USPQ 426 (Comm'r Pats. 1956).

1202.07(a)(iii) Marks That Identify Columns and Sections of Printed Publications in Intent-to-Use Applications

Since a refusal to register a mark that identifies a column or section of a printed publication is based on whether the column or section is separately sold or syndicated, the issue ordinarily does not arise in an intent-to-use application under §1(b) of the Trademark Act, 15 U.S.C. §1051(b), until the applicant has filed either an amendment to allege use under §1(c), or a statement of use under §1(d), 15 U.S.C. §§1051(c) and (d). However, if the identification of goods indicates that the mark is intended to be used to identify a column or section of a printed publication that is not separately sold or syndicated, the potential refusal on the ground that the proposed mark is not used on separate goods in trade should be brought to the applicant's attention in the first Office Action. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant prior to the filing of the allegation of use, the Office is not precluded from refusing registration on this basis.

1202.07(b) Marks That Identify Columns and Sections of On-Line Publications

An on-line publication is considered a service rather than a product. Therefore, refusal of registration on the ground that the proposed mark is not used on goods in trade is inappropriate. Unlike a printed column or section, an on-line column or section can be accessed directly and can exist independent of any single publication. *See Ludden v. Metro Weekly*, 8 F. Supp.2d 7, 47 USPQ2d 1087, 1093 (D.D.C. 1998). Therefore, a mark that identifies an on-line column is registrable on the Principal Register without resort to §2(f) of the Trademark Act, 15 U.S.C. §1052(f), if registration is not barred by other sections of the Act.

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1202.08 Title of a Single Creative Work

The title of a single creative work is not registrable on the Principal Register or the Supplemental Register. Examples of “single creative works” include books, videotapes, films and theatrical performances. *In re Cooper*, 254 F.2d 611, 615-16, 117 USPQ 396, 400 (C.C.P.A. 1958), *cert. denied*, 358 U.S. 840, 119 USPQ 501 (1958) (“A book title ... identifies a specific literary work ... and is not associated in the public mind with the publisher, printer or bookseller....”); *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998) (title of a live theater production held unregistrable); *In re Hal Leonard Publishing Corp.*, 15 USPQ2d 1574 (TTAB 1990) (INSTANT KEYBOARD, as used on music instruction books, found unregistrable as the title of a single work); *In re Appleby*, 159 USPQ 126 (TTAB 1968) (title of single phonograph record, as distinguished from series, does not function as mark).

The name of a series of books or other creative works may be registrable if it serves to identify and distinguish the source of the goods. *In re Scholastic Inc.*, 23 USPQ2d 1774, 1778 (TTAB 1992) (THE MAGIC SCHOOL BUS, prominently displayed on the cover of a series of books, has come to represent a source to purchasers and would be recognized as a trademark). However, a term used in the title of a series of books is not registrable if it merely identifies a character in the books. *In re Scholastic Inc.*, 223 USPQ 431 (TTAB 1984) (THE LITTLES, used in the title of each in a series of children’s books, does not function as a mark where it merely identifies the main characters in the books). *Cf. In re Caserta*, 46 USPQ2d 1088 (TTAB 1998) (FURR-BALL FURCANIA, used as the principal character in a single children’s book, was found not to function as a mark even though the character’s name appeared on the cover and every page of the story); *In re Frederick Warne & Co. Inc.*, 218 USPQ 345 (TTAB 1983) (an illustration of a frog used on the cover of a single book served only to depict the main character in the book and did not function as a trademark).

See TMEP §1301.02(d) regarding the registrability of titles of radio and television programs as service marks, and TMEP §1202.09(a) regarding the registrability of the names of performing artists on sound recordings.

1202.09 Names of Artists and Authors

Generally, subject matter used solely as an author’s name, even on multiple books, does not function as a trademark. See *In re Chicago Reader Inc.*, 12 USPQ2d 1079 (TTAB 1989) (CECIL ADAMS, as used on the specimens, merely identifies the author and is not used as a trademark). *Cf. In re Wood*, 217 USPQ 1345 (TTAB 1983) (artist’s pseudonym YSABELLA, affixed to an original work of art, functioned as a trademark).

See TMEP §1202.09(a) regarding the registrability of the names of performing artists used on sound recordings.

See also TMEP §1301.02(b) regarding the registrability of the names of characters and personal names as service marks.

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1202.09(a) Names of Performing Artists Used on Sound Recordings

Subject matter that, as used on sound recordings, *merely* serves to identify the artist or artists whose performance comprises the content of the recording is not registrable as a trademark for the recordings. *In re Spirer*, 225 USPQ 693 (TTAB 1985). As noted by the Court of Appeals for the Federal Circuit in *In re Polar Music International AB*, 714 F.2d 1567, 1572, 221 USPQ 315, 318 (Fed. Cir. 1983), “just showing the name of the recording group on a record will not by itself enable that name to be registered as a trademark. Where, however, the owner of the mark controls the quality of the goods, and where the name of that recording group has been used numerous times on different records and has therefore come to represent an assurance of quality to the public, the name may be registered as a trademark since it functions as one.” Personal names of individuals or groups function as service marks for entertainment services only if they identify and distinguish the services recited and not merely the individual or group. *See* TMEP §1301.02(b).

The following guidelines must be followed to ensure consistent action on applications to register the names of performers for sound recordings in accordance with *In re Polar Music International AB* and *In re Spirer*.

First, the names of performers may only be registered as a trademark if the mark is used on a series of sound recordings. The identification of goods must specifically indicate that there is a series. If the application does not identify the goods in this fashion, the examining attorney must require an appropriate amendment.

Secondly, the applicant must provide evidence that the mark has been applied to at least two different recordings in the series. In an intent-to-use application, the applicant must provide evidence of use on at least two recordings at the time the applicant files either the amendment to allege use or the statement of use. It is advisable to provide advance notice of this requirement during initial examination, where appropriate. If the applicant is unable to demonstrate use on a series, the mark may be registered on the Supplemental Register, provided it is otherwise proper. These procedures apply specifically to performers’ names used on recordings and not to other types of marks used on other types of artistic material.

Finally, it is only necessary to inquire about the applicant’s control over the nature and quality of the goods if information in the application record clearly contradicts the applicant’s verified statement that it is the owner of the mark or entitled to use the mark.

Similarly, the name of a performer is not registrable as a service mark for entertainment services unless the record shows the name identifies a continuing series of presentations, performances or recordings. *See* TMEP §1301.02(d).

1202.10 Model or Grade Designations

Subject matter used solely as a model, style or grade designation within a product line does not function as a trademark. *In re Dana Corp.*, 12 USPQ2d 1748 (TTAB 1989)

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(alphanumeric designations, such as “5-469X,” held unregistrable for universal joint couplings; evidence insufficient to establish distinctiveness and recognition as a mark). *Cf. In re Clairol Inc.*, 457 F.2d 509, 173 USPQ 355 (C.C.P.A. 1972) (SWEDISH CRYSTAL found to be a registrable trademark, not merely a color designation, for a hair coloring preparation, the Court relying on the arbitrariness of the mark, its manner of use and the fact that it was always used in addition to a shade designation); *In re Petersen Mfg. Co., Inc.*, 229 USPQ 466, 468 (TTAB 1986) (letter-number combinations found registrable for locking hand tools, the Board stating, “[T]here is no question that such model designations can, through use and promotion, be perceived as marks indicating origin in addition to functioning as model designations.”)

1202.11 Background Designs and Shapes

“A background design which is always used in connection with word marks must create a commercial impression on buyers separate and apart from the word marks for the design to be protectible as a separate mark. In deciding whether the design background of a word mark may be separately registered, the essential question is whether or not the background material is or is not inherently distinctive.... If the background portion is inherently distinctive, no proof of secondary meaning need be introduced; if not, such proof is essential (citations omitted).” *In re Chemical Dynamics, Inc.*, 839 F.2d 1569, 1570-1571, 5 USPQ2d 1828, 1829 (Fed. Cir. 1988).

Common geometric shapes, when used as vehicles for the display of word marks, are not regarded as indicators of origin absent evidence of distinctiveness of the design alone. Additionally, the Supreme Court stated in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) that color can never be inherently distinctive.

In the following cases, the evidence of distinctiveness was insufficient: *In re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB 1998) (green rectangular background design not inherently distinctive; evidence of acquired distinctiveness found insufficient); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380 (TTAB 1988) (parallelogram designs used as background for word marks found not inherently distinctive; evidence of record held insufficient to establish acquired distinctiveness pursuant to §2(f)); *In re Kerr-McGee Corp.*, 190 USPQ 204 (TTAB 1976) (affirming refusals to register escutcheon design used as a frame or border for words, under §2(f)).

In the following cases, the evidence of distinctiveness was sufficient: *In re Schenectady Varnish Co., Inc.*, 280 F.2d 169, 126 USPQ 395 (C.C.P.A. 1960) (where use of applicant’s design of a cloud and a lightning flash was always used as a background for the word “SCHENECTADY,” evidence of record found sufficient to show acquired distinctiveness of the design alone as a trademark for synthetic resins); *In re Raytheon Co.*, 202 USPQ 317 (TTAB 1979) (light-colored oval within black rectangular carrier considered not inherently distinctive; evidence of record found sufficient to establish acquired distinctiveness).

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An applicant may respond to a refusal to register by submitting evidence that the subject matter has acquired distinctiveness, under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). The examining attorney should scrutinize any submission that asserts distinctiveness solely on the basis of a statement of substantially exclusive and continuous use for five years to determine whether it truly establishes that the subject matter is perceived as a trademark by the purchasing public. The examining attorney may continue to refuse registration if he or she believes that the applicant's assertion does not establish that the matter is perceived as a trademark. The applicant may submit additional evidence to establish distinctiveness. *See* TMEP §§1212 *et seq.*

1202.12 Varietal and Cultivar Names (Examination of Applications for Seeds and Plants)

Varietal or cultivar names are designations given to cultivated varieties or subspecies of live plants or agricultural seeds. They amount to the generic name of the plant or seed by which such variety is known to the public. These names can consist of a numeric or alphanumeric code or can be a “fancy” (arbitrary) name. The terms “varietal” and “cultivar” may have slight semantic differences but pose indistinguishable issues and are treated identically for trademark purposes.

Subspecies are types of a particular species of plant or seed that are members of a particular genus. For example, all maple trees are in the genus *Acer*. The sugar maple species is known as *Acer saccharum*, while the red maple species is called *Acer rubrum*. In turn, these species have been subdivided into various cultivated varieties that are developed commercially and given varietal or cultivar names that are known to the public.

If the examining attorney determines that wording sought to be registered as a mark for live plants or agricultural seeds comprises a varietal or cultivar name, the examining attorney must refuse registration, or require a disclaimer, on the ground that the matter is the varietal name of the goods and does not function as a trademark under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127. *See Dixie Rose Nursery v. Coe*, 131 F.2d 446, 55 USPQ 315 (D.C. Cir. 1942), *cert. denied* 318 U.S. 782, 57 USPQ 568 (1943); *In re Hilltop Orchards & Nurseries, Inc.*, 206 USPQ 1034 (TTAB 1979); *In re Farmer Seed & Nursery Co.*, 137 USPQ 231 (TTAB 1963); *In re Cohn Bodger & Sons Co.*, 122 USPQ 345 (TTAB 1959). Likewise, if the mark identifies the prominent portion of a varietal name, it must be refused. *In re Delta and Pine Land Co.*, 26 USPQ2d 1157 (TTAB 1993) (Board affirmed refusal to register DELTAPINE, which was a portion of the varietal names Deltapine 50, Deltapine 20, Deltapine 105 and Deltapine 506).

A varietal or cultivar name is used in a plant patent to identify the variety. Thus, even if the name was originally arbitrary, it “describe[s] to the public a [plant] of a particular sort, not a [plant] from a particular [source].” *Dixie Rose*, 131 F.2d at 447, 55 USPQ at 316. It is against public policy for any one supplier to retain exclusivity in a patented variety of plant, or the name of a variety, once its patent expires. *Id.*

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Market realities and lack of laws concerning the registration of varietal and cultivar names have created a number of problems in this area. Some varietal names are not attractive or easy to remember by the public. As a result, many arbitrary terms are used as varietal names. Problems arise when trademark registration is sought for varietal names, when arbitrary varietal names are thought of as being trademarks by the public, and when terms intended as trademarks by plant breeders become generic through public use. These problems make this a difficult area for the examining attorney in terms of gathering credible evidence and knowing when to make refusals.

Whenever an application is filed to register a mark containing wording for live plants or agricultural seeds, the examining attorney must inquire of the applicant whether the term has ever been used as a varietal name, and whether such name has been used in connection with a plant patent, a utility patent, or a certificate for plant variety protection. *See* 37 C.F.R. §2.61(b). The examining attorney should also undertake an independent investigation of any evidence that would support a refusal to register, using sources of evidence that are appropriate for the particular goods specified in the application (*e.g.*, laboratories and repositories of the United States Department of Agriculture, plant patent information from the United States Patent and Trademark Office, a variety name search of plants certified under the Plant Variety Protection Act listed at www.ars-grin.gov/npgs/searchgrin.html).

1202.13 Scent or Fragrance

The scent of a product may be registrable if it is used in a non-functional manner. *See In re Clarke*, 17 USPQ2d 1238 (TTAB 1990), in which the Trademark Trial and Appeal Board held that a scent functioned as a mark for “sewing thread and embroidery yarn.” Scents that serve a utilitarian purpose, such as the scent of perfume, would be functional and not registrable. *See, generally*, TMEP §1202.02(a) regarding functionality. When a scent is not functional, it may be registered on the Principal Register under §2(f), or on the Supplemental Register. The amount of evidence required to establish that a scent or fragrance functions as a mark is substantial. *Cf. In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985).

The requirement for a drawing does not apply to scent marks. 37 C.F.R. §2.52(a)(3). *See* TMEP §807.11.

1202.14 Holograms

A hologram used in varying forms does not function as a mark in the absence of evidence that consumers would perceive it as a trademark. *See In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001), where the Board held that a hologram used on trading cards in varying shapes, sizes, and positions did not function as a mark, because the record showed that other companies used holograms on trading cards and other products as anti-counterfeiting devices, and there was no evidence that the public would perceive applicant’s hologram as an indicator of source. The Board noted that “the common use of holograms for non-trademark purposes means that

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consumers would be less likely to perceive applicant's uses of holograms as trademarks." 59 USPQ2d at 1693.

Therefore, in the absence of evidence of consumer recognition as a mark, the examining attorney should refuse registration on the ground that the hologram does not function as a mark, under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127.

Generally, if a hologram has two or more views, the examining attorney should also refuse registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the application seeks registration of more than one mark. *In re Upper Deck, supra*. See TMEP §807.03.

1202.15 Sound Marks

A sound mark identifies and distinguishes a product or service through audio rather than visual means. Examples of sound marks include: (1) a series of tones or musical notes, with or without words, and (2) a word or words accompanied by music. For a discussion of the criteria for registration of sound marks, *see In re General Electric Broadcasting Co., Inc.*, 199 USPQ 560 (TTAB 1978).

The requirement for a drawing does not apply to sound marks. 37 C.F.R. §2.52(a)(3). See TMEP §807.11.

Audio cassettes and compact disks may be accepted as specimens for sound marks. 37 C.F.R. §2.56(d)(3). To show that the sound mark actually identifies and distinguishes the services and indicates their source, the cassette should contain a sufficient portion of the audio content to indicate the nature of the services. If the mark comprises music or words set to music, the applicant may also submit the musical score as a specimen.

1203 Refusal on Basis of Immoral or Scandalous Matter; Deceptive Matter; Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act) enters into force with respect to the United States.

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The provisions of 15 U.S.C. §1052(a) apply to both the Principal Register and the Supplemental Register.

1203.01 Immoral or Scandalous Matter

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), is an absolute bar to the registration of immoral or scandalous matter on either the Principal Register or the Supplemental Register.

Although the words “immoral” and “scandalous” may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter. *See In re McGinley*, 660 F.2d 481, 484 n.6, 211 USPQ 668, 672 n.6 (C.C.P.A. 1981), *aff’g* 206 USPQ 753 (TTAB 1979) (“Because of our holding, *infra*, that appellant’s mark is ‘scandalous,’ it is unnecessary to consider whether appellant’s mark is ‘immoral.’ We note the dearth of reported trademark decisions in which the term ‘immoral’ has been directly applied.”)

The prohibition against the registration of marks that consist of or comprise immoral or scandalous matter was originally enacted as §5(a) of the Act of 1905, and was reenacted as part of §2(a) of the Act of 1946. There is little legislative history concerning the intent of Congress with regard to the provision; therefore, the term “scandalous” is interpreted by looking to “its ordinary and common meaning.” *In re Riverbank Canning Co.*, 95 F.2d 327, 328, 37 USPQ 268, 269 (C.C.P.A. 1938). This may be established by referring to court decisions, decisions of the Trademark Trial and Appeal Board and dictionary definitions. *In re McGinley*, 660 F.2d at 485, 211 USPQ at 673.

In affirming a refusal to register a mark as scandalous under §2(a), the Court of Customs and Patent Appeals noted dictionary entries that defined “scandalous” as, *inter alia*, shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation. *In re McGinley*, 660 F.2d at 486, 211 USPQ at 673 (mark comprising a photograph of a nude, reclining man and woman, kissing and embracing, for a “newsletter devoted to social and interpersonal relationship topics” and for “social club services,” held scandalous). The statutory language “scandalous” has also been considered to encompass matter that is “vulgar,” defined as “lacking in taste, indelicate, morally crude.” *In re Runsdorf*, 171 USPQ 443, 444 (TTAB 1971). *See also In re Tinseltown, Inc.*, 212 USPQ 863, 864 (TTAB 1981) (BULLSHIT, which the Board termed “profane,” held scandalous for “accessories of a personal nature, ... attaché cases, hand bags, purses, belts, and wallets”).

The meaning imparted by a mark must be determined in the context of the current attitudes of the day. *See In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994) (evidence found insufficient to establish that BLACK TAIL used on adult entertainment magazines comprises scandalous matter; court noted that there were both vulgar and non-vulgar definitions of “tail,” and that the record was devoid of evidence demonstrating which of these definitions a substantial composite

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of the general public would choose in the context of the relevant marketplace); *In re Old Glory Condom Corp.*, 26 USPQ2d 1216 (TTAB 1993) (OLD GLORY CONDOM CORP and design comprising the representation of a condom decorated with stars and stripes in a manner to suggest the American flag held not to be scandalous); *In re Thomas Laboratories, Inc.*, 189 USPQ 50, 52 (TTAB 1975) (“[I]t is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.”)

The determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application, and must be ascertained from the standpoint of not necessarily a majority, but a “substantial composite of the general public.” *In re McGinley*, 660 F.2d at 485, 211 USPQ at 673 (“[T]he Lanham Act does not require, under the rubric of ‘scandalous,’ any inquiry into the specific goods or services not shown in the application itself.”); *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996) (mark for restaurant and bar services consisting of words DICK HEADS positioned directly underneath caricature of a human head composed primarily of graphic and readily recognizable representation of male genitalia held scandalous, as it would be considered offensive by a substantial portion of the public); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639 (TTAB 1988) (graphic design of a dog defecating, as applied to polo shirts and T-shirts, held scandalous, given the broad potential audience that may view applicant's mark in sales establishments and “virtually all public places”); *In re Hepperle*, 175 USPQ 512 (TTAB 1972) (while the words might be a reference to marijuana, ACAPULCO GOLD found not scandalous when used as a mark for suntan lotion); .

Therefore, to support a refusal on the ground that a proposed mark is immoral or scandalous, the examining attorney must provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. *In re Mavety Media*, 33 F.3d at 1371-1372, 31 USPQ2d at 1925. This evidence could include dictionary definitions, newspaper articles and magazine articles.

It has been noted that the threshold is lower for what can be described as “scandalous” than for “obscene.” Refusal to register immoral or scandalous matter has been found not to abridge First Amendment rights, because no conduct is proscribed and no tangible form of expression is suppressed. Also, the term “scandalous” has been held sufficiently precise to satisfy due process requirements under the Fifth Amendment. *In re McGinley*, 660 F.2d at 484-85, 211 USPQ at 672.

The prohibition in §2(a) of the Act against the registration of scandalous matter pertains only to *marks* that are scandalous. The authority of the Act does not extend to goods that may be scandalous. *See In re Madsen*, 180 USPQ 334, 335 (TTAB 1973) (WEEK-END SEX for magazines held not scandalous, the Board observing that whether the magazine contents may be pornographic was not an issue before the Board).

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The examining attorney may look to the specimen(s) or other aspects of the record to determine how the mark will be seen in the marketplace. *See In re McGinley*, 660 F.2d at 482 n.3, 211 USPQ at 670 n.3 (containing excerpts from appellant's newsletters pertaining to their subject matter); *In re Hershey*, 6 USPQ2d 1470, 1472 (TTAB 1988) (BIG PECKER BRAND for T-shirts found not scandalous, the Board considering the labels that were submitted as specimens in determining the question of how the mark might be perceived. "[T]he inclusion of the bird design would make it less likely that purchasers would attribute any vulgar connotation to the word mark and we note that it is proper to look to the specimens of record to determine connotation or meaning of a mark.")

To ensure consistency in examination with respect to immoral or scandalous matter, when an examining attorney believes, for whatever reason, that a mark may be considered to comprise such matter, the examining attorney must consult with his or her supervisor.

1203.02 Deceptive Matter

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), is an absolute bar to the registration of deceptive matter on either the Principal Register or the Supplemental Register. Neither a disclaimer of the deceptive matter nor a claim that it has acquired distinctiveness under §2(f) can obviate a refusal under §2(a) on the ground that the mark consists of or comprises deceptive matter. *See American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTAB 1984); *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 241 (TTAB 1975).

Deceptive marks may include marks that falsely describe the material content of a product (*see In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982)) and marks that are geographically deceptive (*see Stabilisierungsfonds für Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073 (TTAB 1988); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984)). *See* TMEP §1210.05(a) regarding geographically deceptive marks.

The Court of Appeals for the Federal Circuit has articulated the following test for whether a mark consists of or comprises deceptive matter:

- (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?
- (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
- (3) If so, is the misdescription likely to affect the decision to purchase?

In re Budge Mfg. Co. Inc., 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987).

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The fact that only those knowledgeable in the relevant trade, and not average purchasers, would be deceived does not preclude a finding that a mark comprises deceptive matter. *In re House of Windsor, Inc.*, 223 USPQ 191, 192 (TTAB 1984).

1203.02(a) Distinction between Marks Comprising Deceptive Matter (§2(a)) and Deceptively Misdescriptive Marks (§2(e)(1)) or Geographically Deceptively Misdescriptive Marks (§2(e)(3))

If the first two inquiries set forth by the Federal Circuit in *In re Budge Mfg. Co. Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988) (*i.e.*, whether a mark is misdescriptive of the goods or services and whether prospective purchasers are likely to believe the misdescription), are answered affirmatively, the mark is either deceptively misdescriptive of the goods/services under §2(e)(1), or primarily geographically deceptively misdescriptive of them under §2(e)(3). With regard to geographic marks, the second inquiry, whether purchasers are likely to believe the misrepresentation, may also be characterized as whether there is a goods/place association. *See* TMEP §§1210.04 *et seq.*

The third inquiry, whether the misdescription is likely to affect the decision to purchase, distinguishes marks that are deceptive under §2(a) from marks that are deceptively misdescriptive under §2(e)(1) or primarily geographically deceptively misdescriptive under §2(e)(3). Marks that are deceptive under §2(a) are unregistrable on either the Principal Register or the Supplemental Register.

Marks that are deceptively misdescriptive under §2(e)(1) are unregistrable on the Principal Register without a showing of acquired distinctiveness under §2(f), 15 U.S.C. §1052(f). Marks that are primarily geographically deceptively misdescriptive under §2(e)(3) are unregistrable on either the Principal Register or the Supplemental Register with the following exceptions. A mark that is primarily geographically deceptively misdescriptive may be registered on the Principal Register only upon a showing under §2(f) that the mark had acquired distinctiveness in connection with the applicant's goods or services before December 8, 1993. A primarily geographically misdescriptive mark may be registered on the Supplemental Register only if the mark was in lawful use in commerce before December 8, 1993. 15 U.S.C. §1091. *See* TMEP §§1210.06 *et seq.*

The determinative nature of the third inquiry, *i.e.*, the materiality of the misdescription to the purchasing decision, is indicated in the following summary by the Trademark Trial and Appeal Board:

The Board has held that a mark is deceptive within the meaning of Section 2(a) of the Act, 15 U.S.C. 1052(a), if it misdescribes the goods, purchasers are likely to believe the misrepresentation, and the misrepresentation would materially affect their decision to purchase the goods. *See In re Quady Winery Inc.*, 221 USPQ 1213 (TTAB 1984). If the mark misdescribes the goods, and purchasers are likely to believe the misrepresentation, but the misrepresentation is not material to the

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purchasing decision, then the mark is deceptively misdescriptive (citation omitted). In the same vein, if a mark is the name of a place known generally to the public, purchasers who encounter goods bearing the mark would think that the goods originate in that place [*i.e.*, purchasers would make a “goods-place association” (citation omitted)], the goods do not come from the named place, and the deception is material to the purchasing decision, the mark is deceptive under Section 2(a); if the deception is not material to the purchasing decision, the mark is primarily geographically deceptively misdescriptive under Section [2(e)(3)] of the Act.

Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp., 6 USPQ2d 1610, 1615 (TTAB 1988).

To establish that a misdescription would be likely to affect the decision to purchase, the examining attorney should provide evidence that the misdescriptive quality or characteristic would make the product or service more appealing or desirable to prospective purchasers. *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992).

It may often be appropriate for the examining attorney to refuse registration of a mark of this type under both §2(a) and the appropriate subsection of §2(e), because it may be difficult to determine whether misdescriptive matter would materially affect a decision to purchase. *See, e.g., Gold Seal Co. v. Weeks*, 129 F. Supp. 928, 105 USPQ 407 (D.D.C. 1955), *aff'd sub nom. S. C. Johnson & Son, Inc. v. Gold Seal Co.*, 230 F.2d 832, 108 USPQ 400 (D.C. Cir. 1956) (per curiam), *cert. denied*, 352 U.S. 829, 111 USPQ 467 (1956).

See also R. Neumann & Co. v. Overseas Shipments, Inc., 326 F.2d 786, 140 USPQ 276 (C.C.P.A. 1964), and *Stabilisierungsfonds fur Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073 (TTAB 1988), in which third parties filed oppositions based on both statutory sections.

See TMEP §1210.05(b) regarding geographical indications that, when used on or in connection with wines or spirits, identify a place other than the origin of the goods.

1203.02(b) Deceptive Matter: Case References

In the following cases, proposed marks were determined to be deceptive, under §2(a): *In re Budge Mfg. Co. Inc.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987) (LOVEE LAMB held deceptive for seat covers not made of lambskin); *In re Organik Technologies, Inc.*, 41 USPQ2d 1690 (TTAB 1997) (ORGANIK deceptive for clothing and textiles made from cotton that is neither from an organically grown plant nor free of chemical processing or treatment, notwithstanding applicant's assertions that the goods are manufactured by a process that avoids the use of chemical bleaches, because the identification of goods was broad enough to include textiles and clothing manufactured with chemical processes or dyes); *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992)

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(LONDON LONDON held deceptive for clothing having no connection with London); *In re Perry Mfg. Co.*, 12 USPQ2d 1751 (TTAB 1989) (PERRY NEW YORK and design of New York City skyline held deceptive for clothing originating in North Carolina, in view of the renown of New York City in the apparel industry); *Stabilisierungsfonds für Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073, 1075 (TTAB 1988) (GOLDENER TROPFEN held deceptive for wines, in view of evidence of the international renown of the Goldtropfchen vineyard of West Germany, the Board finding that the purchasing public would be likely to think, mistakenly, that applicant's wines were produced from grapes grown there in accordance with German wine laws and regulations); *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (COLAGNAC held deceptive for cola-flavored liqueur containing Spanish brandy, the Board concluding that purchasers were likely to believe that applicant's goods contained COGNAC brandy); *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986) (SILKEASE held deceptive as applied to clothing not made of silk); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984) (BAHIA held deceptive as applied to cigars having no connection with the Bahia province of Brazil, the record indicating that tobacco and cigars are important products in the Bahia region); *Evans Products Co. v. Boise Cascade Corp.*, 218 USPQ 160 (TTAB 1983) (CEDAR RIDGE held deceptive for embossed hardboard siding not made of cedar); *In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982) (TEXHYDE held deceptive as applied to synthetic fabric for use in the manufacture of furniture, upholstery, luggage and the like); *Tanners' Council of America, Inc. v. Samsonite Corp.*, 204 USPQ 150 (TTAB 1979) (SOFTHIDE held deceptive for imitation leather material); *In re Salem China Co.*, 157 USPQ 600 (TTAB 1968) (AMERICAN LIMOGES, used on dinnerware that was neither made in Limoges, France, nor made from Limoges clay, held deceptive because of the association of Limoges with fine quality china); *Company of Cutlers of Hallamshire in the County of York v. Regent-Sheffield, Ltd.*, 155 USPQ 597 (TTAB 1967) (SHEFFIELD, used on cutlery not made in Sheffield, England, held deceptive because of the renowned status of Sheffield in relation to cutlery); *In re U.S. Plywood Corp.*, 138 USPQ 403 (TTAB 1963) (IVORY WOOD, for lumber and timber products, held deceptive since the goods were not made of ivorywood nor did they contain an ivorywood pattern).

Marks were found not to be deceptive in the following cases: *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990) (PARK AVENUE held neither deceptive nor geographically deceptively misdescriptive as applied to applicant's cigarettes and smoking tobacco, the Board finding no goods/place association between Park Avenue in New York City, on which opposer's world headquarters was located, and tobacco products); *In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982) (NIPPON, for radios, televisions and the like, found not deceptive in relation to the goods because, although the applicant was an American firm, the goods were actually made in Japan); *In re Sweden Freezer Mfg. Co.*, 159 USPQ 246, 249 (TTAB 1968) (SWEDEN and design, for which registration was sought under §2(f) for external artificial kidney units, held not deceptive, the Board finding the case to be in the category "where a geographical trademark may

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involve a degree of untruth but the deception may be perfectly innocent, harmless or negligible”); *A. F. Gallun & Sons Corp. v. Aristocrat Leather Products, Inc.*, 135 USPQ 459 (TTAB 1962) (COPY CALF, for wallets and billfolds of synthetic and plastic material made to simulate leather, found not deceptive, the Board noting that the mark, as an obvious play on the expression “copy cat,” suggested to purchasers that the goods were imitations of items made of calf skin).

1203.03 Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), bars the registration on either the Principal or the Supplemental Register of a designation that consists of or comprises matter which, with regard to persons, institutions, beliefs, or national symbols, does any of the following: (1) disparages them, (2) falsely suggests a connection with them, (3) brings them into contempt, or (4) brings them into disrepute.

Section 2(a) is distinctly different from §2(d), 15 U.S.C. §1052(d), for which the relevant test is likelihood of confusion. In *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1375-76, 217 USPQ 505, 508-09 (Fed. Cir. 1983), *aff’g* 213 USPQ 594 (TTAB 1982), the Court of Appeals for the Federal Circuit noted as follows:

A reading of the legislative history with respect to what became §2(a) shows that the drafters were concerned with protecting the name of an individual or institution which was not a technical “trademark” or “trade name” upon which an objection could be made under §2(d)....

Although not articulated as such, it appears that the drafters sought by §2(a) to embrace concepts of the right to privacy, an area of the law then in an embryonic state (footnote omitted). Our review of case law discloses that the elements of a claim of invasion of one’s privacy have emerged as distinctly different from those of trademark or trade name infringement. There may be no likelihood of such confusion as to the source of goods even under a theory of “sponsorship” or “endorsement,” and, nevertheless, one’s right of privacy, or the related right of publicity, may be violated.

The right to privacy protects a party’s control over the use of its identity or “persona.” A party acquires a protectible interest in a name or equivalent designation under §2(a) where the name or designation is unmistakably associated with, and points uniquely to, that party’s personality or “persona.” A party’s interest in a name or designation does not depend upon adoption and use as a technical trademark or trade name. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d at 1376-77, 217 USPQ at 509; *Buffett v. Chi-Chi’s, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

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See TMEP §§1203.03(c) and 1203.03(d) regarding disparagement, bringing into contempt and bringing into disrepute, and TMEP §§1203.03(e) and 1203.03(f) regarding false suggestion of a connection.

See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1 (6th Cir. 1983), concerning the various forms of identity which have been protected under the rights of privacy and publicity.

1203.03(a) “Persons” Defined

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), protects, *inter alia*, “persons, living or dead.”

Section 45 of the Act, 15 U.S.C. §1127, defines “person” and “juristic person” as follows:

The term “person” and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well as a natural person. The term “juristic person” includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term “person” also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.

The term “person” also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any non-governmental entity.

The term “persons” in §2(a) refers to real persons, not fictitious characters. In addition to natural persons, it includes juristic persons, *i.e.*, legally-created entities such as firms, corporations, unions, associations or any other organizations capable of suing and being sued in a court of law. See *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969); *Popular Merchandise Co. v. “21” Club, Inc.*, 343 F.2d 1011, 145 USPQ 203 (C.C.P.A. 1965); *John Walker & Sons, Ltd. v. American Tobacco Co.*, 110 USPQ 249 (Comm’r Pats. 1956); *Copacabana, Inc. v. Breslauer*, 101 USPQ 467 (Comm’r Pats. 1954).

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With respect to natural persons, they may be living or dead. However, §2(a) may not be applicable with regard to a deceased person when there is no longer anyone entitled to assert a propriety right or right of privacy. *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (DA VINCI held not to falsely suggest connection with deceased artist Leonardo Da Vinci).

A juristic person's rights under §2(a) are extinguished when the juristic person ceases to exist. *In re Wielinski*, 49 USPQ2d 1754 (TTAB 1998).

Juristic persons or institutions do not have to be well known to be protected from the registration of a mark that falsely suggests a connection with or disparages them, or brings them into contempt or disrepute. *Gavel Club v. Toastmasters International*, 127 USPQ 88, 94 (TTAB 1960).

It is well settled that the United States Government is a juristic person. See *NASA v. Record Chemical Co. Inc.*, 185 USPQ 563, 566 (TTAB 1975), and cases cited therein.

A mark does not have to comprise a person's full or correct name to be unregistrable; a nickname or other designation by which a person is known by the public may be unregistrable under this provision of the Act. *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 430 (TTAB 1985) (evidence of record "sufficient to raise a genuine issue of material fact as to whether the term 'MARGARITAVILLE' is so uniquely and unmistakably associated with opposer as to constitute opposer's name or identity such that when applicant's mark is used in connection with its [restaurant] services, a connection with opposer would be assumed").

1203.03(b) "National Symbols" Defined

A "national symbol" is subject matter of unique and special significance that, because of its meaning, appearance and/or sound, immediately suggests or refers to the country for which it stands. *In re Consolidated Foods Corp.*, 187 USPQ 63 (TTAB 1975) (noted national symbols include the bald eagle, Statue of Liberty, American flag, Presidential symbol, designation "Uncle Sam" and the unique human representation thereof, and the heraldry and shield designs used in governmental offices). National symbols include the symbols of foreign countries as well as those of the United States. *In re Anti-Communist World Freedom Congress, Inc.*, 161 USPQ 304 (TTAB 1969).

The Trademark Act does not prohibit registration of marks comprising national symbols; it only prohibits registration of matter that may disparage national symbols, falsely suggest a connection with them, or hold them up to contempt or disrepute. *Liberty Mutual Insurance Co. v. Liberty Insurance Co. of Texas*, 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960) (marks comprising portion of the Statue of Liberty found not to disparage, bring into contempt or disrepute, or falsely suggest a connection with the Statue of Liberty or the United States government, the Court "[a]ssuming without deciding" that the statue is a national symbol).

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Designations have been held to be national symbols within the meaning of §2(a) in the following cases: *In re Anti-Communist World Freedom Congress, Inc.*, 161 USPQ 304 (TTAB 1969) (representation of a hammer and sickle held to be a national symbol of the Union of Soviet Socialist Republics (U.S.S.R.)); *In re National Collection & Credit Control, Inc.*, 152 USPQ 200, 201 n.2 (TTAB 1966) (“The American or bald eagle with wings extended is a well-known national symbol or emblem of the United States”); *In re Teasdale Packing Co., Inc.*, 137 USPQ 482 (TTAB 1963) (U. S. AQUA and design held unregistrable under §2(a) on the ground that purchasers of applicant’s canned drinking water would be misled into assuming approval or sponsorship by the United States government in view of the nature of the mark, including a red, white and blue shield design, and the nature of the goods, the Board noting a program for stocking emergency supplies of water in fallout shelters and the setting of standards for drinking water by United States government agencies).

Designations have been held not to be national symbols in the following cases: *W. H. Snyder and Sons, Inc. v. Ladd*, 227 F. Supp. 185, 140 USPQ 647 (D.D.C. 1964) (HOUSE OF WINDSOR held not to be a national symbol of England, but merely the name of its present reigning family); *NASA v. Bully Hill Vineyards, Inc.*, 3 USPQ2d 1671 (TTAB 1987) (SPACE SHUTTLE found not to constitute a national symbol on the evidence of record, the Board also finding “shuttle” to be a generic term for a space vehicle or system); *Jacobs v. International Multifoods Corp.*, 211 USPQ 165, 170-71 (TTAB 1981), *aff’d on other grounds*, 668 F.2d 1234, 212 USPQ 641 (C.C.P.A. 1982) (“[H]istorical events such as the ‘BOSTON TEA PARTY’..., although undoubtedly associated with the American heritage, do not take on that unique and special significance of a ‘national symbol’ designed to be equated with and associated with a particular country.”); *In re General Mills, Inc.*, 169 USPQ 244 (TTAB 1971) (UNION JACK, which applicant was using on packages of frozen fish marked “English cut cod” and in its restaurant near representations of the British national flag, found not to suggest a particular country, the Board noting that it could consider only the matter for which registration was sought); *In re Horwitt*, 125 USPQ 145, 146 (TTAB 1960) (U. S. HEALTH CLUB found registrable for vitamin tablets. “Considering both the nature of the mark and the goods, it is concluded that the purchasing public would not be likely to mistakenly assume that the United States Government is operating a health club, that it is distributing vitamins, or that it has approved applicant’s goods.”)

The name of a country is not a national symbol within the meaning of §2(a) of the Trademark Act, *In re Sweden Freezer Mfg. Co.*, 159 USPQ 246, 248-249 (TTAB 1968), nor does use of the name of a country as a mark, by itself, amount to deception, disparagement, or a “false connection” under §2(a). *In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982).

The acronyms for, and names of, government agencies and bureaus are not considered to be national symbols. *Consolidated Foods Corp.*, 187 USPQ at 64 (OSS, acronym for the Office of Strategic Services, held not to be a national symbol, but merely to designate a particular (and long defunct) government agency, the Board

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contrasting national symbols with names and acronyms of government agencies. “‘National symbols’ ... are more enduring in time, ... and immediately conjure up the image of the country as a whole. Symbols of a country take on a special meaning and significance and are not so numerous as to dilute the special meaning and significance that each has.”)

“National symbols” cannot be equated with the “insignia” of nations. As noted in *Liberty Mutual Insurance Co.*, 185 F. Supp. at 908, 127 USPQ at 323:

The Act ... does not put national symbols on a par with the flag, coat of arms, or other insignia of the United States, which may not in any event be made the subject matter of a trade or service mark. With regard to national symbols the statute provides merely that they shall not be disparaged or held up to contempt or disrepute, and shall not be used as falsely to suggest a connection between the holder of the mark and the symbol.

See TMEP §1204 regarding insignia.

While the prohibition of §2(a) against the registration of matter that may disparage or falsely suggest a connection with national symbols, or bring them into contempt or disrepute, may not be applicable to a particular designation, many names, acronyms, titles, terms, and symbols are protected by other statutes or rules. See TMEP §1205.01.

1203.03(c) Disparagement, Bringing into Contempt and Bringing into Disrepute

Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may disparage, or bring into contempt or disrepute, persons, institutions, beliefs or national symbols. See TMEP §1203.03(a) regarding persons, and TMEP §1203.03(b) regarding national symbols.

In sustaining an opposition on this ground, the Trademark Trial and Appeal Board stated as follows:

Disparagement is essentially a violation of one’s right of privacy -- the right to be “let alone” from contempt or ridicule. See, *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1 (6th Cir. 1983). It has been defined as the publication of a statement which the publisher intends to be understood, or which the recipient reasonably should understand, as tending “to cast doubt upon the quality of another’s land, chattels, or intangible things.” Restatement (Second) of Torts §629 (1977). The two elements of such a claim are (1) that the communication reasonably would be understood as referring to the plaintiff; and (2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities. *Id.* (citations omitted).

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Greyhound Corp. v. Both Worlds Inc., 6 USPQ2d 1635, 1639 (TTAB 1988).

With regard to the first element set forth, the Board found that the applicant's design of a dog defecating strongly resembled the opposer's running dog symbol and that the evidence of record established that the symbol "points uniquely and unmistakably to opposer's persona." *Id.* at 1640.

With regard to the second element, the Board noted the negative nature of the design and stated as follows:

As it relates to opposer, ... the offensiveness of the design becomes even more objectionable because it makes a statement about opposer itself, and holds opposer up to ridicule and contempt.

Id.

1203.03(d) Disparagement, Bringing into Contempt and Bringing into Disrepute: Case References

See Boswell v. Mavety Media Group Ltd., 52 USPQ2d 1600 (TTAB 1999) (BLACK TAIL used on adult entertainment magazines, found not to be disparaging of women in general, or African-American women in particular, nor to bring those groups into contempt or disrepute); *Order Sons of Italy in America v. Memphis Mafia Inc.*, 52 USPQ2d 1364 (TTAB 1999) (THE MEMPHIS MAFIA for entertainment services found not to be matter that disparages Italian-Americans or bring them into contempt or disrepute); *Harjo v. Pro Football Inc.*, 50 USPQ2d 1705 (TTAB 1999) (REDSKINS, used in connection with presentation of professional football contests, found to be matter that may disparage Native Americans and bring them into contempt or disrepute, but not scandalous matter); *In re In Over Our Heads Inc.*, 16 USPQ2d 1653, 1654 (TTAB 1990) (MOONIES and design incorporating a "buttocks caricature," for dolls whose pants can be dropped, held not to be disparaging matter which would be unregistrable under §2(a), the Board finding that the mark "would, when used on a doll, most likely be perceived as indicating that the doll 'moons,' and would not be perceived as referencing members of The Unification Church."); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639-40 (TTAB 1988) (design of dog defecating, for clothing, held to disparage, and bring into contempt or disrepute, opposer's running dog symbol, the Board finding the evidence of record "sufficient to show prima facie that this design [the running dog symbol] is, in effect, an alter ego of opposer which points uniquely and unmistakably to opposer's persona."); *In re Anti-Communist World Freedom Congress, Inc.*, 161 USPQ 304 (TTAB 1969) (design of an "X" superimposed over a hammer and sickle held to disparage, and hold in contempt and disrepute, a national symbol of the U.S.S.R.).

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1203.03(e) False Suggestion of a Connection

Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs or national symbols. See TMEP §1203.03(a) regarding persons, TMEP §1203.03(b) regarding national symbols, and TMEP §1203.03 for information about the legislative history of §2(a).

To establish that a proposed mark falsely suggest a connection with a person or an institution, it must be shown that: (1) the mark is the same as, or a close approximation of, the name or identity of a person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by applicant under the mark; and (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed. *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 (TTAB 1990); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985); *In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985).

In *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350, 1353-34 (TTAB 1997), the Trademark Trial and Appeal Board held that Ernest Hemingway's friendship with the original owner of applicant's bar, his frequenting the bar and his use of the back room as an office is not the kind of "connection" contemplated by §2(a). Rather, a commercial connection, such as an ownership interest or commercial endorsement or sponsorship of applicant's services would be necessary to entitle the applicant to registration.

If it is unclear whether the person or institution is connected with the goods sold or services performed by the applicant, the examining attorney should make an explicit inquiry under 37 C.F.R. §2.61(b).

A refusal on this basis requires, by implication, that the person or institution with which a connection is falsely suggested must be the prior user. *In re Nuclear Research Corp.*, 16 USPQ2d at 1317; *In re Mohawk Air Services Inc.*, 196 USPQ 851, 854-55 (TTAB 1977).

Intent to identify a party or trade on its goodwill is not a required element of a §2(a) claim of false suggestion of an association with such party. *S & L Acquisition Co. v. Helene Arpels, Inc.*, 9 USPQ2d 1221, 1224 (TTAB 1987); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 754 (TTAB 1985). However, evidence of such an intent could be highly persuasive that the public would make the intended false association. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1377, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982).

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1203.03(f) False Suggestion of a Connection: Case References

See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 703 F.2d 1372, 1377, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982) (NOTRE DAME and design, for cheese, held not to falsely suggest a connection with the University of Notre Dame. “As the board noted, ‘Notre Dame’ is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus it cannot be said that the only ‘person’ which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity.”); *In re Sauer*, 27 USPQ2d 1073 (TTAB 1993), *aff'd*, 26 F.3d 140 (Fed. Cir. 1994) (registration of BO BALL for oblong shaped leather ball with white stitching properly refused under §2(a), since use of “Bo” would be recognized by purchasers as reference to football and baseball player Bo Jackson, and there was no connection between Jackson and applicant); *In re Urbano*, 51 USPQ2d 1776 (TTAB 1999) (SYDNEY 2000, used for advertising and business services and communication services, falsely suggests connection with Olympic Games, since general public would recognize phrase as referring unambiguously to Olympic Games to be held in Sydney, Australia, in 2000; entire organization that comprises Olympic games qualifies as “institution.”); *In re North American Free Trade Association*, 43 USPQ2d 1282 (TTAB 1997) (NAFTA, used on “promotion of trade and investment” services, falsely suggests connection with North American Free Trade Agreement; NAFTA qualifies as institution because it encompasses treaty, supplemental agreements, and various commissions, committees and offices created by those documents); *In re Sloppy Joe’s International Inc.*, 43 USPQ2d 1350 (TTAB 1997) (use of mark SLOPPY JOE’S, with design that includes portrait of Ernest Hemingway, falsely suggests connection with deceased writer); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996) (cancellation petitioners failed to state claim for relief where they have not alleged, and cannot reasonably allege, that term INTERNET points uniquely and unmistakably to their own identity or persona); *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1471 (TTAB 1990) (RIT-Z in stylized form, for toilet seats, held not to falsely suggest a connection with opposer, the Board observing that there was “no evidence of record directed to showing a connection of applicant’s mark with opposer corporation, The Ritz Hotel Limited”); *In re Nuclear Research Corp.*, 16 USPQ2d 1316 (TTAB 1990) (NRC and design, for radiation and chemical agent monitors, electronic testers and nuclear gauges, held not to falsely suggest a connection with the U.S. Nuclear Regulatory Commission in view of applicant’s use of NRC long prior to the inception of that agency); *NASA v. Bully Hill Vineyards, Inc.*, 3 USPQ2d 1671, 1676 (TTAB 1987) (opposition to the registration of SPACE SHUTTLE for wines dismissed, the Board finding “shuttle” to be a generic term for a space vehicle or system. “Where a name claimed to be appropriated does not point uniquely and unmistakably to that party’s personality or ‘persona,’ there can be no false suggestion.”); *Board of Trustees of University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986) (petition to cancel registration of BAMA, for shoes, slippers, stockings, socks and insoles, granted, the Board finding that the evidence of record indicated that BAMA points uniquely to the University of

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Alabama and thus falsely suggests a connection with the University); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985) (WESTPOINT, for shotguns and rifles, held to falsely suggest a connection with an institution, the United States Military Academy). For examples of findings of false suggestion of a connection prior to the decision of the Court of Appeals for the Federal Circuit in *Notre Dame, supra*, see *In re U.S. Bicentennial Society*, 197 USPQ 905 (TTAB 1978) (U.S. BICENTENNIAL SOCIETY, for ceremonial swords, held to falsely suggest a connection with the American Revolution Bicentennial Commission and the United States government); *In re National Intelligence Academy*, 190 USPQ 570 (TTAB 1976) (NATIONAL INTELLIGENCE ACADEMY, for educational and instructional services in intelligence gathering for law enforcement officers, held to falsely suggest a connection with the United States government).

1204 Refusal on Basis of Flag, Coat of Arms or Other Insignia of United States, State or Municipality, or Foreign Nation

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

Section 2(b) of the Trademark Act, 15 U.S.C. §1052(b), bars the registration on either the Principal Register or the Supplemental Register of marks that consist of or comprise (whether consisting solely of, or having incorporated in them) the flag, coat of arms, or other insignia of the United States, of any state or municipality, or of any foreign nation. Section 2(b) also bars the registration of marks that consist of or comprise any simulation of such symbols.

Section 2(b) differs from the provision of §2(a) regarding national symbols (*see* TMEP §1203.03(b)) in that §2(b) requires no additional element, such as disparagement or a false suggestion of a connection, to preclude registration.

Flags and coats of arms are specific designs formally adopted to serve as emblems of governmental authority. The wording “other insignia” should not be interpreted broadly, but should be considered to include only those emblems and devices that also represent such authority and that are of the same general class and character as flags and coats of arms. The Trademark Trial and Appeal Board has construed the statutory language as follows:

[T]he wording “or other insignia of the United States” must be restricted in its application to insignia of the same general class as “the flag or coats of arms” of the United States. Since both the flag and coat of arms are emblems of national authority it seems evident that other insignia of national authority such as the Great Seal of the United States, the Presidential Seal, and seals of government departments would be equally prohibited registration under Section 2(b). On the other hand, it appears

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equally evident that department insignia which are merely used to identify a service or facility of the Government are not insignia of national authority and that they therefore do not fall within the general prohibitions of this section of the Statute.

In re U.S. Department of the Interior, 142 USPQ 506, 507 (TTAB 1964) (logo comprising the words “NATIONAL PARK SERVICE” and “Department of the Interior,” with depiction of trees, mountains and a buffalo, surrounded by an arrowhead design, held not to be an insignia of the United States).

Letters that merely identify people and things associated with a particular agency or department of the United States government, instead of representing the authority of the government or the nation as a whole, are generally not considered to be “insignia of the United States” within the meaning of §2(b). The Board, in dismissing an opposition to the registration of “USMC” in a stylized presentation, for prostheses, fracture braces and orthopedic components, discussed the meaning of “insignia” under §2(b), as follows:

The letters “USMC” are nothing like a flag or coat of arms. These types of insignia are pictorial in nature, they can be described, but cannot be pronounced. Even if the letters could be construed to be an insignia, opposer has not shown that they would be seen as an insignia of the United States.

U.S. Navy v. U.S. Mfg. Co., 2 USPQ2d 1254, 1256 (TTAB 1987). As a result of the enactment of Public Law 98-525 on October 19, 1984, the initials, seal and emblem of the United States Marine Corps are “deemed to be insignia of the United States,” under 10 U.S.C. §7881, pertaining to unauthorized use of Marine Corps insignia. However, “USMC” was not so protected when the applicant began using its stylized version of those letters as a mark. In view of the provision in Public Law 98-525 that the amendments adding Chapter 663 (10 U.S.C. §7881) shall not affect rights that vested before the date of its enactment, the majority of the Board found that enactment of the law did not adversely affect the mark’s registrability, stating that “opposer has not shown that applicant’s mark was an insignia of the United States prior to the law making it one, or that the law effectively bars registration to applicant.” *Id.* at 1260. (See TMEP §1205.01 regarding subject matter which is protected by statute.)

See also Liberty Mutual Insurance Co. v. Liberty Insurance Co. of Texas, 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960) (“That the Statue of Liberty is not a part of the ‘insignia of the United States’ is too clear to require discussion.”)

As stated above, marks that consist of or comprise any simulation of the flag, coat of arms, or other insignia of the United States, of any state or municipality, or of any foreign nation are also unregistrable under §2(b). “Simulation,” as contemplated by §2(b), refers to “something that gives the appearance or effect or has the characteristics of an original item.” *In re Waltham Watch Co.*, 179 USPQ 59, 60 (TTAB 1973) (mark consisting of wording and the design of a globe and six flags for

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watches found registrable, the Board stating, “[A]lthough the flags depicted in applicant’s mark incorporate common elements of flag designs such as horizontal or vertical lines, crosses or stars, they are readily distinguishable from any of the flags of the nations alluded to by the examiner. In fact, applicant’s mark would be regarded as nothing more than a conglomeration of nondescript flags utilized to symbolize the significance of the globe design and the slogan ‘TIMING THE WORLD’ appearing thereon.”) Whether a mark comprises a simulation must be determined from a visual comparison of the mark vis-à-vis replicas of the flag, coat of arms or other insignia in question. *Id.*

The determination of whether a proposed mark consists of or comprises a flag, coat of arms or other insignia must be made “without a careful analysis and side-by-side comparison.” *In re Advance Industrial Security, Inc.*, 194 USPQ 344, 346 (TTAB 1977) (ADVANCE SECURITY and design consisting of an eagle on a triangular shield, in gold and brown, for detective and investigative services and providing security systems and services, found registrable, the Board stating, “When the mark of the applicant and the Coat of Arms or Great Seal of the United States are compared in their entirety, it is adjudged that applicant’s mark does not consist of or comprise the Coat of Arms of the United States or any simulation thereof”) The public should be considered to retain only a general or overall, rather than specific, recollection of the various elements or characteristics of design marks. *Id.*

The incorporation in a mark of individual or distorted features that are merely suggestive of flags, coats of arms or other insignia does not bar registration under §2(b). *See Knorr-Nahrungsmittel A.G. v. Havland International, Inc.*, 206 USPQ 827, 833 (TTAB 1980) (While applicant originally may have intended to include the flags of the Scandinavian countries in the mark, NOR-KING and design, “[a]ll that the record reflects is that the mark contains a representation of certain flags, but not the flag or flags of any particular nation.” Opposer’s cause of action under §2(b) found to be without merit; opposition sustained on other grounds); *In re National Van Lines, Inc.*, 123 USPQ 510 (TTAB 1959) (mark comprising words and the design of a shield with vertical stripes held registrable, the Board finding the design to be readily distinguishable from the shield of the Great Seal of the United States and, therefore, not a simulation of the seal or any portion thereof); *In re American Box Board Co.*, 123 USPQ 508 (TTAB 1959) (design mark comprising an eagle and shield held registrable, the Board finding that it did not involve a simulation of the Great Seal of the United States because the eagle and shield of applicant’s mark differed substantially from those on the seal in both appearance and manner of display).

See TMEP §§1205 *et seq.* regarding matter that is protected by statute or by Article 6ter of the Paris Convention.

To overcome a refusal under §2(a) or §2(b), deletion of the unregistrable matter is sometimes permitted. *See* TMEP §807.15 regarding removal of matter from drawings.

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1205 Refusal on Basis of Matter Protected by Statute or Convention

1205.01 Statutory Protection

Various federal statutes and regulations prohibit or restrict the use of certain words, names, symbols, terms, initials, marks, emblems, seals, insignia, badges, decorations, medals and characters adopted by the United States government or particular national and international organizations. These designations are reserved for the specific purposes prescribed in the relevant statute and must be free for use in the prescribed manner. *See* the listings of citations to sections of the United States Code and the Code of Federal Regulations in Appendix C of this Manual.

For example, Congress has created about 70 statutes that grant exclusive rights to use certain designations to federally created private corporations and organizations. Violation of some of these statutes may be a criminal offense, *e.g.*, 18 U.S.C. §§705 (regarding badges, medals, emblems or other insignia of veterans' organizations); 706 ("Red Cross," "Geneva Cross," and emblem of Greek red cross); 707 (4-H Club); 708 (coat of arms of the Swiss Confederation); 711 ("Smokey Bear"); and 711a ("Woodsy Owl" and slogan, "Give a Hoot, Don't Pollute"). Other statutes provide for civil enforcement, *e.g.*, 36 U.S.C. §§153104 (National Society of the Daughters of the American Revolution); 30905 (Boy Scouts); 80305 (Girl Scouts); 130506 (Little League); and 21904 (The American National Theater and Academy).

The following are examples of the protection of words and symbols by statute.

- (1) The Copyright Act of 1976 includes provisions regarding the use of appropriate notices of copyright. These include provisions concerning the use of the letter "C" in a circle - ©, the word "Copyright" and the abbreviation "Copr." to identify visually perceptible copies (17 U.S.C. §401); the use of the letter "P" in a circle to indicate phonorecords of sound recordings (17 U.S.C. §402); and the use of the words "mask work," the symbol *M* and the letter "M" in a circle to designate mask works (17 U.S.C. §909). The Act designates these symbols to perform the function of indicating that the user of the symbol is asserting specific statutory rights.
- (2) Use of the Greek red cross other than by the American National Red Cross is proscribed by statute. 18 U.S.C. §706. Use of the coat of arms of the Swiss Confederation for trade or commercial purposes is proscribed by statute. 18 U.S.C. §708. *See In re Health Maintenance Organizations, Inc.*, 188 USPQ 473 (TTAB 1975) (mark comprising a dark cross with legs of equal length on which a caduceus is symmetrically imposed (representation of caduceus disclaimed) held registrable, the Board finding the mark readily distinguishable from the Greek red cross (on white background) and the Swiss confederation coat of arms (white cross on red background)).
- (3) False advertising or misuse of names to indicate a federal agency is proscribed by 18 U.S.C. §709. For example, this provision prohibits knowing use, without written permission of the Director of the Federal

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Bureau of Investigation, of the words “Federal Bureau of Investigation,” the initials “F.B.I.” or any colorable imitation, in various formats “in a manner reasonably calculated to convey the impression that such advertisement, ... publication, ... broadcast, telecast, or other production, is approved, endorsed, or authorized by the Federal Bureau of Investigation.” Thus, an examining attorney must refuse to register such matter, pursuant to 18 U.S.C. §709, if its use is reasonably calculated to convey an approval, endorsement or authorization by the Federal Bureau of Investigation.

- (4) Section 110 of the Amateur Sports Act of 1978, 36 U.S.C. §220506, protects various designations associated with the Olympics. Under 36 U.S.C. §220506(a), the United States Olympic Committee has the exclusive right to use the name “United States Olympic Committee,” its symbol and emblem, and the words “Olympic,” “Olympiad,” “Citius Altius Fortius,” “Pan American,” “Paralympiad,” “America Espirito Sport Fraternite,” or any combination thereof. The United States Supreme Court has held that the grant by Congress to the United States Olympic Committee of the exclusive right to use the word “Olympic” does not violate the First Amendment. *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 3 USPQ2d 1145 (1987) (concerning petitioner’s use of “Gay Olympic Games”). Under 36 U.S.C. §220506(c), a person is subject to suit in a civil action by the Committee if such person, without the Committee’s consent, uses for the purpose of trade, to induce the sale of goods or services, or to promote any theatrical exhibition, athletic performance, or competition, a designation noted above (listed in §220506(a)) or “any trademark, trade name, sign, symbol, or insignia falsely representing association with, or authorization by, the International Olympic Committee or ... [the United States Olympic Committee]” or any simulation of the words “Olympic,” “Olympiad” or “Citius Altius Fortius” “tending to cause confusion, to cause mistake, to deceive, or to falsely suggest a connection with ... [the United States Olympic Committee] or any Olympic activity.”

See U.S. Olympic Committee v. Toy Truck Lines Inc., 237 F.3d 1331, 57 USPQ2d 1380 (Fed. Cir. 2001); *O-M Bread, Inc. v. U.S. Olympic Committee.*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995); *U.S. Olympic Committee v. Intelicense Corp., S.A.*, 737 F. 2d 263, 222 USPQ 766 (2d Cir. 1984), *cert. denied* 469 U.S. 982 (1984); *U.S. Olympic Committee v. Union Sport Apparel*, 220 USPQ 526 (E.D. Va. 1983); *U.S. Olympic Committee v. International Federation of Body Builders*, 219 USPQ 353 (D.D.C. 1982); *Stop the Olympic Prison v. U.S. Olympic Committee*, 489 F. Supp. 1112, 207 USPQ 237 (S.D.N.Y. 1980).

- (5) In chartering the Blinded Veterans Association, Congress granted it the sole right to use its name and such seals, emblems and badges as it may lawfully adopt. 36 U.S.C. §30306. This protection of its exclusive right to use “Blinded Veterans Association” does not extend to the term “blinded veterans,” which has been found generic. *Blinded Veterans Association v.*

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Blinded American Veterans Foundation, 872 F.2d 1035, 10 USPQ2d 1432 (D.C. Cir. 1989).

Usually the statute will define the appropriate use of a designation and will prescribe criminal penalties or civil remedies for improper use. However, the statutes themselves do not provide the basis for refusal of trademark registration. To determine whether registration should be refused in a particular application, the examining attorney should consult the relevant statute to determine the function of the designation and its appropriate use. If a statute provides that a specific party or government agency has the exclusive right to use a designation, and a party other than that specified in the statute has applied to register the designation, the examining attorney must refuse registration on the ground that the mark is not in lawful use in commerce, citing §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, in addition to the relevant statute.

Depending on the nature and use of the mark, other sections of the Trademark Act may also bar registration and must be cited where appropriate. For example, it may be appropriate for the examining attorney to refuse registration under §2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that the mark comprises matter that may falsely suggest a connection with a national symbol, institution or person specified in the statute (*e.g.*, the United States Olympic Committee). *See* TMEP §1203.03(e). Other §2(a) bases for refusal could also apply. *See* TMEP §§1203 *et seq.* It may be appropriate to refuse registration under §2(b), 15 U.S.C. §1052(b), for matter that comprises a flag, coat of arms or other similar insignia. *See* TMEP §1204. It may be appropriate to refuse registration under §2(d), 15 U.S.C. §1052(d), if the party specified in the statute owns a registration for a mark that is the same or similar. *Cf. U.S. Olympic Committee v. Olymp-Herrenwaschefabriken Bezner GmbH & Co.*, 224 USPQ 497 (TTAB 1984) (opposition to the registration of OLYMP sustained on ground of likelihood of confusion with opposer's registered mark OLYMPIC under §2(d), the Board finding that the evidence of record did not show that OLYMP falsely suggests a connection with opposer under §2(a), and that the remedies provided in 36 U.S.C. §220506(c) for misuse of Olympic designations are not pertinent to opposition proceedings).

In some instances, it may be appropriate for the examining attorney to refuse registration pursuant to §§1, 2 (preamble) and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the ground that the subject matter would not be perceived as a trademark. (For service mark applications, §3 of the Act, 15 U.S.C. §1053, should also be cited in this type of refusal).

To determine what action is appropriate, the examining attorney should look to the particular use of a symbol or term by the applicant. For example, where it is evident that the applicant has merely included a copyright symbol in the drawing of the mark inadvertently, and the symbol is not a material portion of the mark, the examining attorney should indicate that the symbol is not part of the mark and require that the applicant amend the drawing to remove the symbol, instead of issuing statutory refusals of the types noted above.

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Examining attorneys should also consider whether registration of matter as a trademark by the applicant may be prohibited by Article 6*ter* of the Paris Convention. See TMEP §1205.02.

1205.02 Article 6*ter* of the Paris Convention

The United States is a member of the Paris Convention for the Protection of Industrial Property, as revised at Stockholm on July 14, 1967, the members of which constitute a Union for the protection of industrial property.

Under Article 6*ter* of the Paris Convention, the contracting countries have agreed to refuse or to invalidate the registration, and to prohibit the unauthorized use, as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems of the member countries, official signs and hallmarks indicating control and warranty adopted by member countries, and any imitation from a heraldic point of view. The provision applies equally to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations of which one or more countries of the Union are members, except for those that are already the subject of international agreements in force, intended to ensure their protection (*e.g.*, “Red Cross” and emblems protected by the Geneva Convention of August 12, 1949).

Under Article 6*ter*, each member country shall communicate the list of emblems, official signs and hallmarks that it wishes to protect, and all subsequent modifications of its list, to the International Bureau of Intellectual Property (International Bureau), who will transmit the communications to the other member countries. Within twelve months from receipt of the notification, a member country may transmit its objections, through the International Bureau.

When the United States Patent and Trademark Office receives requests for protection under Article 6*ter* from the International Bureau, they are assigned serial numbers in the “89” series code, *i.e.*, serial numbers beginning with the digits “89,” and are sometimes referred to as “non-registrations.” No file wrapper is created, and the requests are not examined. Copies of the designations are filed in the paper records of the Trademark Search Library. Pertinent information is entered in the automated search records of the Office and should be discovered in an examining attorney’s search. However, some of the images of these entries are not currently available in the Office’s automated database and can be found only in the Search Library.

Refusal Of Marks Because of an Article 6*ter* Designation

The Paris Convention requires that the United States refuse to register designations that have been deposited pursuant to Article 6*ter* and to which the United States has transmitted no objections. Depending on the nature and use of the mark, §§2(a) and 2(b) of the Trademark Act, 15 U.S.C. §§1052(a) and 1052(b), may bar registration of these marks. A refusal under §2(d) of the Trademark Act is ***not*** appropriate. The issue is not whether the marks are confusingly similar, but whether registration of the mark would violate §§2(a) or 2(b) of the Trademark Act.

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For example, it may be appropriate for the examining attorney to refuse registration under §2(a) of the Act on the ground that the mark comprises matter that may falsely suggest a connection with a national symbol of a member country or an international intergovernmental organization. *See* TMEP §1203.03(e). Other §2(a) bases for refusal could also apply. *See* TMEP §§1203 *et seq.* It may be appropriate to refuse registration under §2(b) of the Act if the proposed mark comprises a flag, coat of arms or other similar insignia. *See* TMEP §1204. In some instances, it may be appropriate to refuse registration under §§1, 2 (preamble) and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the ground that the subject matter would not be perceived as a trademark. (For service mark applications, §3 of the Act, 15 U.S.C. §1053, should also be cited when making this type of refusal.)

1206 Refusal on Basis of Name, Portrait or Signature of Particular Living Individual or Deceased U.S. President Without Consent

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

Section 2(c) of the Trademark Act, 15 U.S.C. §1052(c), bars the registration of a mark that consists of or comprises (whether consisting solely of, or having incorporated in the mark) a name, portrait or signature that identifies a particular living individual, or a deceased United States president during the life of his widow, except by the written consent of the individual or the president's widow.

Section 2(c) absolutely bars the registration of these marks on both the Principal Register and the Supplemental Register.

The purpose of requiring the consent of a living individual to the registration of his or her name, signature or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1376, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660, 661 (TTAB 1983). *See* TMEP §1203.03 for a discussion of the right to control the use of one's identity, which underlies part of §2(a) as well as §2(c).

See TMEP §813 regarding when it is necessary for an examining attorney to inquire of the applicant as to whether a name, signature or portrait in a mark identifies a particular living individual, and regarding the entry of pertinent statements in the record for printing in the *Official Gazette* and on a registration certificate.

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1206.01 Name, Portrait or Signature

Section 2(c) explicitly pertains to any name, portrait or signature that identifies a particular living individual, or a deceased president of the United States during the life of the president's widow.

To identify a particular living individual, a name does not have to be the person's full name. *See Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269 (TTAB 1999) (registration of opposer's surname without consent prohibited by §2(c), where the record showed that because of opposer's reputation as an inventor in the field of electrochemical analysis, the relevant public would associate the goods so marked with opposer); *In re Steak and Ale Restaurants of America, Inc.*, 185 USPQ 447 (TTAB 1975) (PRINCE CHARLES found to identify a particular living individual whose consent was not of record); *Laub v. Industrial Development Laboratories, Inc.*, 121 USPQ 595 (TTAB 1959) (LAUB, for flowmeters, found to identify the holder of a patent for flowmeters, whose written consent was not of record); *Reed v. Bakers Engineering & Equipment Co.*, 100 USPQ 196, 199 (PO Ex. Ch. 1954) (registration of REED REEL OVEN, for ovens, held to be barred by §2(c) without written consent of the designer and builder of the ovens, Paul N. Reed. "'Name' in §2(c) is not restricted to the full name of an individual but refers to any name regardless of whether it is a full name, or a surname or given name, or even a nickname, which identifies a particular living individual..."). *Cf. Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1209 (TTAB 1988) ("Section 2(c) does not apply to surnames except in those cases where a particular individual is known by a surname alone.")

Cases involving portraits include *In re McKee Baking Co.*, 218 USPQ 287 (TTAB 1983) (mark comprising a sign on which the portrait of a young girl appears below the words LITTLE DEBBIE); *In re Masucci*, 179 USPQ 829 (TTAB 1973) (mark comprising name and portrait of a deceased president of the United States, President Eisenhower); *Garden v. Parfumerie Rigaud, Inc.*, 34 USPQ 30 (Comm'r Pats. 1937) (marks comprising name and portrait of Mary Garden).

1206.02 Particular Living Individual or Deceased U.S. President

Section 2(c) applies to marks that comprise matter that identify living individuals; it does not apply to marks that comprise matter that identifies deceased persons, except for a deceased president of the United States during the life of the president's widow. *See McGraw-Edison Co. v. Thomas Edison Life Insurance Co.*, 160 USPQ 685 (TTAB 1969), *vacated on other grounds*, 162 USPQ 372 (N.D. Ill. 1969) (opposition to the registration of THOMAS EDISON dismissed, the Board finding §2(c) inapplicable, as the particular individual whom the name identifies is deceased); *In re Masucci*, 179 USPQ 829 (TTAB 1973) (affirming refusal to register mark consisting of the name EISENHOWER, a portrait of President Dwight D. Eisenhower and the words PRESIDENT EISENHOWER REGISTERED PLATINUM MEDALLION #13, for greeting cards, on the ground that the mark comprises the name, signature or

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portrait of a deceased United States president without the written consent of his widow, under §2(c)).

The fact that a name appearing in a mark may actually be the name of more than one person does not negate the requirement for a written consent to registration, if the mark identifies, to the relevant public, a particular living individual or deceased United States president whose spouse is living. *In re Steak and Ale Restaurants of America, Inc.*, 185 USPQ 447 (TTAB 1975) (affirming refusal to register PRINCE CHARLES, for meat, in the absence of consent to register by Prince Charles, a member of the English royal family. “Even accepting the existence of more than one living ‘Prince Charles,’ it does not follow that each is not a particular living individual.”)

If it appears that a name, portrait or signature in a mark may identify a particular living individual but in fact the applicant devised the matter as fanciful, or believes it to be fanciful, a statement to that effect should be placed in the record. If appropriate, the statement that a name, portrait or signature does not identify a particular living individual will be printed in the *Official Gazette* and on the registration certificate. See TMEP §813. Additional relevant circumstances should also be explained. For example, if the matter identifies a certain character in literature, or a deceased historical person, then a statement of these facts in the record may be helpful; however, this information should not be printed in the *Official Gazette* or on a registration certificate.

Although a mark may have been devised to be fanciful or arbitrary and not to identify a particular living individual, it nevertheless may name or otherwise identify one or more living individuals. Whether a consent to registration is required depends on whether the public would recognize and understand the mark as identifying the person. Therefore, if the person is not generally known, or well known in the field relating to the relevant goods or services, it may be that the mark would not constitute the identification of a particular person under §2(c), and consent would not be required. The Trademark Trial and Appeal Board noted as follows in *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931, 933 (TTAB 1979):

[Section] 2(c) was not designed to protect every person from having a name which is similar or identical to his or her name registered as a trademark. Such a scope of protection would practically preclude the registration of a trademark consisting of a name since in most cases there would be someone somewhere who is known by the name and who might be expected to protest its registration. Rather, the Statute was intended to protect one who, for valid reasons, could expect to suffer damage from another's trademark use of his name. That is, it is more than likely that any trademark which is comprised of a given name and surname will, in fact, be the name of a real person. But that coincidence, in and of itself, does not give rise to damage to that individual in the absence of other factors from which it may be determined that the particular individual bearing the name in question will be associated

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with the mark as used on the goods, either because that person is so well known that the public would reasonably assume the connection or because the individual is publicly connected with the business in which the mark is used.

See also Fanta v. Coca-Cola Co., 140 USPQ 674 (TTAB 1964) (dismissing a petition to cancel registrations of FANTA, for soft drinks and syrup concentrate, the Board noting no use by the petitioner, Robert D. Fanta, of his name in connection with the sale of soft drinks, nor any indication that petitioner had attained recognition in that field); *DeCecco v. Wright*, 120 USPQ 20 (TTAB 1958) (“The question whether the name ‘DECECCO’ as used by applicant in connection with his goods serves to identify opposer is a matter for proof.”); *Brand v. Fairchester Packing Co.*, 84 USPQ 97 (Comm’r Pats. 1950) (affirming dismissal of a petition to cancel the registration of ARNOLD BRAND, for fresh tomatoes, the Commissioner finding nothing in the record to indicate that the mark identified the petitioner, Arnold Brand, an attorney specializing in patent and trademark matters, with the tomato business, or that use of the mark would lead the public to make such a connection).

1206.03 Consent of Individual or President’s Widow Required

1206.03(a) Consent Must Be Written Consent to Registration

When a name, portrait or signature in a mark identifies a particular living individual, or a deceased president of the United States during the life of his widow, the mark can be registered only if the written consent of the individual, or of the president’s widow, is filed in the application.

The consent must be a written consent to the registration of the identifying matter as a trademark. *See Reed v. Bakers Engineering & Equipment Co.*, 100 USPQ 196, 199 (PO Ex. Ch. 1954) (“Consent to register must be distinguished from consent to use. There may very well be consent to use without any consent to register. And neither is consent to register sufficient under the statute unless it is a written consent to register as specified in the statute.”) Permission to use a mark in connection with specific goods without specific written consent to also register that mark does not give a party the right to register the subject matter as a trademark. *Garden v. Parfumerie Rigaud, Inc.*, 34 USPQ 30, 31 (Comm’r Pats. 1937) (granting petition to cancel registrations of marks that named and portrayed the petitioner, Mary Garden, who, although she had consented to the use of her name and portrait in connection with a particular perfume, had not given written consent to register the marks for perfumes and other cosmetic items. “Permission to use one’s name and portrait in connection with a specified item of merchandise falls far short of consent to register one’s name and portrait as a trade mark for such merchandise generally.”) Consent to *register* a mark that makes no reference to consent to *use* is acceptable; the Office has no authority to regulate use of a mark.

Written consents for minors may be given by their guardians.

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1206.03(b) Implicit Consent

When a particular individual identified by matter in a mark is also the person who signed the application, then his or her consent to registration will be presumed. *Alford Mfg. Co. v. Alfred Electronics*, 137 USPQ 250 (TTAB 1963), *aff'd*, 333 F.2d 912, 142 USPQ 168 (C.C.P.A. 1964) (“The written consent to the registration of the mark ‘ALFORD’ by Andrew Alford, the individual, is manifested by the fact that said person executed the application....”); *Ex parte Dallieux*, 83 USPQ 262, 263 (Comm’r Pats. 1949) (“By signing the application, the applicant here obviously consents....”).

An implied consent to register has been found in certain other limited situations. *Compare, In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 344 (TTAB 1985) (consent to the use and registration of the mark D. B. KAPLAN’S DELICATESSEN, for restaurant services, found to be implicit in the terms of the “buy-out” agreement which relinquished all property rights in the name and forbade its use by the named party in any subsequent business) *with, In re New John Nissen Mannequins*, 227 USPQ 569 (TTAB 1985) (consent to register not implied from appearance of the name “John Nissen” in a deed of incorporation of applicant’s predecessor, nor from existence of foreign registrations incorporating the name).

An applicant does not have to submit a new consent if a consent to register is already part of the record in the file of a valid registration for a mark comprised in whole or in part of the same name, portrait or signature for the same goods or services. In this situation, the applicant only has to claim ownership of that existing registration. If an applicant has submitted a consent to register in an application that has not matured to registration, a new consent is not required for pertinent co-pending applications, but a copy of the consent must be placed in each pending application. *In re McKee Baking Co.*, 218 USPQ 287 (TTAB 1983) (applicant’s claim of ownership of a prior registration that includes a consent to register in the record held sufficient for purposes of complying with the consent requirement of the Act).

See TMEP §813 regarding a statement of consent of a living individual to the registration of his or her name or likeness.

1207 Refusal on Basis of Likelihood of Confusion, Mistake or Deception

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....

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Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), is the statutory basis for a refusal to register due to likelihood of confusion with another mark. Section 2(d) applies to both the Principal and the Supplemental Register.

1207.01 Likelihood of Confusion

In the *ex parte* examination of a trademark application, a refusal under §2(d) is normally based on the examining attorney's conclusion that the applicant's mark, as used on or in connection with the specified goods or services, so resembles a *registered* mark as to be likely to cause confusion. (See TMEP §1207.02 concerning §2(d) refusals to register marks that so resemble another mark as to be likely to deceive, and TMEP §1207.03 concerning §2(d) refusals based on unregistered marks. *Note:* Refusals based on unregistered marks are not issued in *ex parte* examination.)

The examining attorney must conduct a search of Office records to determine whether the applicant's mark so resembles any registered mark(s) as to be likely to cause confusion or mistake, when used on or in connection with the goods or services identified in the application. The examining attorney also searches pending applications for conflicting marks with earlier effective filing dates. See TMEP §§1208 *et seq.* regarding conflicting marks. The examining attorney must place a copy of the search strategy in the file.

If the examining attorney determines that there is a likelihood of confusion between applicant's mark and a previously registered mark, the examining attorney refuses registration under §2(d). Before citing a registration, the examining attorney must check the automated records of the Office to confirm that any registration that is the basis for a §2(d) refusal is an active registration. See TMEP §716.02(e). Also, if Office records indicate that an assignment of the conflicting registration has been recorded, the examining attorney should check the Assignment Historical Database (*i.e.*, the automated records of the Assignment Services Division of the Office) to determine whether the conflicting mark has been assigned to applicant.

See TMEP §716.02(e) regarding suspension pending cancellation of a cited registration under §8 of the Act or expiration of a cited registration for failure to renew under §9 of the Act.

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion.

In *ex parte* examination, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The other factors listed in *du Pont* may be considered only if relevant evidence is contained in the record. See *In re Dixie Restaurants*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) ("the thirteen du Pont factors 'must be considered' 'when [they] are of record,'" quoting *du Pont*, 476 F.2d at 1361, 177 USPQ at 567); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640

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(TTAB 1984). In an *ex parte* case, the following factors are usually the most relevant:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- The relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- The similarity or dissimilarity of established, likely-to-continue trade channels.
- The conditions under which and buyers to whom sales are made, *i.e.* “impulse” vs. careful, sophisticated purchasing.
- The number and nature of similar marks in use on similar goods.
- A valid consent agreement between the applicant and the owner of the previously registered mark.

The Court of Appeals for the Federal Circuit has provided the following guidance with regard to determining and articulating likelihood of confusion:

The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used (citations omitted). It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark (footnote omitted). On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties (footnote omitted). Indeed, this type of analysis appears to be unavoidable.

In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

There is no mechanical test for determining likelihood of confusion. The issue is not whether the actual goods are likely to be confused but, rather, whether there is a likelihood of confusion as to the *source* of the goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein. Each case must be decided on its own facts.

The determination of likelihood of confusion under §2(d) in an intent-to-use application does not differ from the determination in any other type of application.

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1207.01(a) Relatedness of the Goods or Services

If the marks of the respective parties are identical, the relationship between the goods or services need not be as close to support a finding of likelihood of confusion as would be required in a case where there are differences between the marks. *Amtcor, Inc. v. Amtcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981).

In some instances, because of established marketing practices, the use of identical marks on seemingly unrelated goods and services could result in a likelihood of confusion. *See In re Phillips-Van Heusen Corporation*, 228 USPQ 949, 951 (TTAB 1986) (“The licensing of commercial trademarks for use on ‘collateral’ products (such as clothing, glassware, linens, etc.), that are unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years.”)

1207.01(a)(i) Goods or Services Need Not Be Identical

The goods or services do not have to be identical or even competitive in order to determine that there is a likelihood of confusion. The inquiry is whether the goods are related, not identical. The issue is not whether the goods will be confused with each other, but rather whether the public will be confused about their source. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). It is sufficient that the goods or services of the applicant and the registrant are so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source. *See, e.g., On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000) (ON-LINE TODAY for Internet connection services held likely to be confused with ONLINE TODAY for Internet content); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (MARTIN’S for wheat bran and honey bread held likely to be confused with MARTIN’S for cheese); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer held likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) (LAREDO for land vehicles and structural parts therefor held likely to be confused with LAREDO for pneumatic tires).

Conversely, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*,

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1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field).

1207.01(a)(ii) Goods May Be Related to Services

It is well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other. *See, e.g., In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG’S (stylized) for retail grocery and general merchandise store services held likely to be confused with BIGGS and design for furniture); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (C.C.P.A. 1961) (SEILER for catering services held likely to be confused with SEILER’S for smoked and cured meats); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services held likely to be confused with AZTECA for Mexican food products); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services held likely to be confused with GOLDEN GRIDDLE for table syrup); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988) (MUCKY DUCK and duck design for mustard held likely to be confused with THE MUCKY DUCK and duck design for restaurant services); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women’s clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for various items of men’s, boys’, girls’ and women’s clothing held likely to be confused with THE “21” CLUB (stylized) for restaurant services and towels); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories); *Corinthian Broadcasting Corporation v. Nippon Electric Co., Ltd.*, 219 USPQ 733 (TTAB 1983) (TVS for transmitters and receivers of still television pictures held likely to be confused with TVS for television broadcasting services); *In re Industrial Expositions, Inc.*, 194 USPQ 456 (TTAB 1977) (POLLUTION ENGINEERING EXPOSITION for programming and conducting of industrial trade shows held likely to be confused with POLLUTION ENGINEERING for a periodical magazine).

1207.01(a)(iii) Reliance on Identification of Goods/Services in Registration and Application

The nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16

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USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973).

If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. Therefore, if the cited registration has a broad identification of goods or services, an applicant does not avoid likelihood of confusion merely by more narrowly identifying its related goods. *See, e.g., In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992) (where a registrant's goods are broadly identified as "computer programs recorded on magnetic disks," without any limitation as to the kind of programs or the field of use, it is necessary to assume that the registrant's goods encompass all such computer programs, and that they travel in the same channels of trade and are available to all classes of prospective purchasers of those goods); *In re Diet Center Inc.*, 4 USPQ2d 1975 (TTAB 1987) (VEGETABLE SVELTES for wheat crackers sold through franchised outlets offering weight reduction services held likely to be confused with SVELTE for low calorie frozen dessert); *In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986) (SPRAYZON for cleaning preparations and degreasers for industrial and institutional use held likely to be confused with SPRA-ON and design for preparation for cleaning woodwork and furniture). Similarly, there is a likelihood of confusion if an applicant identifies its goods or services so broadly that the identification encompasses the goods or services identified in the registration of a similar mark. *See, e.g., In re Americor Health Services*, 1 USPQ2d 1670 (TTAB 1986) (RESOLVE for corporate employee assistance services, namely, providing confidential mental health counseling services, held likely to be confused with RESOLVE for counseling services in the field of infertility); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE for banking services held likely to be confused with RESPONSE CARD for banking services rendered through 24-hour teller machines).

An applicant may not restrict the scope of its goods and/or the scope of the goods covered in the registration by extrinsic argument or evidence, for example, as to the quality or price of the goods. *See, e.g., In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

In the situation where the terminology in the identification is unclear, the Trademark Trial and Appeal Board has permitted an applicant to provide extrinsic evidence to show that the registrant's identification has a specific meaning to members of the trade. The Board noted that in light of such evidence it is improper to consider the identification in a vacuum and attach all possible interpretations to it. *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990).

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1207.01(a)(iv) No “Per Se” Rule

The facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances; therefore, there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. *See, e.g., Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) (regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) and cases cited therein (regarding clothing).

1207.01(a)(v) Expansion of Trade Doctrine

The examining attorney must consider any goods or services in the registrant's normal fields of expansion to determine whether the registrant's goods or services are related to the applicant's identified goods or services under §2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). A trademark owner is entitled to protection against the registration of a similar mark on products that might reasonably be expected to be produced by him in the normal expansion of his business. The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Products Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983).

1207.01(a)(vi) Evidence Showing Relatedness of Goods or Services

The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods or services are used together or used by the same purchasers; advertisements showing that the relevant goods or services are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods and services and the goods and services listed in the cited registration. *See* TMEP §1207.01(d)(iii) and cases cited therein regarding the probative value of third party registrations.

1207.01(b) Similarity of the Marks

If it appears that confusion may be likely as a result of the contemporaneous use of similar marks by the registrant and the applicant with the identified goods or services, the next step is to evaluate the marks themselves, in relation to the goods and services. The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. When considering the similarity of the marks, [a]ll relevant facts

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pertaining to the appearance and connotation must be considered.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Where the goods are identical, “the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

1207.01(b)(i) Word Marks

The points of comparison for a word mark are appearance, sound, and meaning or connotation. Similarity of the marks in one respect -- sight, sound or meaning -- will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor alone *may* be sufficient to support a holding that the marks are confusingly similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987).

1207.01(b)(ii) Similarity In Appearance

Similarity in appearance is one factor in determining whether there is a likelihood of confusion between marks. Marks may be confusingly similar in appearance despite the addition, deletion or substitution of letters or words. *See, e.g., Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (TMM held confusingly similar to TMS, both for systems software); *Canadian Imperial Bank of Commerce, N.A., v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH held likely to be confused with COMMUNICASH, both for banking services); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987) (TRUCOOL for synthetic coolant held likely to be confused with TURCOOL for cutting oil); *In re Curtice-Burns, Inc.*, 231 USPQ 990 (TTAB 1986) (MCKENZIE’S (stylized) for processed frozen fruits and vegetables held likely to be confused with McKenzie for canned fruits and vegetables); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (NEWPORTS for women’s shoes held likely to be confused with NEWPORT for outer shirts); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON for microprocessor used in commercial laundry machines held likely to be confused with MILLTRONICS (stylized) for electronic control devices for machinery); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL for resinous chemicals used in dyeing textiles held likely to be confused with LUTEX for non-resinous chemicals used in the textile industry).

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1207.01(b)(iii) Comparing Marks That Contain Additional Matter

It is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark or matter that is descriptive or suggestive of the named goods or services. Sometimes the rule is expressed in terms of the dominance of the common term. Therefore, if the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences. *See, e.g., In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO COMBOS (with “COMBOS” disclaimed) held likely to be confused with MACHO (stylized), both for food items as a part of restaurant services); *In re Computer Systems Center Inc.*, 5 USPQ2d 1378 (TTAB 1987) (CSC ADVANCED BUSINESS SYSTEMS for retail computer stores held likely to be confused with CSC for computer time sharing and computer programming services); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE held likely to be confused with RESPONSE CARD (with “CARD” disclaimed), both for banking services); *In re The U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS (stylized) for clothing held likely to be confused with SPARKS (stylized) for footwear); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer held likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Energy Images, Inc.*, 227 USPQ 572 (TTAB 1985) (SMART-SCAN (stylized) for optical line recognition and digitizing processors held likely to be confused with SMART for remote data gathering and control systems); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY’S ACCU TUNE and design for automotive service stations held likely to be confused with ACCUTUNE for automotive testing equipment); *In re Denisi*, 225 USPQ 624 (TTAB 1985) (PERRY’S PIZZA held likely to be confused with PERRY’S, both for restaurant services); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and design (with “CALIFORNIA” disclaimed) held likely to be confused with COLLEGIENNE, both for items of clothing); *In re Pierre Fabre S.A.*, 188 USPQ 691 (TTAB 1975) (PEDI-RELAX for foot cream held likely to be confused with RELAX for antiperspirant).

Exceptions to the above stated general rule regarding additions or deletions to marks may arise if: (1) the marks in their entireties convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. *See, e.g., In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with “CATFISH” disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH’S GOLD’N CRUST and design (with “GOLD’N CRUST” disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store

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services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

1207.01(b)(iv) Similarity in Sound – Phonetic Equivalents

Similarity in sound is one factor in determining whether there is a likelihood of confusion between marks. There is no “correct” pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. Therefore, “correct” pronunciation cannot be relied on to avoid a likelihood of confusion. *See, e.g., Kabushiki Kaisha Hattori Tokeiten v. Scuto*, 228 USPQ 461 (TTAB 1985) (SEYCOS and design for watches held likely to be confused with SEIKO for watches and clocks); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985) (CAYNA (stylized) for soft drinks held likely to be confused with CANA for, *inter alia*, canned and frozen fruit and vegetable juices); *In re Energy Telecommunications & Electrical Association*, 222 USPQ 350 (TTAB 1983) (ENTELEC and design for association services in the telecommunication and energy industries held likely to be confused with INTELECT for conducting expositions for the electrical industry); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963) (CRESCO and design for leather jackets held likely to be confused with KRESSCO for hosiery).

1207.01(b)(v) Similarity in Meaning

Similarity in meaning or connotation is another factor in determining whether there is a likelihood of confusion between marks. The focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *See, e.g., In re M. Serman & Company, Inc.*, 223 USPQ 52 (TTAB 1984) (CITY WOMAN held likely to be confused with CITY GIRL, both for clothing); *Gastown Inc., of Delaware v. Gas City, Ltd.*, 187 USPQ 760 (TTAB 1975) (GAS CITY (with “GAS” disclaimed) held likely to be confused with GASTOWN, both for gasoline); *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971) (AQUA-CARE (stylized) held likely to be confused with WATERCARE (stylized), both for water conditioning products).

The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies’ sportswear, the Board finding that the term was suggestive of the construction of applicant’s bras, but was likely to be perceived by purchasers either as an entirely arbitrary designation or as being suggestive of sportswear that “crosses over” the line between informal and more formal wear when applied to ladies’ sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men’s underwear held not likely to be confused with PLAYERS for shoes, the Board finding that the term PLAYERS

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implies a fit, style, color and durability adapted to outdoor activities when applied to shoes, but “implies something else, primarily indoors in nature” when applied to men’s underwear); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies’ and children’s underwear held not likely to be confused with BOTTOMS UP for men’s clothing, the Board finding that the term connotes the drinking phrase “Drink Up” when applied to men’s suits, coats and trousers, but does not have this connotation when applied to ladies’ and children’s underwear).

1207.01(b)(vi) Doctrine of Foreign Equivalents

Under the doctrine of foreign equivalents, a foreign word (from a language familiar to an appreciable segment of American consumers) and the English equivalent may be found to be confusingly similar. *See, e.g., Continental Nut Co. v. Cordon Bleu, Ltee*, 494 F.2d 1397, 181 USPQ 647 (C.C.P.A. 1974); *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987) (BUENOS DIAS for soap held likely to be confused with GOOD MORNING and design for latherless shaving cream); *In re Ithaca Industries, Inc.*, 230 USPQ 702 (TTAB 1986) (LUPO for men’s and boys’ underwear held likely to be confused with WOLF and design for various items of clothing); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983) (EL SOL for clothing and footwear held likely to be confused with SUN and design for footwear).

Compare the following decisions involving marks found not confusingly similar, based on consideration of factors such as the overall appearance and pronunciation of the marks, the extent to which the terms are “equivalent,” and the relatedness of the named goods and/or services: *In re Sarkli Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983) (REPECHAGE for various skin care products held not likely to be confused with SECOND CHANCE for face creams and other toiletries); *In re Buckner Enterprises Corp.*, 6 USPQ2d 1316 (TTAB 1987) (DOVE and design for solid fuel burning stoves and furnaces held not likely to be confused with PALOMA for various forms of gas heating apparatus); *In re L’Oreal S.A.*, 222 USPQ 925 (TTAB 1984) (HAUTE MODE for hair coloring cream shampoo held not likely to be confused with HI-FASHION SAMPLER (with “SAMPLER” disclaimed) for finger nail enamel); *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975) (TIA MARIA for restaurant services held not likely to be confused with AUNT MARY’S for canned fruits and vegetables).

The doctrine of foreign equivalents is not normally invoked if the marks alleged to be confusingly similar are both foreign words. *See Safeway Stores Inc. v. Bel Canto Fancy Foods Ltd.*, 5 USPQ2d 1980, 1982 (TTAB 1987) (“[T]his Board does not think it proper to take the French expression ‘bel air’ and the Italian expression ‘bel aria’ and then convert both into English and compare the English translations....”). However, application of the doctrine of foreign equivalents is not barred in every case where the respective marks consist of terms from different foreign languages. *Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L.*, 49 USPQ2d 2018 (TTAB 1998) (likelihood of confusion found between the Italian DUE TORRI and design for wines, and the Spanish TORRES and design for wines and brandy and TRES TORRES for brandy).

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While foreign words are generally translated into English for trademark comparison purposes, words from dead or obscure languages may be so unfamiliar to the American buying public that they should not be translated into English. *See Enrique Bernat F. S.A. v. Guadalajara Inc.*, 210 F.3d 439, 54 USPQ2d 1497 (5th Cir. 2000), *reh'g denied* 218 F.3d 745 (2000). The test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent. *See In re Zazzara*, 156 USPQ 348 (TTAB 1967). The determination of whether a language is “dead” must be made on a case-by-case basis, based upon the meaning that the term would have to the relevant purchasing public.

Example: Latin is generally considered a dead language. However, if there is evidence that a Latin term is still in use by the relevant purchasing public (e.g., if the term appears in current dictionaries or news articles), then a Latin term is not considered dead. The same analysis should be applied to other uncommon languages.

1207.01(b)(vii) Transposition of Terms

Where the primary difference between marks is the transposition of the elements that compose the marks and where this transposition does not change the overall commercial impression, there may be a likelihood of confusion. *See, e.g., In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (THE WINE SOCIETY OF AMERICA and design, for “wine club membership services including the supplying of printed materials, sale of wines to members, conducting wine tasting sessions and recommending specific restaurants offering wines sold by applicant,” held likely to be confused with AMERICAN WINE SOCIETY 1967 and design, for a newsletter, bulletin and journal of interest to members of the registrant); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988) (RUST BUSTER (with “RUST” disclaimed) for rust-penetrating spray lubricant held likely to be confused with BUST RUST for penetrating oil); *In re General Tire & Rubber Co.*, 213 USPQ 870 (TTAB 1982) (SPRINT STEEL RADIAL (with “STEEL” and “RADIAL” disclaimed) for tires held likely to be confused with RADIAL SPRINT (with “RADIAL” disclaimed) for tires).

However, if the transposed mark creates a distinctly different commercial impression, then confusion is not likely. *See, e.g., In re Best Products Co., Inc.*, 231 USPQ 988 (TTAB 1986) (BEST JEWELRY and design (with “JEWELRY” disclaimed) for retail jewelry store services held not likely to be confused with JEWELERS’ BEST for jewelry).

1207.01(b)(viii) Marks Consisting of Multiple Words

When assessing the likelihood of confusion between compound word marks, one must determine whether there is a portion of the word mark that is dominant in terms of creating a commercial impression. Although there is no mechanical test to select a “dominant” element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term rather than a descriptive or generic term as the

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source-indicating feature of the mark. Accordingly, if two marks for related goods or services share the same dominant feature and the marks, when viewed in their entireties, create similar overall commercial impressions, then confusion is likely. *See In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987) (JM ORIGINALS (with “ORIGINALS” disclaimed) for various items of apparel held likely to be confused with JM COLLECTABLES for “knitwear -- namely, sport shirts”).

If the common element of two marks is “weak” in that it is generic, descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *The U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER’S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes); *In re Istituto Sieroterapico E Vaccinogeno, Toscano “SCLAVO” S.p.A.*, 226 USPQ 1035 (TTAB 1985) (ASO QUANTUM (with “ASO” disclaimed) for diagnostic laboratory reagents held not likely to be confused with QUANTUM I for laboratory instrument for analyzing body fluids).

In a sense the public can be said to rely more on the nondescriptive portions of each mark. On the other hand, this does not mean that the public looks only at the differences, or that the descriptive words play no role in creating confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) (THE CASH MANAGEMENT EXCHANGE (with “CASH MANAGEMENT” disclaimed) for computerized cash management services held likely to be confused with CASH MANAGEMENT ACCOUNT for various financial services).

1207.01(b)(ix) Weak or Descriptive Marks

The Trademark Trial and Appeal Board and the courts have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *In re Central Soya Company, Inc.*, 220 USPQ 914 (TTAB 1984). However, even a weak mark is entitled to protection against the registration of a similar mark for closely related goods or services. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (C.C.P.A. 1974).

In *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975), the Board stated:

[R]egistration on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance. (citation omitted.) This is significant because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is,

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terms falling within the former category have been generally categorized as “weak” marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.

However, even marks that are registered on the Supplemental Register may be cited under §2(d). *In re Clorox Company*, 578 F.2d 305, 198 USPQ 337 (C.C.P.A. 1978).

1207.01(b)(x) Parody Marks

Parody is not a defense to a likelihood of confusion refusal. There are confusing parodies and non-confusing parodies. *See* 3 J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §31.153 (4th ed. 2000). A true parody actually decreases the likelihood of confusion because the effect of the parody is to create a distinction in the viewer’s mind between the actual product and the joke. While a parody must call to mind the actual product to be successful, the same success also necessarily distinguishes the parody from the actual product. *Mutual of Omaha Insurance Co. v. Novak*, 648 F. Supp. 905, 231 USPQ 963 (D. Neb. 1986).

Another example of parody can be found in *Columbia Pictures Industries Inc., v. Miller*, 211 USPQ 816 (TTAB 1981) (CLOTHES ENCOUNTERS held likely to be confused with CLOSE ENCOUNTERS OF THE THIRD KIND, for men’s and women’s clothing); *Cf., Jordache Enterprises, Inc. v. Hogg Wyld, Inc.*, 828 F.2d 1482, 4 USPQ2d 1216 (10th Cir. 1987) (LARDASHE for pants was not an infringement of the JORDACHE mark).

1207.01(c) Design Marks

When the marks at issue are both design marks, the issue of the similarity of the marks must be decided primarily on the basis of visual similarity. In this situation, consideration must be given to the fact that a purchaser’s recollection of design marks is often of a general and hazy nature. *See, e.g., Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404 (TTAB 1988) (stylized house design for service of management of real estate properties for others held not likely to be confused with stylized house design for real estate brokerage services); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (silhouette of two profiles facing right within a teardrop background for distributorship services in the field of health and beauty aids held likely to be confused with silhouette of two profiles facing left within an oval background for skin cream); *Ocean Spray Cranberries, Inc. v. Ocean Garden Products, Inc.*, 223 USPQ 1027 (TTAB 1984) (abstract circular design mark for seafood held not likely to be confused with oval breaking wave design for various food items including juices and fruits); *In re Steury Corp.*, 189 USPQ 353 (TTAB 1975) (design comprised of three generally horizontal bars for boats and camper trailers held likely to be confused with design comprised of two generally horizontal bars for boats and campers); *Matsushita Electric Industrial Co., Ltd. v. Sanders Associates, Inc.*, 177 USPQ 720 (TTAB 1973) (triangular arrow design within a square border for various items of electrical and electronic equipment

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held likely to be confused with triangular arrow design for various items of electrical and electronic components and equipment).

1207.01(c)(i) Legal Equivalents - Comparison of Words and Their Equivalent Designs

Under the doctrine of legal equivalents, a pictorial representation and its literal equivalent may be found to be confusingly similar. This doctrine is based on a recognition that a pictorial depiction and equivalent wording are likely to impress the same mental image on purchasers. *See, e.g., In re Rolf Nilsson AB*, 230 USPQ 141 (TTAB 1986) (design comprising the silhouette of the head of a lion and the letter “L” for shoes held likely to be confused with LION for shoes); *Puma-Sportschuhfabriken Rudolf Dassler KG v. Garan, Inc.*, 224 USPQ 1064 (TTAB 1984) (designs of mountain lion, for shirts and tops, held confusingly similar to PUMA, for items of clothing; the design of a puma, for items of sporting goods and clothing; and PUMA and design, for T-shirts); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974) (design of eagle lined for the color gold, for various items of sports apparel, held likely to be confused with GOLDEN EAGLE and design of an eagle, for various items of clothing).

1207.01(c)(ii) Composite Marks Consisting of Both Words and Designs

Often, the examining attorney must determine whether a likelihood of confusion exists between composite marks that consist of a design element as well as words and/or letters. Frequently the marks at issue are similar in only one element. Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). However, the fundamental rule in this situation is that the marks must be considered in their entireties. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (C.C.P.A. 1974).

If a mark comprises both a word and a design, greater weight is often given to the word, because it is the word that purchasers would use to refer to or request the goods or services. *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (APPETITO and design of two broad stripes lined for the colors red and green, for Italian sausage, held likely to be confused with A APPETITO’S and design and A APPETITO’S INC. and design of a sandwich (with “INC.” and sandwich design disclaimed), both for restaurant services). The Court of Appeals for the Federal Circuit has cautioned, however, that “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement).

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The comparison of composite marks must be done on a case-by-case basis without reliance on mechanical rules of construction. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) (finding a likelihood of confusion between SPICE VALLEY and SPICE ISLANDS, both for tea); *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices); *In re Sun Supermarkets, Inc.*, 228 USPQ 693 (TTAB 1986) (SUN SUPERMARKETS and design of sun held likely to be confused with SUNSHINE and design of sun and SUNRISE and design of sun, all for retail grocery store services).

1207.01(c)(iii) Comparison of Typed Marks and Special Form Marks

If a mark (in either an application or a registration) is presented in typed form, the owner of the mark is not limited to any particular depiction. The rights associated with a mark in typed form reside in the wording (or other literal element, *e.g.*, letters, numerals, punctuation) and not in any particular display. Therefore, an applicant cannot, by presenting its mark in special form, avoid likelihood of confusion with a mark that is registered in typed form because the marks presumably could be used in the same manner of display. *E.g., In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1751 (TTAB 1987); *In re Hester Industries, Inc.*, 231 USPQ 881, 883, n.6 (TTAB 1986).

1207.01(d) Miscellaneous Considerations

1207.01(d)(i) Doubt Resolved in Favor of Registrant

If there is any doubt as to whether there is a likelihood of confusion, that doubt must be resolved in favor of the prior registrant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio), Inc.* 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

1207.01(d)(ii) Absence of Actual Confusion

It is well settled that the relevant test is *likelihood of confusion*, not actual confusion. It is unnecessary to show actual confusion to establish likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein.

1207.01(d)(iii) Third-Party Registrations [R-1]

Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive,

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suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). Properly used in this limited manner, third party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1285-86 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987).

Third-party registrations that cover a number of different goods or services have some probative value to the extent that they may serve to suggest that goods or services are of a type that may emanate from a single source, if the registrations are based on use in commerce. However, registrations issued under 15 U.S.C. §1126(e), based on a foreign registration, have very little, if any, persuasive value. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

The submission of a list of registrations or a copy of a search report is not proper evidence of third-party registrations. To make registrations of record, soft copies of the registrations or the electronic equivalent thereof (*i.e.*, printouts of the registrations taken from the electronic search records of the United States Patent and Trademark Office) must be submitted. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n. 3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). *See* TMEP §710.03.

1207.01(d)(iv) Collateral Attack on Registration Improper in *Ex Parte* Proceeding

Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. During *ex parte* prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (*e.g.*, a registrant's nonuse of the mark). *See In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (C.C.P.A. 1970); *In re Peebles Inc.* 23 USPQ2d 1795, 1797 n. 5 (TTAB 1992); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB 1988).

It is also inappropriate for the applicant to place the burden of showing a likelihood of confusion on the owner of the cited registration. In *Dixie Restaurants, supra*, the

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court stated that “it is the duty of the PTO and this court to determine whether there is a likelihood of confusion between two marks.... [I]t is no answer for the applicant to ask that the application be passed to publication to see whether the owner of the cited mark will oppose the registration.” 105 F.3d 1405, 1408, 41 USPQ2d at 1531, 1535.

1207.01(d)(v) Classification of Goods/Services

The classification of goods and services has no bearing on the question of likelihood of confusion. Rather, it is the manner in which the applicant and/or registrant have identified their goods or services that is controlling. *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

1207.01(d)(vi) Prior Decisions of Examining Attorneys

Each case must be decided on its own merits. Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board. *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984).

1207.01(d)(vii) Sophisticated Purchasers

The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion.

1207.01(d)(viii) Consent Agreements

The term “consent agreement” generally refers to an agreement in which a party (*e.g.*, a prior registrant) consents to the use and/or registration of a mark by another party (*e.g.*, an applicant for registration of the same mark or a similar mark), or in which each party consents to the use and/or registration of the same mark or a similar mark by the other party.

A consent agreement may be submitted by the applicant to overcome a refusal of registration under §2(d) of the Act, or in anticipation of a refusal to register. When a consent agreement is submitted, the examining attorney will consider the agreement, and all other evidence in the record, to determine likelihood of confusion. The examining attorney should not solicit a consent agreement.

Consents come in different forms and under circumstances in infinite variety. They are, however, but one factor to be taken into account with all of the other relevant circumstances bearing on the likelihood of confusion referred to in §2(d). *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

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In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363, 177 USPQ 563, 568 (C.C.P.A. 1973), the Court of Customs and Patent Appeals stated as follows:

[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

A consent agreement that is not merely a “naked” consent typically details reasons why no likelihood of confusion exists and/or arrangements undertaken by the parties to avoid confusing the public. *In re Permagrain Products, Inc.*, 223 USPQ 147 (TTAB 1984) (consent agreement found to be “naked” because the agreement did not restrict the markets in such a way as to avoid confusion).

The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the Office should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

Compare In re Mastic Inc., 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987) (refusal to register affirmed even with a consent to register where applicant had not used the mark in commerce and consent agreement contained contradictory statements).

The examining attorney should give great weight to a proper consent agreement. The examining attorney should not interpose his or her own judgment concerning likelihood of confusion when an applicant and registrant have entered into a *credible* consent agreement and, *on balance*, the other factors do not dictate a finding of likelihood of confusion.

A consent agreement is not the same as a “concurrent use” agreement. The term “concurrent use” is a term of art that refers to a geographical restriction on the registration. See TMEP §§1207.04 *et seq.* regarding concurrent use.

1207.01(d)(ix) Fame of Mark

The fame of a registered mark is a factor to be considered in determining likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Famous marks enjoy a wide latitude of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894,

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1897 (Fed. Cir. 2000) (Trademark Trial and Appeal Board erred in limiting the weight accorded to the fame of opposer's FRITO-LAY mark); *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862 (1992) (Board erred in discounting the fame of opposer's mark PLAY-DOH). The Court of Appeals for the Federal Circuit has stated:

[A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.

Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbols to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders.

Kenner Parker Toys, 963 F.2d at 353, 22 USPQ2d at 1456.

When present, the fame of the mark is "a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1328, 54 USPQ2d 1894, 1898. However, like the other *du Pont* factors, the fame of a mark may be considered only if there is relevant evidence of record. *See* TMEP §1207.01 and cases cited therein.

In *Tiffany & Broadway v. Commissioner*, 167 F. Supp.2d 949 (S.D. Tex. 2001), the fame of four registered marks cited against the applicant was a significant factor in finding a likelihood of confusion between applicant's TIFFANY for ladies' dress shoes and registrant's TIFFANY and TIFFANY & CO. for a variety of goods, including jewelry, china, silverware, glassware, leather goods, belt buckles, ties, scarves, clocks, watches, brushes and lamps, and for retail store services specializing in the sale of jewelry, watches, clocks, and gift items. The *ex parte* record included excerpts from 18 news articles where the registrant Tiffany & Company was identified as a famous business; citations to three published decisions in which the fame of the TIFFANY mark had been judicially recognized; and evidence that the registrant's goods were sold at over 60 Tiffany locations worldwide--including 34 in the United States--and through independently-owned retail stores and mail order outlets.

1207.01(d)(x) Conflicting Marks Owned by Different Parties

During the examination of an application, the examining attorney should consider separately each registration found in a search of the marks registered in the Office that may bar registration of the applicant's mark under §2(d). If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no

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likelihood of confusion. However, the examining attorney must cite all the marks that are considered to be a bar against registration of the mark presented in the application, even if they are owned by different parties. The examining attorney should always explain the reason that the mark in each cited registration is grounds for refusal under §2(d).

1207.02 Marks That Are Likely to Deceive

In addition to referring to a mark that so resembles another mark as to be likely to cause confusion or mistake, §2(d) refers to a mark being likely “to deceive.” As a practical matter, this provision is rarely applied in examination, because deceptiveness involves intent and would be difficult to prove in an *ex parte* proceeding.

1207.03 Marks Previously Used in United States but Not Registered

As a basis for refusal, §2(d) refers not only to registered marks but also to “a mark or trade name previously used in the United States by another and not abandoned.” Refusal on the basis of an unregistered mark or trade name has sometimes been referred to as refusal on the basis of a “known mark.” This provision is not applied in *ex parte* examination because of the practical difficulties with which an examining attorney is faced in attempting to locate “previously used” marks and attempting to determine whether anyone has rights in them and whether they are “not abandoned.”

1207.04 Concurrent Use Registration

1207.04(a) Concurrent Use – In General [R-1]

Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), contains a proviso under which an eligible applicant may request issuance of a registration concurrent with the registration of a conflicting mark.

In a concurrent use application, the applicant normally requests a geographically restricted registration. The applicant seeks registration for a specified geographical area of the United States and lists one or more parties who concededly have rights in the mark in other geographical areas of the United States. These other parties may own applications or registrations, or they may have common law rights in a mark, but no application or registration. “Incontestable” registrations (*i.e.*, where the registrant’s right to use the mark has become incontestable pursuant to 15 U.S.C. §1065) are subject to concurrent use registration proceedings. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (C.C.P.A. 1976); *Thriftmart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330 (TTAB 1980). However, registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 (*see* TMEP §1601.05) are not subject to concurrent use registration proceedings. 37 C.F.R. §2.99(g).

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Concurrent use registration is requested by the applicant; it should not be suggested or initiated by the examining attorney.

1207.04(b) Filing Basis of Application Seeking Concurrent Use

In an application based on use in commerce under 15 U.S.C. §1051(a), the applicant may seek concurrent use registration at the time the application is filed or in a subsequent amendment. *See* 37 C.F.R. §2.73(a).

An applicant who files solely under §44, 15 U.S.C. §1126, may not seek a concurrent use registration.

In an application based on a bona fide intent to use the mark in commerce under 15 U.S.C. §1051(b), the applicant may not amend to seek concurrent use registration until the applicant files an acceptable amendment to allege use or statement of use. 37 C.F.R. §§2.73(b) and 2.99(g).

1207.04(c) Basis for Concurrent Use Registration

If an applicant requests a concurrent use registration, the examining attorney must first determine the basis for seeking such a registration. An application for registration as a concurrent user is either: (1) subject to a concurrent use registration proceeding before the Trademark Trial and Appeal Board, or (2) pursuant to the final determination by a court of competent jurisdiction of the concurrent rights of the parties to use the same or similar marks in commerce. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.99.

1207.04(d) Determining Eligibility for Concurrent Use

An applicant is eligible to request a registration subject to concurrent use if it meets one or more of the following criteria:

- (1) The concurrent use request is sought pursuant to a decree of a court of competent jurisdiction reflecting its final determination of the rights of the concurrent user;
- (2) The owner of the registration consents to the grant of a concurrent use registration to the applicant; or
- (3) The applicant's date of first use in commerce is before the *filing date* of the pending applications or of any registrations issued under the Trademark Act of 1946. When a party specified as an excepted user does not own an application or registration, the applicant's date of first use in commerce is before the filing date of any application to register the mark that may be filed by the excepted user.

The applicant has the burden of proving that it is entitled to a concurrent use registration. 37 C.F.R. §2.99(e).

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1207.04(d)(i) Requirements for All Concurrent Use Applications

An application for registration as a lawful concurrent user is generally examined in the same manner as any other application for registration. 37 C.F.R. §2.99(a). The examining attorney must examine the application to determine whether it complies with the relevant requirements for a non-restricted application (*see* 37 C.F.R. §§2.32 – 2.41). Additionally, the application must comply with the following requirements for a concurrent use application:

- (1) The applicant must specify the goods and the geographic area for which the applicant seeks registration of the mark. 15 U.S.C. §1051(a)(3)(D); 37 C.F.R. §2.42. The applicant must also set forth the mode of use. 15 U.S.C. §1052(d); 37 C.F.R. §2.42.
- (2) The applicant must specify, to the extent of its knowledge, the exceptions to its claim of exclusive use, listing any concurrent use by others and the relevant goods, geographic areas and periods of this use. 15 U.S.C. §1051(a)(3)(D); 37 C.F.R. §2.42.
- (3) The applicant must also list the names and addresses of the concurrent users, the registrations issued to or applications filed by them (if any), and the mode of such use. 37 C.F.R. §2.42.

The applicant does not have to insert the stated exceptions in the verification or declaration; the exceptions may be set forth in the statement portion of the application.

In addition to the requirements noted above, which apply to all applications for concurrent use registration, concurrent use applications must meet other conditions, depending on whether the application is subject to a concurrent use before the Board (*see* TMEP §§1207.04(e) *et seq.*) or pursuant to the decree of a court (*see* TMEP §§1207.04(f) *et seq.*).

1207.04(e) Applications Subject to Concurrent Use Proceeding Before the Trademark Trial and Appeal Board

If an application for concurrent use registration complies with the above requirements and it appears that the applicant is entitled to registration but for the question of concurrent rights, the examining attorney will approve the application for publication subject to a concurrent use registration proceeding. 15 U.S.C. §1062(a).

Ordinarily, the examining attorney should not require an applicant for concurrent use registration to submit evidence in support of its claim to concurrent rights. However, the examining attorney should refuse registration under §2(d) if the applicant has requested a concurrent use registration and information in the record suggests that the applicant has not met the basic requirements for concurrent use registration (*e.g.*, if the application indicates that the applicant adopted and used the mark with knowledge of the rights of a person specified as an excepted user, or that actual confusion has

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resulted from the concurrent use of the marks of the parties in their respective geographic areas). See *In re Place for Vision, Inc.*, 196 USPQ 267, 269-70 (TTAB 1977). *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987), *aff'g* 229 USPQ 474 (TTAB 1986).

1207.04(e)(i) Preparing the File for Publication

When the examining attorney determines that the mark in an application that is subject to a concurrent use proceeding is ready for publication, the examining attorney should prepare the file as follows:

- (1) The file must contain as many copies of the written application, specimens and drawing as may be necessary for the preparation of notices for each party specified as a concurrent user in the application. 37 C.F.R. §2.99(b). The copies are used by the Board to notify the concurrent users of the institution of the concurrent use proceeding.
- (2) The application must contain a concurrent use statement that will be printed in the *Official Gazette*. The statement may be submitted by the applicant or prepared by the examining attorney. The statement must be in the following form:

Subject to Concurrent Use Proceeding with _____ [specifying the application serial number(s) or registration number(s), if any, of each other party; otherwise, the name and address of each other party].

Applicant claims the exclusive right to use the mark in the area comprising _____ [specifying the area for which the applicant seeks registration].

- (3) To aid in the preparation of the file by the Legal Instruments Examiner (LIE), the examining attorney should prepare a one-page summary of the relevant concurrent use information. The information on the summary page should be set forth in the following manner:

CONCURRENT USE SUMMARY

Applicant:

Address:

Mark:

Goods or services:

Other Reg. or Serial Nos.:

Dates of use:

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Areas of use:

EXCEPTIONS TO EXCLUSIVE USE

Name:

Address:

Mark:

Goods or Services:

Reg. or Serial No.:

Dates of Use:

Area of use:

This summary should be attached to the front of the file.

After publication, if no opposition is filed, or if any opposition that is filed is dismissed or withdrawn, the Trademark Trial and Appeal Board will institute the concurrent use proceeding. The Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding. 37 C.F.R. §2.99(h). *See* 37 C.F.R. §2.99; TMEP §1506.

See, generally, Trademark Trial and Appeal Board Manual of Procedure (TBMP) Chapter 1100 (1st ed. Sept. 1995).

1207.04(f) Application for Concurrent Use Registration Pursuant to Court Decree

Under the last two sentences of §2(d), the Office may issue a concurrent use registration pursuant to the final determination of a court of competent jurisdiction that more than one person is entitled to use the same or similar marks in commerce. An applicant who seeks a concurrent use registration on the basis of a court determination does not have to claim use in commerce prior to the specified dates or obtain the consent of the owner of the involved mark, and the registration may be issued notwithstanding the possibility of public confusion. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (C.C.P.A. 1976). *Cf. Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (C.C.P.A. 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962).

When examining an application for concurrent use registration pursuant to the decree of a court, the examining attorney must determine whether the application complies with the specific requirements for concurrent use applications (*see* TMEP §§1207.04(d) and (d)(i)) and the requirements that would apply to an unrestricted application.

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In addition, under 37 C.F.R. §2.99(f), all of the following conditions must be met, or a concurrent use proceeding before the Board must be prepared and instituted:

- (1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding;
- (2) The court decree specifies the rights of the parties;
- (3) A true copy of the court decree is submitted to the examining attorney;
- (4) The concurrent use application complies fully and exactly with the court decree; and
- (5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree.

If any of the above conditions are *not* satisfied, the examining attorney will approve the application for publication subject to a concurrent use registration proceeding (*see* TMEP §§1207.04(e) and (e)(i)), rather than pursuant to the court decree. 37 C.F.R. §2.99(f).

1207.04(f)(i) Preparing the File for Publication

If the application complies with all of the conditions listed in TMEP §1207.04(f) and all other relevant requirements, and is otherwise entitled to registration, the examining attorney will approve the application for publication of the mark. The examining attorney should prepare the file as follows:

The application must contain a concurrent use statement to be printed in the *Official Gazette*. The statement may be submitted by the applicant or prepared by the examining attorney. The statement will delineate the concurrent rights of the parties as determined by the court, in the following form:

Registration limited to the area comprising _____ [specifying the area granted to the applicant by the court and any other restriction designated by the court] pursuant to the decree of _____ [specifying the name of the court, proceeding number and date of the decree].

Concurrent registration with _____ [specifying the application serial number(s) or registration number(s), if any, of each other party; otherwise, the name and address of each other party].

After publication, if no opposition is filed, or if any opposition that is filed is dismissed or withdrawn, the application will mature into a registration.

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1208 Conflicting Marks in Pending Applications

37 C.F.R. §2.83. *Conflicting marks.*

(a) *Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the “Official Gazette” for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.*

(b) *In situations in which conflicting applications have the same effective filing date, the application with the earliest date of execution will be published in the “Official Gazette” for opposition or issued on the Supplemental Register.*

(c) *Action on the conflicting application which is not published in the Official Gazette for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.*

1208.01 Priority for Publication or Issue Based on Effective Filing Date

In *ex parte* examination, priority among conflicting pending applications is determined based on the effective filing dates of the applications, without regard to whether the dates of use in a later-filed application are earlier than the filing date or dates of use of an earlier-filed application, whether the applicant in a later-filed application owns a registration for a mark that would be considered a bar to registration of the earlier-filed application, or whether an application was filed on the basis of use of the mark in commerce or a bona fide intent to use the mark in commerce.

When two or more applications contain marks that are conflicting, the mark in the application that has the *earliest effective filing date* will be published for opposition if it is eligible for registration on the Principal Register, or will be registered if it is eligible for registration on the Supplemental Register. 37 C.F.R. §2.83(a). *See* TMEP §§206 *et seq.* regarding effective filing dates.

The examining attorney cannot refuse registration under §2(d) of the Trademark Act based on an earlier-filed application for a conflicting mark until the mark registers. Therefore, when the examining attorney has examined the later-filed application and determined that it is in condition to be approved for publication or issue or in condition for a final refusal, except for the conflict between the marks, the examining attorney will *suspend* action on the later-filed application until the earlier-filed application matures into a registration or is abandoned. 37 C.F.R. §2.83(c); TMEP §§716.02(c) and 1208.02(c).

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1208.01(a) What Constitutes Conflict Between Pending Applications

Marks in applications filed by different parties are in conflict when the registration of one of the marks would be a bar to the registration of the other under §2(d) of the Trademark Act, 15 U.S.C. §1052(d). Therefore, the term “conflicting application” refers to an application to register a mark that so resembles the mark in another application as to be likely to cause confusion. *See* TMEP §702.03(b). *See* TMEP §§1207 *et seq.* regarding likelihood of confusion. There may be several conflicting pending applications.

1208.01(b) What Constitutes Effective Filing Date

The *filing date* of an application is the date when all the elements designated in 37 C.F.R. §2.21(a) are received at the Office. While this is generally the *effective filing date* for purposes of determining priority among conflicting applications, in certain situations another date is treated as the effective filing date. *See* TMEP §§206 *et seq.* For example, in an application claiming priority under §44(d) of the Trademark Act based on a foreign application, the effective filing date is the date of filing the foreign application. TMEP §206.02. In a §1(b) application that is amended to the Supplemental Register on the filing of an acceptable allegation of use, the effective filing date is the date of filing the amendment to allege use or the statement of use. TMEP §206.01.

If two or more applications conflict, the application with the earliest effective filing date will be approved for publication for opposition or for issuance of a registration on the Supplemental Register, as appropriate. 37 C.F.R. §2.83(a); TMEP §1208.01.

If conflicting applications have the same effective filing date, the application with the earliest date of execution will be published for opposition or issued on the Supplemental Register. 37 C.F.R. §2.83(b). An application that is unexecuted will be treated as having a later date of execution.

Occasionally, conflicting applications will have the same date of filing and execution. If this situation occurs, the application with the lowest serial number will have priority for publication or issuance. When determining which serial number is the lowest, the examining attorney should disregard the series code (*e.g.*, “76” or “78”) and look only to the six digit serial number.

1208.01(c) Change in Effective Filing Date During Examination

If the effective filing date in an application containing a conflicting mark changes, the examining attorney should review all the application(s) involved to determine which application has the earliest effective filing date as a result of the change.

The examining attorney should conduct a new search of the mark whenever the effective filing date of an application changes to a date that is later than the original filing date.

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1208.01(d) Examination of Conflicting Marks After Reinstatement or Revival

When an abandoned application is revived or reinstated (*see* TMEP §§1712.01, 1713 and 1714 *et seq.*), the examining attorney must conduct a new search to determine whether any later-filed applications for conflicting marks have been approved for publication or registration, and place the search strategy in the file.

If a later-filed application has been approved, the examining attorney should inform the examining attorney who approved the later-filed application that the earlier-filed application has been revived, if necessary. If the later-filed application has been published, the examining attorney handling that application should request jurisdiction (*see* TMEP §1504.04(a)) and suspend the application pending disposition of the earlier-filed application that was revived or reinstated.

If a later-filed application for a conflicting mark has matured into registration, the examining attorney must refuse registration of the revived or reinstated application under §2(d), even though the application for the registered mark was filed after the revived or reinstated application. The Office does not have the authority to cancel the registration.

1208.02 Conflicting Applications Examination Procedure

1208.02(a) Examination of Application with Earliest Effective Filing Date

When the application with the earliest effective filing date is first reviewed for action, the examining attorney should approve the application for publication or for issuance of a registration on the Supplemental Register, if appropriate. 37 C.F.R. §2.83(a).

If the application with the earliest effective filing date is not in condition for publication or issue, the examining attorney should issue an Office action that includes all relevant refusals and requirements.

The Office does not notify applicants of potentially conflicting later-filed applications.

See TMEP §§206 *et seq.* and 1208.01(b) regarding what constitutes an effective filing date.

1208.02(b) Action on Later-Filed Application: Giving Notice of the Earlier Application or Applications

If, when the later-filed conflicting application is first reviewed for action, it is not in condition for publication or issue, the examining attorney should, in addition to treating other matters, send with the Office action a copy of the drawing or a printout from the Office's automated search system of the information for the mark in each earlier-filed application. The examining attorney's letter should also advise the applicant that the earlier application, if and when it matures into a registration, may

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be cited against the applicant's later-filed application. The applicant should be notified of all conflicting applications with earlier effective filing dates.

See TMEP §1208.02(c) regarding suspension of later-filed conflicting applications that are otherwise in condition to be approved for publication or issue.

1208.02(c) Suspension of Later-Filed Application [R-1]

When the later-filed application is in condition for publication or issue except for the conflicting mark in an earlier-filed application, either because no action was necessary on the application as filed or because examination on other matters has been brought to a conclusion, the examining attorney should suspend the later-filed application until the mark in the earlier-filed application is registered or the earlier-filed application is abandoned. 37 C.F.R. §2.83(c). *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm'r Pats. 1993). If the examining attorney discovers that a previously-filed pending application was abandoned, but that a petition to revive is pending, the examining attorney should suspend the later-filed application pending disposition of the petition to revive.

Action on the later-filed application should also be suspended when the application is in condition for a final action but for the conflict with the earlier-filed application. The letter of suspension should repeat the outstanding issues, but these issues should not be made final.

If the Office action informing the applicant of the suspension is the first action in the case, the examining attorney should include a copy of the drawing or a printout from the Office automated search system of the information for the mark in each earlier-filed conflicting application.

1208.02(d) Action on Later-Filed Application upon Disposition of the Earlier Application or Applications

If all conflicting earlier-filed applications have either matured into registrations or become abandoned, and there are no other grounds for suspension, the examining attorney should remove the later-filed application from suspension and take appropriate action as follows.

The examining attorney should cite the registration or registrations that issued from the earlier-filed conflicting application or applications, if there is a likelihood of confusion. This will be a first refusal under §2(d) of the Trademark Act, 15 U.S.C. §1052(d). Any other outstanding issues should be repeated at this time.

If all earlier-filed applications have become abandoned, the examining attorney should either approve the later-filed application for publication or issue, or repeat and make final any remaining issues, as appropriate.

If some, but not all of the earlier-filed conflicting applications have matured into registrations, the examining attorney will normally not issue a refusal of registration

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until the remaining conflicting application(s) are registered or abandoned, in order to avoid issuing piecemeal refusals.

1208.02(e) Applicant's Argument on Issues of Conflict

If an applicant with a later-filed application argues that there is no conflict in relation to the application with the earlier effective filing date, the examining attorney should consider the merits of that argument and determine whether or not the earlier-filed application constitutes a potential bar to registration under §2(d) of the Act.

If the examining attorney concludes that the earlier-filed application is not a potential bar, the examining attorney should remove the application from suspension and take appropriate action on any other outstanding issues.

However, if the examining attorney concludes that the earlier-filed application is a potential bar, the examining attorney should issue an action for the later-filed application (*e.g.*, a letter of suspension if there are no other issues that are not in condition for final action), in which the examining attorney explains why the applicant's argument is not persuasive. *See* TMEP §716.03 regarding requests for removal of applications from suspension.

1208.02(f) Conflicting Mark Mistakenly Published or Approved for Issuance on the Supplemental Register

If a later-filed conflicting mark is mistakenly published for opposition, it may be necessary for the examining attorney to obtain jurisdiction of the application to take appropriate action. *See* TMEP §§1504 *et seq.* concerning obtaining jurisdiction of an application after publication.

The examining attorney does not lose jurisdiction of an application forwarded for issuance on the Supplemental Register until the day of issuance of the registration.

1208.03 Procedure Relating to Possibility of Interference

An interference will not be declared except upon petition to the Director. The Director will declare an interference only upon a showing of extraordinary circumstances that would result in a party being unduly prejudiced without an interference. These cases are extremely rare. In ordinary circumstances, the availability of an opposition or cancellation proceeding is deemed to remove any undue prejudice. 37 C.F.R. §2.91(a). Interferences are generally limited to situations where a party would otherwise be required to engage in a series of opposition or cancellation proceedings, and where the issues are substantially the same. *See* TMEP §1208.03(b). The potential need to file two notices of opposition that could be consolidated if the issues were sufficiently similar, is not considered an extraordinary circumstance that will unduly prejudice a petitioner without an interference.

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All petitions, or requests for interference are to be forwarded to the Commissioner for Trademarks for decision. The examining attorney does not make a determination on a request for interference.

See TBMP Chapter 1000.

1208.03(a) Procedures on Request for Interference

The request for interference should be in a separate paper in the form of a petition, and should be captioned as a petition. The petition fee indicated in 37 C.F.R. §2.6 should accompany the request. A petition to declare an interference should not be filed before the application has been examined and the mark has been found to be registrable but for the existence of one or more conflicting pending applications.

If the examining attorney receives a petition or request for interference, the examining attorney should forward it, with the file, to the Office of the Commissioner for Trademarks.

A request for interference does not make an application “special” or alter the normal order of examination.

See TBMP Chapter 1000.

1208.03(b) Decision on Request for Interference

Section 16 of the Trademark Act, 15 U.S.C. §1066, states that, upon petition showing extraordinary circumstances, the Director may declare that an interference exists when application is made for the registration of a mark that so resembles a mark previously registered by another, or for the registration of which another has previously applied, as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive. No interference shall be declared between an application and a registration that has become incontestable.

The Director will declare an interference only upon a showing of extraordinary circumstances that would result in a party being unduly prejudiced in the absence of an interference. 37 C.F.R. §2.91(a). The availability of opposition and cancellation procedures provides a remedy and ordinarily precludes the possibility of undue prejudice to a party. The request for interference must show that there is some extraordinary circumstance that would make the remedy of opposition or cancellation inadequate or prejudicial to the party's rights. See *In re Family Inns of America, Inc.*, 180 USPQ 332 (Comm'r Pats. 1974).

The fact that an earlier-filed application based on intent to use the mark in commerce under §1(b) or based on §44 has been cited against a later-filed application based on use in commerce under §1(a) is not an extraordinary circumstance that warrants declaration of an interference. An opposition proceeding is the proper forum for

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determining priority between an applicant and another party. Priority for purposes of examination of an application is determined by filing date.

Although §16 of the Act permits the declaration of an interference between an application and a registration, the practice of declaring an interference in these cases has been discontinued. The reason is that the applicant cannot obtain a registration if the interfering registration remains on the register. Therefore, even if the applicant prevailed in the interference, the applicant would still have to petition to cancel the interfering registration. See *In re Kimbell Foods, Inc.*, 184 USPQ 172 (Comm'r Pats. 1974); *Ex parte H. Wittur & Co.*, 153 USPQ 362 (Comm'r Pats. 1966); 37 C.F.R. §2.96.

See TBMP Chapter 1000.

1208.03(c) Procedure When Interference Is to be Declared

If the Director grants a petition requesting an interference, the examining attorney must determine that each mark is registrable but for the interfering mark before the interference will be instituted. 37 C.F.R. §2.92.

All marks must be published for opposition before interference proceedings are instituted; if possible, the marks should be published simultaneously.

Each application that is to be the subject of an interference must contain the following statement to be printed in the *Official Gazette*:

This application is being published subject to declaration of interference with:

Serial No.:

Filed:

Applicant:

(Address, if there is no attorney)

Attorney and Address:

Mark:

The examining attorney should prepare the statement.

If an application that is published subject to declaration of interference is opposed by a party other than the applicant(s) in the interfering application(s), the opposition will be determined first. If still necessary and appropriate, the interference will be instituted. If an opposition is filed by the applicant in the interfering application, the interference proceeding will not be instituted. The rights of the parties will be determined in the opposition proceeding.

If, during the pendency of an interference, another application appears involving substantially the same registrable subject matter, the examining attorney may request suspension of the interference for the purpose of adding that application. If the

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application is not added, the examining attorney should suspend further action on the application pending termination of the interference proceeding. 37 C.F.R. §2.98.

See TBMP Chapter 1000.

1209 Refusal on Basis of Descriptiveness

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them....

Matter that “merely describes” the goods or services on or in connection with which it is used is not registrable on the Principal Register. As noted in *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

1209.01 Distinctiveness/Descriptiveness Continuum

With regard to trademark significance, matter may be categorized along a continuum, ranging from marks that are highly distinctive to matter that is a generic name for the goods or services. The degree of distinctiveness -- or, on the other hand, descriptiveness -- of a designation can be determined only by considering it in relation to the specific goods or services. *Remington Products, Inc. v. North American Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444, 1448 (Fed. Cir. 1990) (the mark must be considered in context, *i.e.*, in connection with the goods).

At one extreme are marks that, when used in relation to the goods or services, are completely arbitrary or fanciful. Next on the continuum are suggestive marks, followed by merely descriptive matter. Finally, generic terms for the goods or services are at the opposite end of the continuum from arbitrary or fanciful marks. As stated in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), “[t]he generic name of a thing is in fact the ultimate in descriptiveness.”

Fanciful, arbitrary and suggestive marks, often referred to as “inherently distinctive” marks, are registrable on the Principal Register without proof of acquired distinctiveness. See TMEP §1209.01(a).

Marks that are merely descriptive of the goods or services may not be registered on the Principal Register absent a showing of acquired distinctiveness under 15 U.S.C.

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§1052(f). *See* TMEP §1209.01(b) regarding merely descriptive marks, and TMEP §§1212 *et seq.* regarding acquired distinctiveness. Merely descriptive marks may be registrable on the Supplemental Register. 15 U.S.C. §1091.

Matter that is generic for the goods or services is not registrable on either the Principal or the Supplemental Register under any circumstances. *See* TMEP §§1209.01(c) *et seq.*

1209.01(a) Fanciful, Arbitrary and Suggestive Marks

Fanciful marks comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language (*e.g.*, PEPSI, KODAK, EXXON) or are completely out of common usage (*e.g.*, FLIVVER).

Arbitrary marks comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality or characteristic of the goods or services (*e.g.*, APPLE for computers; OLD CROW for whiskey).

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. *See In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). *See also In re Quik-Print Copy Shop, Inc.*, 203 USPQ 624 (TTAB 1979), *aff'd*, 616 F.2d 523, 205 USPQ 505 (C.C.P.A. 1980) (QUIK-PRINT held merely descriptive of printing services); *In re Aid Laboratories, Inc.*, 223 USPQ 357 (TTAB 1984) (BUG MIST held merely descriptive of insecticide). Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. Therefore, a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable.

1209.01(b) Merely Descriptive Marks

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*,

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204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

It is not necessary that a term describe all of the purposes, functions, characteristics or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute or property. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

The great variation in facts from case to case prevents the formulation of specific rules for specific fact situations. Each case must be decided on its own merits. *See In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985); *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977).

See TMEP §§1209.03(a) through (s) regarding factors that often arise in determining whether a mark is merely descriptive or generic.

See also TMEP §§1213 *et seq.* concerning disclaimer of merely descriptive matter within a mark.

1209.01(c) Generic Terms

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). These terms are incapable of functioning as registrable trademarks denoting source, and are not registrable on the Principal Register under §2(f) or on the Supplemental Register.

1209.01(c)(i) Test

There is a two-part test used to determine whether a designation is generic: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public.

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The examining attorney has the burden of proving that a term is generic by clear evidence. *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the public's understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, newspapers and other publications. *See In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT, a term that designates a type of cake, held generic for ring cake mix); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (ANALOG DEVICES held generic for devices having analog capabilities).

When a term is a compound word, the examining attorney may establish that a term is generic by producing evidence that each of the constituent words is generic, and that the separate words retain their generic significance when joined to form a compound that has “a meaning identical to the meaning common usage would ascribe to those words as a compound.” *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111-1112 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screens).

However, the Court of Appeals for the Federal Circuit has expressly limited the holding in *Gould* to “compound terms formed by the union of words” where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends “no additional meaning to the term.” *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (citing *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999)). Where the mark is a phrase, the examining attorney cannot simply cite definitions and generic uses of the individual components of the mark, but must provide evidence of the meaning of the composite mark as a whole.

In *American Fertility Society*, the court held that evidence that the components “Society” and “Reproductive Medicine” were generic was not enough to establish that the composite phrase SOCIETY FOR REPRODUCTIVE MEDICINE was generic for association services in the field of reproductive medicine. The court held that the examining attorney must show: (1) the genus of services that the applicant provides; and (2) that the relevant public understands the proposed composite mark to primarily refer to that genus of services. 51 USPQ2d at 1836-37.

In *Dial-A-Mattress*, the court held that an alphanumeric phone number “bears closer conceptual resemblance to a phrase than a compound word.” 57 USPQ2d at 1811. The court found that 1-888-M-A-T-R-E-S-S was not generic as applied to “telephone shop-at-home retail services in the field of mattresses,” because there was no evidence of record that the public understood the term to refer to shop-at-home telephone mattress retailers. Therefore, to establish that a mnemonic phone number is generic, the examining attorney must show that the relevant public would understand the mark as a whole to have generic significance.

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1209.01(c)(ii) Terminology

As specifically amended by the Trademark Law Revision Act of 1988, §14 of the Trademark Act provides for the cancellation of a registration of a mark at any time if the mark “becomes the generic name for the goods or services, or a portion thereof, for which it is registered....” 15 U.S.C. §1064(3). Previously, that provision had pertained to a mark that “becomes the common descriptive name of an article or substance....” Cases previously distinguished between generic names and “apt or common descriptive names,” which referred to matter that, while not characterized as “generic,” had become so associated with the product that it was recognized in the applicable trade as another name for the product, serving as a term of art for all goods of that description offered by different manufacturers rather than identifying the goods of any one producer. *See Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 364 (TTAB 1978), *aff’d*, 599 F.2d 1009, 202 USPQ 100 (C.C.P.A. 1979). In addition, the Trademark Law Revision Act of 1988 amended §15 of the Trademark Act to adopt the term “generic name” to refer to generic designations. 15 U.S.C. §1065(4). In view of the amendment of §§14 and 15, a distinction between “generic” names and “apt or common descriptive” names should not be made. Rather, the terminology of the Act should be consistently used, *e.g.*, in refusals to register matter that is a generic name for the goods or services, or a portion thereof. *See In re K-T Zoe Furniture Inc.*, 16 F.3d 390, 29 USPQ2d 1787 (Fed. Cir. 1994).

Similarly, cases have distinguished between “generic” terms and terms that were deemed “so highly descriptive as to be incapable of exclusive appropriation as a trademark.” *See In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS held so highly descriptive as to be incapable of distinguishing applicant’s services of arranging and conducting seminars in the field of business law); *In re Industrial Relations Counselors, Inc.*, 224 USPQ 309 (TTAB 1984) (INDUSTRIAL RELATIONS COUNSELORS, INC. held an apt name or so highly descriptive of educational services in the industrial relations field that it is incapable of exclusive appropriation and registration, notwithstanding *de facto* source recognition capacity). Regarding current practice for refusing registration of such matter, the Trademark Trial and Appeal Board noted as follows in *In re Women’s Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 n.2 (TTAB 1992):

The Examining Attorney’s refusal that applicant’s mark is “so highly descriptive that it is incapable of acting as a trademark” is not technically a statutory ground of refusal. Where an applicant seeks registration on the Principal Register, the Examining Attorney may refuse registration under Section 2(e)(1) of the Act, 15 USC 1052(e)(1), on the basis that the mark sought to be registered is generic (citations omitted). Alternatively, an Examining Attorney may refuse registration under the same section if he or she believes that the mark is merely descriptive and that applicant’s showing of acquired distinctiveness is unpersuasive of registrability.

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In essence, the Board was merely emphasizing the need to use precise statutory language in stating grounds for refusal. While the decision does not explicitly bar the use of the terminology “so highly descriptive that it is incapable of acting as a trademark” under all circumstances, the case illustrates that the use of this terminology may lead to confusion and should be avoided. It is particularly important in this context to use the precise statutory language to avoid doctrinal confusion. *See generally* McLeod, *The Status of So Highly Descriptive and Acquired Distinctiveness*, 82 Trademark Rep. 607 (1992). Therefore, examining attorneys should not state that a mark is “so highly descriptive that it is incapable of acting as a trademark” in issuing refusals. Rather, in view of the amendments of the Trademark Act noted above, the terminology “generic name for the goods or services” should be used in appropriate refusals, and use of the terminology “so highly descriptive” should be discontinued when referring to incapable matter.

This does not mean that designations that might formerly have been categorized as “so highly descriptive” should not be regarded as incapable. The Court of Appeals for the Federal Circuit has specifically stated that “a phrase or slogan can be so highly laudatory and descriptive as to be incapable of acquiring distinctiveness as a trademark.” *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA for beer and ale held to be “so highly laudatory and descriptive of the qualities of [applicant’s] product that the slogan does not and could not function as a trademark to distinguish Boston Beer’s goods and serve as an indication of origin”).

The Court of Appeals for the Federal Circuit has stated that “[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus of goods or services in question.” *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989-990, 228 USPQ 528, 530 (Fed. Cir. 1986). Also note that it is entirely appropriate to consider whether a particular designation is “highly descriptive” in evaluating registrability under §2(f), or in similar circumstances.

The expression “generic name for the goods or services” is not limited to noun forms but also includes “generic adjectives,” that is, adjectives that refer to a genus, species, category or class of goods or services. *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers for use on permanent press products).

1209.01(c)(iii) Generic Matter: Case References

In the following cases, the matter sought to be registered was found generic: *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA for beer and ale held to be “so highly laudatory and descriptive of the qualities of [applicant’s] product that the slogan does not and could not function as a trademark to distinguish Boston Beer’s goods and serve as an indication of origin”); *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to premoistened antistatic

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cloths for cleaning computer and television screens); *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT, a term that designates a type of cake, held generic for ring cake mix); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for dealership services in the field of fine art, antiques, furniture and jewelry); *Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385 (TTAB 1999) (E-TICKET generic for computerized reservation and ticketing of transportation services); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for architectural design of buildings and retail outlets selling kits for building log homes); *In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998) (WEB COMMUNICATIONS generic for consulting services to businesses seeking to establish sites on a global computer network); *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers installed primarily in attics); *In re Stanbel Inc.*, 16 USPQ2d 1469 (TTAB 1990), *aff'd*, 20 USPQ2d 1319 (Fed. Cir. 1991) (ICE PAK for reusable ice substitute for use in food and beverage coolers held generic; even assuming a contrary holding, evidence submitted by applicant deemed insufficient to establish acquired distinctiveness); *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988) (PAINT PRODUCTS CO. for “interior and exterior paints and coatings, namely, alkyd, oil, latex, urethane and epoxy based paints and coatings” held so highly descriptive as to be incapable of becoming distinctive; even assuming the term could function as a mark, applicant’s evidence deemed insufficient to establish acquired distinctiveness); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (ANALOG DEVICES held generic for devices having analog capabilities); *In re Mortgage Bankers Association of America*, 226 USPQ 954 (TTAB 1985) (CERTIFIED MORTGAGE BANKER (“MORTGAGE BANKER” disclaimed) for “educational services, namely providing qualifying examinations, testing and grading in the field of real estate finance” held so highly descriptive as to be incapable of functioning as a mark notwithstanding evidence of acquired distinctiveness); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 222 (TTAB 1984) (HALF PRICE BOOKS RECORDS MAGAZINES for retail book and record store services “is incapable of designating origin and any evidence of secondary meaning can only be viewed as ‘de facto’ in import and incapable of altering the inability of the subject matter for registration to function as a service mark”).

In the following cases, the matter sought to be registered was found not to be generic: *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (1-888-M-A-T-R-E-S-S not generic for “telephone shop-at-home retail services in the field of mattresses”); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in the field of reproductive medicine); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (CASH MANAGEMENT ACCOUNT for “stock brokerage services, administration of money market fund services, and providing loans against securities services” held merely descriptive, rather than generic, and remanded to Board to consider sufficiency of §2(f) evidence); *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (FIRE CHIEF not

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generic for publications); *In re Federated Dept. Stores Inc.*, 3 USPQ2d 1541 (TTAB 1987) (THE CHILDREN'S OUTLET ("OUTLET" disclaimed), while merely descriptive of applicant's "retail children's clothing store services," held capable of functioning as a mark, with evidence submitted by applicant sufficient to establish acquired distinctiveness pursuant to §2(f)); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER for periodic trade journal held merely descriptive, rather than generic, and applicant's evidence held sufficient to establish acquired distinctiveness pursuant to §2(f)); *In re Failure Analysis Associates*, 1 USPQ2d 1144 (TTAB 1986) (FAILURE ANALYSIS ASSOCIATES, for "consulting services in the field of mechanical, structural, metallurgical, and metal failures, fires and explosions; engineering services in the field of mechanical design and risk analysis" and "consulting engineering services in the metallurgical field," found to be merely descriptive of applicant's services rather than incapable of distinguishing them from those of others; evidence submitted by applicant held sufficient to demonstrate acquired distinctiveness under §2(f)).

1209.02 Procedure for Descriptiveness and/or Genericness Refusal [R-1]

The examining attorney must consider the evidence of record to determine whether a mark is merely descriptive or whether it is suggestive or arbitrary. *See In re Noble Co.*, 225 USPQ 749, 750 (TTAB 1985). The examining attorney may request that the applicant submit additional explanations or materials to clarify the nature of the goods or services. 37 C.F.R. §2.61(b); TMEP §814. The examining attorney should also do any necessary research to determine the nature of the use of the designation in the marketplace. If the examining attorney refuses registration, he or she should support the refusal with appropriate evidence.

In all cases the examining attorney should try to make the Office action as complete as possible, so that the applicant may respond appropriately.

A designation that is merely descriptive should be refused registration under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). When issuing any refusal under §2(e)(1), if the designation appears to be a generic name for the goods or services, the examining attorney should provide an advisory statement that the subject matter appears to be a generic name for the goods or services, in conjunction with the refusal on the ground that the matter is merely descriptive. If, on the other hand, the mark appears to be capable, the examining attorney should provide appropriate advice concerning a possible amendment to the Supplemental Register or assertion of a claim of acquired distinctiveness. *See* TMEP §1102.03 concerning ineligibility of the proposed mark in a §1(b) application for the Supplemental Register prior to filing an acceptable amendment to allege use under 15 U.S.C. §1051(c) or statement of use under 15 U.S.C. §1051(d). If the record is unclear as to whether the designation is capable of functioning as a mark, the examining attorney should refrain from giving any advisory statement. In general, the Office should make every effort to apprise applicants as early as possible of the prospects for registration through appropriate amendments, if feasible.

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An examining attorney should not issue a refusal in an application for the Principal Register on the ground that a mark is a generic name for the goods or services unless the applicant asserts that the mark has acquired distinctiveness under 15 U.S.C. §1052(f). Even if it appears that the mark is generic, the proper basis for refusal is §2(e)(1). If there is strong evidence that the proposed mark is generic, a statement that the subject matter appears to be a generic name for the goods or services can be included as part of the §2(e)(1) refusal. It has been said that a generic term is “the ultimate in descriptiveness.” *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986).

If, in response to a first-action refusal under §2(e)(1), the applicant merely argues that the mark is registrable on the Principal Register without claiming acquired distinctiveness or amending to the Supplemental Register, the examining attorney should issue a final refusal under §2(e)(1), on the ground that the proposed mark is merely descriptive, if he or she is not persuaded by the applicant’s arguments.

If the applicant responds to a §2(e)(1) refusal by amending its application to the Supplemental Register, this amendment presents a new issue requiring consideration by the examining attorney (unless the amendment is irrelevant to the outstanding refusal—*see* TMEP §714.05(a)(i)). If the examining attorney determines that the designation is a generic name for the applicant’s goods or services, the examining attorney should then refuse registration on the Supplemental Register. The statutory basis for such a refusal is §23 of the Trademark Act, 15 U.S.C. §1091. This action must be nonfinal. *See* TMEP §§815 *et seq.* and 816 *et seq.* concerning applications for registration on the Supplemental Register.

If the applicant amends an application to assert acquired distinctiveness under §2(f), this raises a new issue. *See* TMEP §1212.02(h). If the examining attorney determines that the designation is a generic name for the applicant’s goods or services, the examining attorney should continue the refusal of registration on the Principal Register under §2(e)(1). The examining attorney should also explain why the showing of acquired distinctiveness is insufficient. The action must be nonfinal. *See* TMEP §§1212 *et seq.* regarding distinctiveness under §2(f), and TMEP §1212.02(i) regarding assertion of §2(f) claims with respect to generic matter.

To the fullest extent possible, the examining attorney will examine §1(b) intent-to-use applications for registrability under §2(e)(1) according to the same procedures and standards that apply to any other application. *See In re American Psychological Association*, 39 USPQ2d 1467 (Comm’r Pats. 1996); TMEP §§1102 and 1102.01.

1209.03 Considerations Relevant to Determination of Descriptiveness

The following sections discuss factors and situations that often arise during a determination of whether a mark is descriptive or generic.

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1209.03(a) Third-Party Registrations

Third-party registrations are not conclusive on the question of descriptiveness. Each case must stand on its own merits, and a mark that is merely descriptive should not be registered on the Principal Register simply because other such marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977) (SCHOLASTIC held merely descriptive of devising, scoring and validating tests for others). The question of whether a mark is merely descriptive must be determined based on the evidence of record at the time registration is sought. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS held merely descriptive of computer software for use in development and deployment of application programs on a global computer network).

1209.03(b) No Dictionary Listing

The fact that a term is not found in a dictionary is not controlling on the question of registrability if the examining attorney can show that the term has a well understood and recognized meaning. *See In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED held merely descriptive of jellies and jams).

1209.03(c) First or Only User

The fact that an applicant may be the first and only user of a merely descriptive or generic designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field). *See also* TMEP §1212.06(e)(i) and cases cited therein.

1209.03(d) Combined Terms

When two descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of “facsimile terminals employing electrophoretic displays”); *In re Entenmann’s Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff’d per curiam*, 928 F.2d 411 (Fed. Cir. 1991) (OATNUT held

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to be merely descriptive of bread containing oats and hazelnuts); *In re Serv-A-Portion Inc.*, 1 USPQ2d 1915 (TTAB 1986) (SQUEEZE N SERV held to be merely descriptive of ketchup and thus subject to disclaimer); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (EXPRESSERVICE held to be merely descriptive of banking and trust services); *In re Uniroyal, Inc.*, 215 USPQ 716 (TTAB 1982) (STEELGLAS BELTED RADIAL held merely descriptive of vehicle tires containing steel and glass belts); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of coasters suitable for direct mailing).

However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool).

When there is evidence that the composite mark itself has been used together to form a phrase that is descriptive of the goods or services, it is unnecessary to engage in an analysis of each individual component. *In re Shiva Corp.*, 48 USPQ2d 1957 (TTAB 1998) (TARIFF MANAGEMENT merely descriptive of computer hardware and computer programs to control, reduce and render more efficient wide area network usage).

The Trademark Trial and Appeal Board has held that the addition of the prefix “e” does not change the merely descriptive significance of a term in relation to goods or services sold or rendered electronically, where the record showed that the “e” prefix has become commonly recognized as a designation for goods or services sold and/or delivered electronically. *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000) (E FASHION merely descriptive of software used to obtain beauty and fashion information, and for electronic retailing services); *Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385 (TTAB 1999) (E-TICKET generic for computerized reservation and ticketing of transportation services). Similarly, the prefix “i” or “I” would be understood by purchasers to signify Internet, when used in relation to Internet-related products or services. *See In re Zanova, Inc.*, 59 USPQ2d 1300 (TTAB 2000) (ITOOL merely descriptive of computer software for use in creating web pages, and custom designing websites for others).

The addition of an entity designator (e.g., Corporation, Corp., Co., Inc., Ltd., etc.) to a descriptive term does not alter the term’s descriptive significance, because an entity designation has no source-indicating capacity. *See In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1215 (TTAB 2000) (“PRESS,” as applied to a printing or publishing establishment, “is in the nature of a generic entity designation which is incapable of serving a source-indicating function”); *In re The Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) (“PAINT PRODUCTS CO.’ is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a

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company.”); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984) (the element ‘INC.’ [in PACKAGING SPECIALISTS, INC.] has “no source indication or distinguishing capacity”). See TMEP §1213.03(d) regarding disclaimer of entity designators.

1209.03(e) More Than One Meaning

The fact that a term may have meanings other than the one relevant to a particular application is not controlling, because descriptiveness must be determined in relation to the goods or services for which registration is sought. See *In re Chopper Industries*, 222 USPQ 258 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Champion International Corp.*, 183 USPQ 318 (TTAB 1974).

See TMEP §1213.05(c) regarding wording that constitutes a “double entendre.”

1209.03(f) Picture or Illustration

A visual representation that consists merely of an illustration of the goods, or of an article that is an important feature or characteristic of the goods or services, is merely descriptive under §2(e)(1) of the Act. See *In re Society for Private and Commercial Earth Stations*, 226 USPQ 436 (TTAB 1985) (representation of satellite dish held merely descriptive of services of an association promoting the interests of members of the earth station industry); *In re Underwater Connections, Inc.*, 221 USPQ 95 (TTAB 1983) (pictorial representation of a compressed air gas tank held merely descriptive of travel tour services involving underwater diving). But see *In re LRC Products Ltd.*, 223 USPQ 1250 (TTAB 1984) (stylized hand design found not merely an illustration of the goods, *i.e.*, gloves; thus not merely descriptive).

1209.03(g) Foreign Equivalents/Dead or Obscure Languages

The foreign equivalent of a merely descriptive English word is no more registrable than the English word itself. Words from modern languages are translated into English to determine descriptiveness or genericness. *In re Northern Paper Mills*, 64 F.2d 998, 17 USPQ 492 (C.C.P.A. 1933). The test is whether, to those American buyers familiar with the foreign language, the word would have a descriptive or generic connotation. *In re Zazzara*, 156 USPQ 348 (TTAB 1967) (PIZZA FRITTE, the Italian equivalent of “fried buns,” held incapable for fried dough). See *In re Oriental Daily News, Inc.*, 230 USPQ 637 (TTAB 1986) (Chinese characters that translate as ORIENTAL DAILY NEWS held merely descriptive of newspapers); *In re Geo. A. Hormel & Co.*, 227 USPQ 813 (TTAB 1985) (SAPORITO, an Italian word meaning “tasty,” held merely descriptive because it describes a desirable characteristic of applicant’s dry sausage); *In re Optica International*, 196 USPQ 775 (TTAB 1977) (OPTIQUE, a French word meaning “optic,” held merely descriptive of eyeglass frames).

While foreign words are generally translated into English for purposes of determining descriptiveness, foreign words from dead or obscure languages may be so unfamiliar

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to the American buying public that they should not be translated into English for descriptiveness purposes. See *Enrique Bernat F. S.A. v. Guadalajara Inc.*, 210 F.3d 439, 54 USPQ2d 1497 (5th Cir. 2000), *reh'g denied* 218 F.3d 745 (2000); *cf. General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 45 USPQ2d 1481 (S.D.N.Y. 1997). The determination of whether a language is “dead” must be made on a case-by-case basis, based upon the meaning that the term would have to the relevant purchasing public.

Example: Latin is generally considered a dead language. However, if there is evidence that a Latin term is still in use by the relevant purchasing public (*e.g.*, if the term appears in current dictionaries or news articles), then a Latin term is not considered dead. The same analysis should be applied to other uncommon languages.

1209.03(h) Incongruity

Arbitrary and incongruous combinations of English terms with terms from a foreign language have been found registrable. See *In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988) (LA YOGURT for yogurt held registrable on Principal Register under §2(f), with a disclaimer of “YOGURT”); *In re Universal Package Corp.*, 222 USPQ 344 (TTAB 1984) (LE CASE held not merely descriptive of jewelry boxes and gift boxes and, therefore, registrable with a disclaimer of “CASE”).

1209.03(i) Intended Users

A term that identifies a group to whom the applicant directs its goods or services is merely descriptive. See *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER found merely descriptive of a trade journal directed toward users of large data processing systems; evidence sufficient to establish distinctiveness under §2(f)); *In re Camel Mfg. Co., Inc.*, 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER held merely descriptive of retail mail order services in the field of outdoor equipment and apparel).

1209.03(j) Phonetic Equivalent

A slight misspelling of a word will not turn a descriptive or generic word into a non-descriptive mark. See *C-Thru Ruler Co. v. Needleman*, 190 USPQ 93 (E.D. Pa. 1976) (C-THRU held to be the equivalent of “see-through” and therefore merely descriptive of transparent rulers and drafting aids); *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987) (MINERAL-LYX held generic for mineral licks for feeding livestock).

1209.03(k) Laudatory Terms

Laudatory terms, those that attribute quality or excellence to goods or services, are merely descriptive under §2(e)(1). See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (THE ULTIMATE BIKE RACK found to be merely

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descriptive and therefore subject to disclaimer); *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001) (the words BEST and PREMIER in mark BEST! SUPPORTPLUS PREMIER held merely descriptive of computer consultation and support services and thus subject to disclaimer); *In re Dos Padres Inc.*, 49 USPQ2d 1860 (TTAB 1998) (QUESO QUESADILLA SUPREME merely descriptive of cheese); *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995) (SUPER BUY held merely descriptive of tobacco products); *General Foods Corp. v. Ralston Purina Co.*, 220 USPQ 990 (TTAB 1984) (ORIGINAL BLEND held merely descriptive of cat food).

1209.03(l) Telephone Numbers

If an applicant applies to register a designation that consists of a merely descriptive term with numerals in the form of an alphanumeric telephone number (*e.g.*, 800, 888 or 900 followed by a word), the examining attorney should refuse registration under §2(e)(1). *See In re Page*, 51 USPQ2d 1660 (TTAB 1999) (888 PATENTS merely descriptive of patent-related legal services). The fact that a designation is in the form of a telephone number is insufficient, by itself, to render it distinctive.

If the relevant term is merely descriptive, but not generic, the mark may be registered on the Principal Register with a proper showing of acquired distinctiveness under §2(f), or on the Supplemental Register. *See Express Mortgage Brokers Inc. v. Simpson Mortgage Inc.*, 31 USPQ2d 1371 (E.D. Mich. 1994) (369-CASH held merely descriptive but shown to have acquired distinctiveness as applied to mortgage brokering and mortgage-related services). Of course, the designation must also be used in the manner of a mark. *See* TMEP §§1202 *et seq.* regarding use as a mark.

If the proposed mark is generic, the designation is unregistrable on either the Principal or the Supplemental Register. However, to support a refusal of registration on the ground that a telephone number is generic, the Court of Appeals for the Federal Circuit has held that it is not enough to show that the telephone number consists of a non-source-indicating area code and a generic term. The examining attorney must show evidence of the meaning the relevant purchasing public accords the proposed alphanumeric mark as a whole. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001). *See also Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675, 11 USPQ2d 1644 (2d Cir. 1989) (use of confusingly similar telephone number enjoined). *But see Dranoff-Perlstein Associates v. Sklar*, 967 F.2d 852, 23 USPQ2d 1174, 1178 (3d Cir. 1992) (“[W]e decline to adopt the position espoused by the Second Circuit that telephone numbers which correlate to generic terms may be protectible as trademarks.... If telephone numbers that correlate to generic terms were granted protection, the first firm in a given market to obtain such a telephone number would, merely by winning the race to the telephone company, gain an unfair advantage over its competitors.”) (footnotes omitted); *800 Spirits Inc. v. Liquor By Wire, Inc.*, 14 F. Supp.2d 675 (D.N.J. 1998) (800 SPIRITS generic for “gift delivery service of alcohol beverages”).

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1209.03(m) Domain Names

Internet domain names raise some unique trademark issues. A mark comprised of an Internet domain name is registrable as a trademark or service mark only if it functions as an identifier of the source of goods or services. Portions of the uniform resource locator (URL) including the beginning, (“http://www.”) and the top level Internet domain name (TLD) (e.g., “.com,” “.org,” “.edu,”) function to indicate an address on the World Wide Web, and therefore generally serve no source-indicating function. See TMEP §§1215 *et seq.* regarding marks comprising domain names. TLDs may also signify abbreviations for the type of entity for whom use of the cyberspace has been reserved. For example, the TLD “.com” signifies to the public that the user of the domain name constitutes a commercial entity. See *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888) (“The addition of the word ‘Company’ [to an otherwise generic mark] only indicates that parties have formed an association or partnership to deal in such goods . . .” and does not render the generic mark registrable).

If a proposed mark includes a TLD such as “.com”, “.biz”, “.info”, the examining attorney should present evidence that the term is a TLD, and, if available, evidence of the significance of the TLD as an abbreviation (e.g. “.edu” signifies an educational institution, “.biz” signifies a business).

Because TLDs generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable. See *Goodyear*, 128 U.S. at 602 (the incorporation of a term with no source-indicating function into an otherwise generic mark cannot render it registrable). For example, if a proposed mark is composed of merely descriptive term(s) combined with a TLD, the examining attorney must refuse registration on the Principal Register under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. See TMEP §1215.04.

Similarly, if a proposed mark is composed of generic term(s) for the applicant’s goods or services and a TLD, the examining attorney must refuse registration on the ground that the mark is generic. See TMEP §§1209.01(c)(i) and 1215.05.

1209.03(n) “America” or “American”

If “AMERICA” or “AMERICAN” appears in a phrase or slogan, the examining attorney must evaluate the entire mark to determine whether it is merely descriptive as laudatory or even incapable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA’S FRESHEST ICE CREAM held incapable); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (AMERICA’S FAVORITE POPCORN held merely descriptive). Typically these marks primarily extol the quality or popularity of the goods or services and secondarily denote geographic origin. The examining attorney must

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look at each mark to determine whether it is capable, considering all relevant circumstances and case law. *See* TMEP §1210.02(c) and cases cited therein regarding use of terms such as “AMERICA,” “AMERICAN,” and “USA” in a way that is primarily geographically descriptive under 15 U.S.C. §1052(e)(2), primarily geographically deceptively misdescriptive under 15 U.S.C. §1052(e)(3), or deceptive under 15 U.S.C. §1052(a).

1209.03(o) “National” or “International”

The terms “NATIONAL” and “INTERNATIONAL” have been held to be merely descriptive of services that are international or nationwide in scope. *See Jefferson Bankshares Inc. v. Jefferson Savings Bank*, 14 USPQ2d 1443 (W.D. Va. 1989) (NATIONAL BANK merely descriptive of banking services); *National Automobile Club v. National Auto Club, Inc.*, 365 F. Supp. 879, 180 USPQ 777 (S.D.N.Y. 1973), *aff’d*, 502 F.2d 1162 (2d Cir. 1974) (NATIONAL merely descriptive of auto club services); *In re Institutional Investor, Inc.*, 229 USPQ 614 (TTAB 1986) (INTERNATIONAL BANKING INSTITUTE for organizing seminars for bank leaders of major countries held incapable); *In re Billfish International Corp.*, 229 USPQ 152 (TTAB 1986) (BILLFISH INTERNATIONAL CORPORATION merely descriptive of corporation involved with billfish on an international scale); *In re National Rent A Fence, Inc.*, 220 USPQ 479 (TTAB 1983) (NATIONAL RENT A FENCE merely descriptive of nationwide fence rental services); *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233 (TTAB 1979) (INTERNATIONAL TRAVELERS CHEQUE merely descriptive of financial consulting services that are international in scope); *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691 (TTAB 1978) (NATIONAL INSURANCE TRUST merely descriptive of services of handling administrative matters in locating suitable insurance coverage for attorneys).

1209.03(p) Function or Purpose

Terms that identify the function or purpose of a product or service may be merely descriptive or generic under 15 U.S.C. §1051(e)(1). *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic for an anti-static cloth used for cleaning computer and television screens); *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers installed primarily in attics); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers for use on permanent press products); *In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 1984) (WALLYBALL held descriptive of sports clothing and game equipment); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977) (BURGER held merely descriptive of cooking utensils); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED held merely descriptive of jams and jellies).

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1209.03(q) Source or Provider of Goods or Services

Terms that identify the source or provider of a product or service may be merely descriptive under 15 U.S.C. §1051(e)(1) or generic. *In re Major League Umpires*, 60 USPQ2d 1059 (TTAB 2001) (MAJOR LEAGUE UMPIRE merely descriptive of clothing, face masks, chest protectors and skin guards); *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213 (TTAB 2000) (PSYCHOLOGY PRESS merely descriptive of books in field of psychology); *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988) (PAINT PRODUCTS COMPANY incapable for paint); *In re The Phone Co., Inc.*, 218 USPQ 1027 (TTAB 1983) (THE PHONE COMPANY merely descriptive of telephones).

1209.03(r) Retail Store and Distributorship Services

A term that is generic for goods is descriptive of retail store services featuring those goods, when the goods are not a significant item typically sold in the type of store in question. *In re Pencils Inc.*, 9 USPQ2d 1410 (TTAB 1988) (PENCILS held merely descriptive of office supply store services). However, where the matter sought to be registered identifies the primary articles of a store or distributorship service, the term is considered generic. *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for dealership services in the field of fine art, antiques, furniture and jewelry); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for retail outlets selling kits for building log homes); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE held generic for retail stores specializing in the sale of lingerie); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of products made of wicker); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219 (TTAB 1984) (HALF PRICE BOOKS RECORDS MAGAZINES generic for retail book and record store services). The examining attorney, therefore, must analyze the term in relation to the services recited, the context in which it is used and the possible significance it would have to the recipient of the services. *Pencils*, 9 USPQ2d at 1411.

1209.03(s) Slogans

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). See TMEP §1202.04 and cases cited therein.

1209.04 Deceptively Misdescriptive Marks

Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), also prohibits registration of designations that are deceptively misdescriptive of the goods or

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services to which they are applied. The examining attorney must consider the mark in relation to the applicant's goods or services to determine whether a mark is deceptively misdescriptive.

The examining attorney must first determine whether a term is misdescriptive as applied to the goods or services. A term that conveys an immediate idea of an ingredient, quality, characteristic, function or feature of the goods or services with which it is used is merely descriptive. *See* TMEP §1209.01(b). If a term immediately conveys such an idea but the idea is false, although plausible, then the term is deceptively misdescriptive and is unregistrable under §2(e)(1). *See In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987) (CAMEO held deceptively misdescriptive of jewelry); *In re Ox-Yoke Originals, Inc.*, 222 USPQ 352 (TTAB 1983) (G.I. held deceptively misdescriptive of gun cleaning patches, rods, brushes, solvents and oils).

The Trademark Act does not prohibit the registration of misdescriptive terms unless they are deceptively misdescriptive, that is, unless persons who encounter the mark, as used on or in connection with the goods or services in question, are likely to believe the misrepresentation. *See Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984) (LIQUID CRAYON held neither common descriptive name, nor merely descriptive, nor deceptively misdescriptive of coloring kits or markers).

As explained in the case of *In re Quady Winery Inc.*, 221 USPQ 1213, 1214 (TTAB 1984):

The test for deceptive misdescriptiveness has two parts. First we must determine if the matter sought to be registered misdescribes the goods. If so, then we must ask if it is also deceptive, that is, if anyone is likely to believe the misrepresentation. *Gold Seal Co. v. Weeks*, 129 F. Supp. 928 (D.D.C. 1955), *aff'd sub nom. S.C. Johnson & Son v. Gold Seal Co.*, 230 F.2d 832 (D.C. Cir.) (*per curiam*), *cert. denied*, 352 U.S. 829 (1956). A third question, used to distinguish between marks that are deceptive under Section 2(a) and marks that are deceptively misdescriptive under Section 2(e)(1), is whether the misrepresentation would materially affect the decision to purchase the goods. *Cf. In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983).

If the misdescription represented by the mark is material to the decision to purchase the goods or use the services, then the mark should be refused registration under §2(a) of the Trademark Act, 15 U.S.C. §1052(a). *See* TMEP §1203.02 regarding deceptive marks, and 1203.02(a) regarding the distinction between deceptive marks and deceptively misdescriptive marks.

The examining attorney should consider and make of record, or require the applicant to make of record, all available information that shows the presence or absence, and the materiality, of a misrepresentation. The mere fact that the true nature of the goods or services is revealed by other matter on the labels, advertisements or other materials

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to which the mark is applied does not preclude a determination that a mark is deceptively misdescriptive. *See R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (C.C.P.A. 1964) (DURA-HYDE held deceptive and deceptively misdescriptive of plastic material of leather-like appearance made into shoes); *In re Woolrich Woolen Mills Inc.*, 13 USPQ2d 1235 (TTAB 1989) (WOOLRICH for clothing not made of wool found not to be deceptive under §2(a)); *Tanners' Council of America, Inc. v. Samsonite Corp.*, 204 USPQ 150 (TTAB 1979) (SOFTHIDE held deceptive within the meaning of §2(a) for imitation leather material).

See also Northwestern Golf Co. v. Acushnet Co., 226 USPQ 240 (TTAB 1985); *R.J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169 (TTAB 1985); and *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984) regarding the issue of deceptive misdescriptiveness.

Marks that have been refused registration pursuant to §2(e)(1) on the ground of deceptive misdescriptiveness may be registrable under §2(f) upon a showing of acquired distinctiveness, or on the Supplemental Register. 15 U.S.C. §§1052(f) and 1091. Marks that are deceptive under §2(a) are not registrable on either the Principal Register or the Supplemental Register under any circumstances.

1210 Refusal on Basis of Geographic Significance

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

(a) Consists of or comprises ... deceptive ... matter; ... or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after [January 1, 1996].

...

(e) Consists of a mark which ... (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them....

Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), prohibits registration on the Principal Register of a mark that is primarily geographically descriptive of the goods or services named in the application. *See* TMEP §1210.01(a).

Section 2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), prohibits registration of a mark that is primarily geographically deceptively misdescriptive of the goods or services named in the application. *See* TMEP §1210.01(b). Prior to the amendment

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of the Trademark Act on January 1, 1994, by the North American Free Trade Agreement Implementation Act, Public Law 103-182, 107 Stat. 2057, the statutory basis for refusal to register primarily geographically deceptively misdescriptive marks was §2(e)(2).

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), prohibits registration of a designation that consists of or comprises deceptive matter, as well as geographical indications which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods. *See* TMEP §§1210.01(c), 1210.05(a) and 1210.05(b).

See TMEP §1210.06(a) regarding the registrability of geographic terms on the Supplemental Register, TMEP §1210.06(b) regarding the registrability of geographic terms on the Principal Register under §2(f), and TMEP §1210.08 regarding disclaimer of geographic terms.

1210.01 Elements

1210.01(a) Geographically Descriptive Marks - Test

If a mark identifies the geographic origin of the goods or services, the issue is whether or not the mark is primarily geographically descriptive of the goods or services within the meaning of §2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2).

To establish a *prima facie* case for refusal to register a mark as primarily geographically descriptive, the examining attorney must show that:

- (1) the primary significance of the mark is geographic (*see* TMEP §1210.02(b));
- (2) purchasers would be likely to make a goods/place or services/place association, *i.e.*, to think that the goods or services originate in the geographic place identified in the mark (*see* TMEP §§1210.04 *et seq.*); and
- (3) the mark identifies the geographic origin of the goods or services (*see* TMEP §1210.03).

A mark that is found to be primarily geographically descriptive within the meaning of §2(e)(2) may be registrable on the Principal Register under §2(f), or on the Supplemental Register. *See* TMEP §§1210.06(a) and (b).

1210.01(b) Geographically Deceptively Misdescriptive Marks - Test

If a mark identifies a place other than the place where the goods or services originate, the issue is: (1) whether the mark is primarily geographically deceptively misdescriptive of the goods or services within the meaning of §2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3); or (2) whether the mark is deceptive of the goods or services within the meaning of §2(a) of the Trademark Act, 15 U.S.C.

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§1052(a). *See* TMEP §§1210.01(c) and 1210.05(a) *et seq.* regarding geographically deceptive marks.

To support a refusal to register a mark as primarily geographically deceptively misdescriptive, the examining attorney must show that:

- (1) the primary significance of the mark is geographic (*see* TMEP §1210.02(b));
- (2) purchasers would be likely to make a goods/place or services/place association, *i.e.*, to think that the goods or services originate in the geographic place identified in the mark (*see* TMEP §§1210.04 *et seq.*); and
- (3) the goods or services do not originate in the place identified in the mark (*see* TMEP §1210.03).

In re Save Venice New York Inc., 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *Institut National Des Appellations D'Origine v. Vintners Int'l Co. Inc.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992); *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (C.C.P.A. 1982).

A mark that is primarily geographically deceptively misdescriptive may not be registered on the Supplemental Register unless the mark has been in lawful use in commerce since before December 8, 1993, and may not be registered on the Principal Register under §2(f) unless the mark became distinctive of the goods or services in commerce before December 8, 1993. TMEP §§1210.06(a) and (b). A mark that includes a primarily geographically deceptively misdescriptive term is unregistrable even with a disclaimer. *See* TMEP §1210.08.

1210.01(c) Geographically Deceptive Marks - Test

To support a refusal of registration on the ground that a geographic term is deceptive under §2(a), the examining attorney must show that:

- (1) the primary significance of the mark is geographic (*see* TMEP §1210.02(b));
- (2) the goods or services do not originate in the place identified in the mark (*see* TMEP §1210.03);
- (3) purchasers would be likely to make a goods/place or services/place association, *i.e.*, to believe that the goods or services originate in the geographic place identified in the mark (*see* TMEP §§1210.04 *et seq.*); and
- (4) a purchaser's erroneous belief as to the geographic origin of the goods or services would materially affect the purchaser's decision to buy the goods or use the services.

See Institut National des Appellations D'Origine v. Vintners Int'l Co., Inc., 958 F.2d 1574, 1580, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992) (evidence showing that Chablis is name of region in France insufficient to establish that CHABLIS WITH A TWIST

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is geographically deceptive of wine under §2(a), where evidence showed that the term “Chablis” would be perceived by consumers in the United States as the generic name for a type of wine with the general characteristics of French chablis).

Section 2(a) is an absolute bar to registration on either the Principal or Supplemental Register. *See* TMEP §§1210.06(a) and (b). A disclaimer of the deceptive matter will not overcome a refusal under §2(a). *See* TMEP §1210.08.

See TMEP §§1210.05(a) *et seq.* for additional information about geographically deceptive marks.

1210.02 Primarily Geographic Significance

A mark is primarily geographic if it identifies a real and significant geographic location, and the primary meaning of the mark is the geographic meaning.

1210.02(a) Geographic Locations

A geographic location may be any term identifying a country, city, state, continent, locality, region, area or street.

The adjectival form of the name of a geographic location, a geographic nickname, or an abbreviation or other variant of the name of a geographic location is treated the same as the actual name of the geographic location if it is likely to be perceived as such by the purchasing public. *See In re Jack’s Hi-Grade Foods, Inc.*, 226 USPQ 1028 (TTAB 1985) (NEAPOLITAN held primarily geographically deceptively misdescriptive of sausage emanating from the United States, where the term is defined as “of or pertaining to Naples in Italy”).

A map or outline of a geographic area is treated the same as the actual name of the geographic location if it is likely to be perceived as such by the purchasing public. *See In re Canada Dry Ginger Ale, Inc.*, 86 F.2d 830, 32 USPQ 49 (C.C.P.A. 1936) (map of Canada held to be the equivalent of the word “Canada”). *Cf. In re Texsun Tire and Battery Stores, Inc.*, 229 USPQ 227 (TTAB 1986) (indicating that if the depiction of a map is fanciful or so integrated with other elements of a mark that it forms a unitary whole, then the map should not be considered primarily geographically descriptive).

Vague geographic terms (*e.g.*, “Global,” “National,” “International,” or “World”) are *not* considered to be primarily geographic, though they may be merely descriptive or deceptively misdescriptive under §2(e)(1). *See* TMEP §1209.03(o).

See also In re Pebble Beach Co., 19 USPQ2d 1687 (TTAB 1991) (17 MILE DRIVE not a geographic term, where it refers to a specific location wholly owned by applicant, and was coined by applicant to refer both to applicant’s services and the place where the services were performed).

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1210.02(b) Primary Significance

To support a refusal to register geographic matter, the Trademark Act requires that the mark be *primarily* geographic, that is, that its primary significance be that of a geographic location. 15 U.S.C. §§1052(e)(2) and (3). *See, e.g., In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (primary significance of NEW YORK held to geographic; Court was not persuaded by assertions that the composite NEW YORK WAYS GALLERY evokes a gallery that features New York “ways” or “styles”); *Scotch Whisky Ass’n v. U.S. Distilled Products Co.*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991) (not necessary to show that term is “primarily recognized as a geographic term in and of itself” in order to state a claim under §2(a); allegations that Scottish surname MCADAMS is strongly associated by the United States public with Scotland, that it is a common practice to market Scotch whisky in the United States under marks comprising Scottish surnames, and that such marks have come to be understood by the United States public to identify the geographic origin of such goods found sufficient to state a claim under §2(a)); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987) (evidence insufficient to establish that public in United States would perceive VITTEL as the name of a place where cosmetic products originate; Vittel, France found to be obscure); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985) (WESTPOINT held not primarily geographically deceptively misdescriptive of various types of guns that are not produced in West Point, New York, the Board observing that the primary significance of WESTPOINT is as the name of the United States Military Academy rather than the town in New York); *In re Norfolk Wallpaper, Inc.*, 216 USPQ 903 (TTAB 1983) (THE NORFOLK PLAN held not primarily geographically descriptive of “installation of wallpaper and retail wallpaper store services,” the Board noting that the examining attorney failed to make the necessary threshold showing of the relevant geographic place to which descriptiveness is attributed).

The fact that the mark has meaning or usage other than as a geographic term does not necessarily alter its primarily geographic significance. Thus, if a geographic term has another meaning, the examining attorney must determine whether the *primary* significance is geographic. If so, refusal of registration under §2(e)(2) or §2(e)(3) is appropriate. *See, e.g., In re Opryland USA Inc.*, 1 USPQ2d 1409, 1413 (TTAB 1986) (THE NASHVILLE NETWORK held primarily geographically descriptive of television program production and distribution services, the Board finding that the primary significance of the term was Nashville, Tennessee, and not that of a particular style of music); *In re Cookie Kitchen, Inc.*, 228 USPQ 873, 874 (TTAB 1986) (the fact that MANHATTAN identifies an alcoholic cocktail does not alter the primary significance of that term as a borough of New York City); *In re Jack’s Hi-Grade Foods, Inc.*, 226 USPQ 1028, 1029 (TTAB 1985) (the fact that NEAPOLITAN identifies, among other things, a type of ice cream does not alter the primary significance of that term as meaning “of or pertaining to Naples in Italy”).

However, if the most prominent meaning or significance of the mark is not geographic, or if the mark creates a separate readily understood meaning that is not

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geographic, then a refusal under §2(e)(2) or §2(e)(3) is not appropriate. *See Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951), *aff'd*, 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) (primary significance of HYDE PARK for men's suits is to suggest that the product is stylish or of high quality rather than to provide information about geographic origin); *In re International Taste Inc.*, 53 USPQ2d 1604, 1605-06 (TTAB 2000) (because of other prominent, significant meaning of HOLLYWOOD as referring to the entertainment industry in general, doubt about the primary significance of HOLLYWOOD was resolved in favor of the applicant); *In re Urbano*, 51 USPQ2d 1776, 1780 (TTAB 1999) (primary significance of SYDNEY 2000, used for advertising and business services and communication services, is as a reference to the Olympic Games, not to the name of a place within the meaning of §§2(e)(2) and 2(e)(3)); *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455, 1456 (TTAB 1987) (primary significance of THE GREAT AMERICAN BASH for promoting, producing and presenting professional wrestling matches, is to suggest something of desirable quality or excellence rather than to describe the geographic origin of the services); *In re Dixie Insurance Co.*, 223 USPQ 514, 516 (TTAB 1984) (DIXIE held not primarily geographically descriptive of property and casualty underwriting services, where the examining attorney provided no evidence to show that the geographical significance of DIXIE was its primary significance). *See also In re Municipal Capital Markets Corp.*, 51 USPQ2d 1369, 1371 (TTAB 1999) (COOPERSTOWN held not to be primarily geographically deceptively misdescriptive of restaurant services, the majority finding that the primary significance of COOPERSTOWN is that of "an institution, namely, the Baseball Hall of Fame" rather than a geographic location).

The fact that the mark identifies more than one geographic location does not necessarily detract from the term's primary geographic significance. *See, e.g., In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985) (DURANGO held primarily geographically deceptively misdescriptive of chewing tobacco not grown in Durango, Mexico, where the evidence of record showed that tobacco is a crop produced and marketed in that area, even though there is more than one place named Durango); *In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL and design ("DIGITAL" disclaimed) held primarily geographically descriptive of computer system and parts thereof, where applicant's place of business is Cambridge, Massachusetts, even though there is more than one Cambridge).

When two geographical terms are combined in the same mark, the primary significance of the composite may still be geographic, if purchasers would believe that the goods or services originate from or are rendered in both of the locations named in the mark. *See In re Narada Productions, Inc.*, 57 USPQ2d 1801, 1803 (TTAB 2001) (CUBA L.A. primarily geographically deceptively misdescriptive of musical recordings and live musical performances that do not originate in Cuba or Los Angeles, the Board finding that purchasers would understand the composite as a reference to the two places named rather than to "some mythical place called 'Cuba L.A.'"); *In re London & Edinburgh Insurance Group Ltd.*, 36 USPQ2d 1367, 1369-70 (TTAB 1995) (LONDON & EDINBURGH INSURANCE primarily

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geographically descriptive of insurance and underwriting services that are rendered or originate in the cities of London and Edinburgh).

When a geographic term is combined with additional matter (*e.g.*, wording and/or a design element), the examining attorney must determine the primary significance of the composite. *See In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1034 (TTAB 1997) (HAVANA SELECT, HAVANA CLASICO, OLD HAVANA, HAVANA PRIMO, and HAVANA CLIPPER primarily geographically deceptively misdescriptive of rum, the Board finding that the added terms do not detract from primarily geographic significance). *See* TMEP §§1210.07 *et seq.* regarding composite marks that include geographic terms.

Generally, the addition of a highly descriptive or generic term to the name of a geographic place does not alter its primarily geographic significance. *See, e.g. In re JT Tobacconists*, 59 USPQ2d 1080, 1083 (TTAB 2001); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998); *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637, 1639 (TTAB 1991); *In re Wine Society of America Inc.*, 12 USPQ2d 1139, 1141-42 (TTAB 1989); *In re Cambridge Digital Systems, supra*.

See TMEP §1210.04(d) regarding obscure or remote geographic marks.

1210.02(c) “America” or “American” and Similar Terms in Marks

When terms such as “AMERICA,” “AMERICAN” and “USA” appear in marks, the determination as to whether the term or the entire mark should be considered geographic can be a particularly difficult one. There is no simple or mechanical answer to the question of how to treat “AMERICA” or “AMERICAN” in a mark. The examining attorney must evaluate each mark on a case-by-case basis. The examining attorney must consider the entire context, the type of goods or services at issue, the geographic origin of the goods or services and, most importantly, the overall commercial impression engendered by the mark at issue. The following principles, developed in the case law, should provide guidance in reaching a judgment in a given case.

- (1) If “AMERICA” or “AMERICAN” is used in a way that primarily denotes the United States origin of the goods or services, then the term is primarily geographically descriptive. *See, e.g., American Diabetes Association, Inc. v. National Diabetes Association*, 533 F. Supp. 16, 214 USPQ 231 (E.D. Pa. 1981), *aff'd*, 681 F.2d 804 (3d Cir. 1982) (AMERICAN DIABETES ASSOCIATION held primarily geographically descriptive); *In re Monograms America, Inc.*, 51 USPQ2d 1317 (TTAB 1999) (MONOGRAMS AMERICA primarily geographically descriptive of consultation services for owners of monogramming shops); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986) (BANK OF AMERICA held primarily geographically descriptive); *American Paper & Plastic Products, Inc. v. American Automatic Vending Corp.*, 152 USPQ 117 (TTAB 1966) (AMERICAN AUTOMATIC VENDING held primarily

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geographically descriptive). One commentator refers to such marks as exhibiting an “unadorned” use of “AMERICA” or “AMERICAN.” 2 J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §14:11 (4th ed. 2000). Many service marks (e.g., association-type marks) fall squarely into this category. *See also In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998) (U.S. CARGO primarily geographically descriptive of towable trailers carrying cargo and vehicles).

- (2) If a composite mark does not primarily convey geographic significance overall, or if “AMERICA” or “AMERICAN” is used in a nebulous or suggestive manner, then it is inappropriate to treat “AMERICA” or “AMERICAN” as primarily geographically descriptive. *See, e.g., Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.*, 240 U.S. 251 (1916) (THE AMERICAN GIRL held not primarily geographically descriptive for shoes); *American Plan Corp. v. State Loan & Finance Corp.*, 365 F.2d 635, 150 USPQ 767 (3d Cir. 1966), *cert. denied*, 385 U.S. 1011, 152 USPQ 844 (1967) (AMERICAN PLAN CORPORATION held not primarily geographically descriptive); *Wilco Co. v. Automatic Radio Mfg. Co., Inc.*, 255 F. Supp. 625, 151 USPQ 24 (D. Mass. 1966) (ALL AMERICAN held not primarily geographically descriptive); *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987) (THE GREAT AMERICAN BASH held not primarily geographically descriptive of wrestling exhibitions). The introduction of a nuance, even a subtle one, may remove a mark from the primarily geographically descriptive category. This area calls for the most difficult analysis. The examining attorney must determine whether the overall commercial impression is something other than primarily geographic -- for example, due to double meanings or shades of suggestive meanings.
- (3) If “AMERICA” or “AMERICAN” is used in virtually any manner with goods or services that are not from the United States, then the examining attorney should treat the term as primarily geographically deceptively misdescriptive under §2(e)(3) or even deceptive under §2(a), if appropriate. *See, e.g., Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273, 138 USPQ 63 (C.C.P.A. 1963) (AMERICAN BEAUTY held primarily geographically deceptively misdescriptive when used on Japanese-made sewing machines); *In re Biessecci S.p.A.*, 12 USPQ2d 1149 (TTAB 1989) (AMERICAN SYSTEM and design (“AMERICAN” disclaimed) held deceptive for clothing manufactured in Italy). *Cf. In re Salem China Co.*, 157 USPQ 600 (TTAB 1968) (AMERICAN LIMOGES held deceptive under §2(a) when used on china not made in Limoges, France). In this situation, even marks that arguably convey a non-geographic commercial impression must be viewed with great skepticism. The cases indicate that if there is any likelihood that the inclusion of “AMERICA” or “AMERICAN” in a mark may mislead the public as to the national origin of the goods or services, the mark should be treated as at least geographically deceptively misdescriptive.

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- (4) If “AMERICA” or “AMERICAN” appears in a phrase or slogan, the examining attorney must evaluate the entire mark to determine whether it is merely descriptive as laudatory, or even incapable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA’S FRESHEST ICE CREAM held incapable); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (AMERICA’S FAVORITE POPCORN held merely descriptive); *Kotzin v. Levi Strauss & Co.*, 111 USPQ 161 (Comm’r Pats. 1956) (AMERICA’S FINEST JEANS and AMERICA’S FINEST for overalls held not confusingly similar and incapable by inference). Typically these marks primarily extol the quality or popularity of the goods or services and secondarily denote geographic origin. See TMEP §1209.03(n) regarding use of terms such as “AMERICA” and “AMERICAN” in a way that is merely descriptive or generic.

1210.02(d) Non-Geographic Characteristics of Goods or Services Conveyed by Geographic Terms

Geographic matter may serve to designate a kind or type of goods or services, or to indicate a style or design that is a feature of the goods or services, rather than to indicate their geographic origin. For example, the geographic components in terms such as “dotted swiss,” “Boston baked beans,” “Swiss cheese,” “Early American design” and “Italian spaghetti” are not understood as indicating geographic origin of the goods but, rather, a particular type or style of product regardless of where it is produced. See *Forschner Group Inc. v. Arrow Trading Co. Inc.*, 30 F.3d 348, 31 USPQ2d 1614 (2d Cir. 1994) (SWISS ARMY KNIFE); *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951), *aff’d*, 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) (primary significance of HYDE PARK for men’s suits is to suggest that the product is stylish or of high quality rather than to provide information about geographic origin).

When geographic terms are used in circumstances in which it is clear that they are meant to convey some meaning other than geographic origin, registration should not be refused on the basis of geographical descriptiveness or misdescriptiveness. However, there may be some other basis for refusal; for example, the terms may be merely descriptive or deceptively misdescriptive of the goods or services under §2(e)(1) of the Act, 15 U.S.C. §1052(e)(1). *In re Busch Entertainment Corp.*, 60 USPQ2d 1130 (TTAB 2000) (EGYPT merely descriptive of subject matter or motif of amusement park services).

If it is unclear whether the primary significance of the term is geographic or merely descriptive or deceptively misdescriptive, the examining attorney may refuse registration on both grounds in the alternative.

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1210.03 Geographic Origin of the Goods or Services

The question of whether a term is primarily geographically descriptive under §2(e)(2) or primarily geographically deceptively misdescriptive under §2(e)(3) depends on whether or not the mark identifies the place from which the goods or services originate. Goods or services may be said to “originate” from a geographic location if, for example, they are manufactured, produced or sold there. *See Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996) (RODEO DRIVE held primarily geographically deceptively misdescriptive of perfume, where opposer’s evidence showed that a significant number of Rodeo Drive retailers sell “prestige” fragrances, and that the public would be likely to make the requisite goods/place association between perfume and Rodeo Drive). *Cf. In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725 (Fed. Cir. 1990) (RODEO DRIVE held not primarily geographically deceptively misdescriptive of perfume because of the lack of persuasive evidence of a goods/place association in the *ex parte* record).

Goods and services do not always originate from the applicant’s place of business. *See In re Nantucket Allserve Inc.*, 28 USPQ2d 1144 (TTAB 1993) (NANTUCKET NECTARS held primarily geographically descriptive of soft drinks, even though the goods were manufactured elsewhere, where the record showed that applicant’s headquarters and research and development division were on Nantucket, the distributor of the goods was located on Nantucket, the specimens indicated that the goods were “born” or “created” on Nantucket, and the goods were sold in the applicant’s store on Nantucket); *In re Chalk’s International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air, because the applicant’s services included flights to and from Paradise Island, Bahamas, even though the flights were not based there); *In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982) (NIPPON held not deceptive of, *inter alia*, radios and televisions because, although the applicant is an American corporation, the goods are made in Japan). *Cf. In re Gale Hayman Inc.*, 15 USPQ2d 1478 (TTAB 1990) (SUNSET BOULEVARD held not primarily geographically descriptive of perfume and cologne, the Board holding that the mere fact that applicant’s principal offices are in Century City, close to Sunset Boulevard, does not mandate a finding that a goods/place association should be presumed, determining that the public would not make a goods/place association, and noting that there was no evidence that any perfume or cologne is manufactured or produced on Sunset Boulevard or that applicant’s goods are sold there).

When the goods or services may be said to originate both in the geographic place named in the mark and outside that place, registration will normally be refused on the ground that the mark is primarily geographically descriptive under §2(e)(2) of the Trademark Act. *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 n.2 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN for restaurant services held primarily geographically descriptive, where the services were rendered both in California and elsewhere).

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1210.04 Goods/Place or Services/Place Association

Refusal of registration under §2(e)(2) (primarily geographically descriptive), §2(e)(3) (primarily geographically deceptively misdescriptive), or §2(a) (deceptive) requires that there be a goods/place or services/place association such that the public is likely to believe that the goods or services originate in the place identified in the mark.

1210.04(a) Place Does Not Have to be Well Known for the Goods or Services

It is not necessary to show that the place identified in the mark is well known or noted for the goods or services to establish a goods/place or services/place association in support of a refusal under §2(e)(2) or §2(e)(3). *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511 (TTAB 2001) (TOSCANA primarily geographically deceptively misdescriptive of furniture not originating in Tuscany, Italy); *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN held primarily geographically descriptive of restaurant services). The examining attorney “must show only a reasonable basis for concluding that the public is likely to believe the mark identifies the place from which the goods [or services] originate....” *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985) (evidence from a gazeteer and dictionary showing that tobacco is a crop produced and marketed in Durango, Mexico held sufficient to establish a *prima facie* goods/place association). See TMEP §1210.04(c) and cases cited therein.

If the place identified in the mark is well known or noted for the goods or services specified and the applicant’s goods or services do not originate from that place, the mark is likely to be deceptive under §2(a). *Id.*, 769 F.2d at 768 n.6, 226 USPQ at 868 n.6. See TMEP §§1210.05(a) *et seq.* regarding deceptive geographical marks.

1210.04(b) Geographically Descriptive Marks - Association Presumed Unless Applicant Raises Genuine Issue as to Whether Primary Significance of Term is Geographic or Place is Obscure or Remote

When the geographic significance of a term is its primary significance and the geographic place is neither obscure nor remote, the goods/place or services/place association may ordinarily be presumed from the fact that the applicant’s goods or services originate in the place named in the mark. *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998) (U.S. CARGO primarily geographically descriptive of towable trailers carrying cargo and vehicles); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (CAROLINA APPAREL primarily geographically descriptive of retail clothing store services); *In re Chalk’s International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation

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of passengers and goods by air); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN held primarily geographically descriptive of restaurant services where applicant's services originate in California).

However, if the applicant provides information that creates a genuine issue as to whether the primary significance of the term is geographic or whether the place is obscure or remote, the examining attorney must submit evidence to establish the goods/place association. The Trademark Trial and Appeal Board has stated:

We believe that, where the refusal to register is based on the Trademark Examining Attorney's finding that a mark is primarily geographically descriptive of the goods (that is, the goods actually come from the geographical place designated in the mark), the Trademark Examining Attorney would need to submit evidence to establish a public association of the goods with that place if, for example, a genuine issue is raised that (1) the place named in the mark may be so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods to which the mark is applied or (2) an admittedly well-recognized geographical term may have other meanings, such that the term's geographical significance may not be the primary significance to prospective purchasers. Where, on the other hand, there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure nor remote, a public association of the goods with the place may ordinarily be presumed from the fact that the applicant's own goods come from the geographical place named in the mark.

In re Handler Fenton Westerns, Inc., 214 USPQ 848, 849-50 (TTAB 1982) (DENVER WESTERNS held primarily geographically descriptive of western-style shirts originating in Denver).

Thus, if a mark identifies the geographic origin of the goods or services, the examining attorney must determine: (1) whether there is a genuine issue as to whether the place identified in the mark is obscure or remote (*see* TMEP §1210.04(d)); and (2) whether the primary meaning of the mark is geographic (*see* TMEP §1210.02(b)). If there is no issue as to these considerations, a goods/place association may ordinarily be presumed from the fact that the applicant's own goods come from the geographic place identified in the mark.

However, if there is a genuine issue as to whether the place identified in the mark is obscure or remote, or whether the mark has a primary meaning that is not geographic, the examining attorney must provide evidence to establish an association between the goods or services and the place named in the mark. *In re John Harvey & Sons Ltd.*, 32 USPQ2d 1451 (TTAB 1994) (HARVEYS BRISTOL CREAM not primarily geographically descriptive of cakes flavored with sherry wine); *In re Gale Hayman Inc.*, 15 USPQ2d 1478 (TTAB 1990) (SUNSET BOULEVARD held not primarily geographically descriptive of perfume and cologne, the Board holding that the mere fact that applicant's principal offices are in Century City, close to Sunset Boulevard,

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does not mandate a finding that a goods/place association should be presumed). *See* TMEP §1210.04(c).

1210.04(c) Establishing Goods/Place or Services/Place Association

As noted in TMEP §1210.04(b), the examining attorney must submit evidence to establish a goods/place or services/place association if: (1) the goods or services do not originate in the place named in the mark; or (2) the goods or services originate in the place named in the mark, but there is a genuine issue as to whether the place is obscure or remote, or whether the primary significance of the place is geographic.

There is no requirement that the place identified in the mark be well known or noted for the goods or services to find the existence of a goods/place or services/place association under §2(e)(2) or §2(e)(3). *See* TMEP §1210.04(a). The Court of Appeals for the Federal Circuit has held that to establish a goods/place or services/place association, the examining attorney must “show only a reasonable basis for concluding that the public is likely to believe the mark identifies the place from which the goods [or services] originate....” *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985) (evidence from a gazetteer and dictionary showing that tobacco is a crop produced and marketed in Durango, Mexico held sufficient to establish a *prima facie* goods/place association). *See In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and design held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy, where an atlas and a gazetteer showed that Venice was a large metropolitan area where fine art objects, glassware and decorative items had been made and sold for centuries, and a popular tourist destination); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY held primarily geographically deceptively misdescriptive where manufacturing listings and Nexis® excerpts showed that handbags and luggage are designed and manufactured in New York); *In re Boyd Gaming Corp.*, 57 USPQ2d 1944 (TTAB 2000) (HAVANA RESORT & CASINO and ROYAL HAVANA RESORT & CASINO held primarily geographically deceptively misdescriptive of wearing apparel, beauty products and perfume that do not come from Havana, Cuba, where the record showed that Havana produces a variety of goods, including clothing and cosmetic items); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB 1997) (HAVANA SELECT, HAVANA CLASICO, OLD HAVANA, HAVANA PRIMO, and HAVANA CLIPPER all held primarily geographically deceptively misdescriptive of rum that does not originate in Havana, Cuba, where the evidence showed that Havana is a major city and rum is a significant product); *In re Pan-O-Gold Baking Co.*, 20 USPQ2d 1761 (TTAB 1991) (NEW ENGLAND primarily geographically deceptively misdescriptive of bread and rolls that do not come from the New England area).

In *Save Venice*, the Court noted that in the modern marketing context, geographic regions that are noted for certain products or services are likely to expand from their traditional goods or services into related goods or services, and that this would be expected by consumers. Accordingly, the court held that “the registrability of a

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geographic mark may be measured against the public's association of that region with both its traditional goods and any related goods or services that the public is likely to believe originate there.” 259 F.3d at 1355, 59 USPQ2d at 1784.

However, a showing that the geographic place is known to the public and could be the source of the goods or services may not be enough in itself to establish a goods/place or services/place association in all cases. *See In re Municipal Capital Markets Corp.*, 51 USPQ2d 1369, 1371 (TTAB 1999) (COOPERSTOWN *not* primarily geographically deceptively misdescriptive of restaurant services; “the Examining Attorney must present evidence that does something more than merely establish that services as ubiquitous as restaurant services are offered in the pertinent geographic location”); *In re Venice Maid Co., Inc.*, 222 USPQ 618, 619 (TTAB 1984) (VENICE MAID held *not* primarily geographically deceptively misdescriptive of canned foods, including, *inter alia*, lasagna and spaghetti, where the evidence of a goods/place association was found insufficient; “we are unwilling to sustain the refusal to register in this case simply on the basis that Venice is a large Italian city that could, conceivably, be the source of a wide range of goods, including canned foods”).

The question of whether there is a goods/place or services/place association is determined on a case-by-case basis, based on the evidence in the record. *Compare Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996) (RODEO DRIVE held primarily geographically deceptively misdescriptive of perfume, where opposer's evidence showed that a significant number of Rodeo Drive retailers sell “prestige” fragrances, and that the public would be likely to make the requisite goods/place association between perfume and Rodeo Drive) *with In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725 (Fed. Cir. 1990) (RODEO DRIVE held *not* primarily geographically deceptively misdescriptive of perfume because of the lack of persuasive evidence of a goods/place association in the *ex parte* record). *See also Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990) (PARK AVENUE held neither deceptive nor geographically deceptively misdescriptive as applied to cigarettes and smoking tobacco, the Board finding no goods/place association between tobacco products and Park Avenue in New York City, on which opposer's world headquarters was located).

To establish a goods/place or services/place association, the examining attorney may provide such evidence as excerpts from telephone directories, gazetteers, encyclopedias, geographic dictionaries, or the LEXIS-NEXIS® database. The examining attorney should also examine the specimen(s) and any other evidence in the record that shows the context in which the applicant's mark is used.

1210.04(d) Obscure or Remote Geographic Marks

As noted in TMEP §1210.04(b), if there is a genuine question as to whether the place identified in the mark is obscure or remote, or whether the term has a primary meaning that is not geographic, the examining attorney must provide evidence to establish the goods/place or services/place association. *See, e.g., In re John Harvey & Sons Ltd.*, 32 USPQ2d 1451 (TTAB 1994) (HARVEYS BRISTOL CREAM *not*

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primarily geographically descriptive of cakes flavored with sherry wine); *In re Bavaria St. Pauli Brauerei AG*, 222 USPQ 926 (TTAB 1984) (reversing examining attorney's requirement for disclaimer of "JEVER" in application to register JEVER and design for beer originating in Jever, West Germany, where the sole evidence of a goods/place association was an entry from a 32-year-old geographic index); *In re Brauerei Aying Franz Inselkammer KG*, 217 USPQ 73 (TTAB 1983) (AYINGER BIER ("BIER" disclaimed) held not primarily geographically descriptive of beer emanating from Aying, West Germany, a hamlet of 500 inhabitants, where the examining attorney's evidence of a goods/place association was the specimen label identifying Aying as the place of origin).

Geographic matter may be so obscure or remote that it would not be recognized as an indication of the geographic source of the goods or services. In such a case, the mark is treated as an arbitrary designation (*see* TMEP §1210.04(e)) because its geographic meaning is likely to be lost on consumers and not perceived as its primary significance. *See ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987) (TAPATIO held not primarily geographically deceptively misdescriptive of meatless hot sauce, despite the fact that the mark is a Spanish term meaning "of or pertaining to Guadalajara, Mexico" and the goods did not originate from Guadalajara).

Remoteness or obscurity is determined from the perspective of the average American consumer. *See In re Societe Generale des Eaux Minerales de Vittel, S.A.*, 824 F.2d 957 3 USPQ2d 1450 (Fed. Cir. 1987) (VITTEL and design held not primarily geographically descriptive of cosmetic products because of lack of goods/place association between the goods and the applicant's place of business in Vittel, France). However, the examining attorney does not have to show that the nationwide general public would associate the mark with the place. The significance of the term is determined not in the abstract, but from the point of view of the consumers of the particular goods or services identified in the application. *In re MCO Properties Inc.*, 38 USPQ2d 1154 (TTAB 1995) (FOUNTAIN HILLS held primarily geographically descriptive of real estate development services rendered in Fountain Hills, Arizona, where the record showed that Fountain Hills was the name of the town where the applicant was located and rendered its services, and that the purchasers who came in contact with the mark would associate that place with the services).

1210.04(e) Arbitrary Use of Geographic Terms

The name of a geographic location that has no significant relation to commercial activities or the production of the relevant goods or services, such as ALASKA for bananas, is treated as an arbitrary mark because it is unlikely that consumers would believe that the mark identifies the place from which the goods originate. *See In re Nantucket, Inc.*, 677 F.2d 95, 105, 213 USPQ 889, 897 (C.C.P.A. 1982) (Nies, J., concurring) (construing use of "the names of places devoid of commercial activity" as "arbitrary usage").

See TMEP 1210.07(e) regarding arbitrary, fanciful or suggestive composite marks.

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1210.05 Geographically Deceptive Marks

1210.05(a) Deceptive Geographical Marks - in General

See TMEP §1210.01(c) regarding the test for determining whether a geographic term is deceptive under 15 U.S.C. §1052(a).

The distinction between marks that are primarily geographically deceptively misdescriptive under 15 U.S.C. §1052(e)(3) and those that are deceptive under §2(a) is whether the fact that the mark identifies a place from which the goods or services do not originate is likely to be material to consumers' decision to purchase the goods or use the services. If so, the mark is deceptive within the meaning of §2(a); if not, the mark is primarily geographically deceptively misdescriptive within the meaning of §2(e)(3). See *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984), in which the Trademark Trial and Appeal Board provided the following guidance in assessing whether the deception is material:

In embracing a “materiality” test to distinguish marks that fall within the proscription of Section [2(e)(3)] from those that fall also within the proscription of Section 2(a), we are really saying no more than that we must look to the evidence that has been presented about the probable reaction of purchasers to a particular geographical term when it is applied to particular goods. If the evidence shows that the geographical area named in the mark is an area sufficiently renowned to lead purchasers to make a goods-place association but the record does not show that goods like applicant's or goods related to applicant's are a principal product of that geographical area, then the deception will most likely be found not to be material and the mark, therefore, not deceptive. On the other hand, if there is evidence that goods like applicant's or goods related to applicant's are a principal product of the geographical area named by the mark, then the deception will most likely be found material and the mark, therefore, deceptive.

221 USPQ at 57 (BAHIA held deceptive of cigars that do not originate in the Bahia province of Brazil, where the evidence of record was “unequivocal” that tobacco and cigars are important products in the Bahia region).

If a mark comprises geographic matter that is deceptive within the meaning of §2(a) combined with additional matter, the mark as a whole is unregistrable. See *In re Perry Mfg. Co.*, 12 USPQ2d 1751 (TTAB 1989) (PERRY NEW YORK and design (“NEW YORK” disclaimed) held deceptive for various items of clothing that originate in North Carolina, and have no connection with New York, because of the renown of New York in the apparel industry); *In re Biessecci S.p.A.*, 12 USPQ2d 1149 (TTAB 1989) (AMERICAN SYSTEM and design (“AMERICAN” disclaimed), for clothing manufactured in Italy, held deceptive).

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If a composite mark comprises geographic matter that is deceptive, the mark is subject to strict scrutiny and may be held to be deceptive even if the mark as a whole is not perceived as identifying a geographic origin. *See In re Danish Maid Cultured Products, Inc.*, 156 USPQ 430 (TTAB 1967) (DANISH MAID CULTURED PRODUCTS and design depicting the world famous mermaid statue in Copenhagen, Denmark held deceptive for consulting and advisory services relating to dairy products that do not originate in Denmark); *In re Richemond*, 131 USPQ 441 (TTAB 1961) (MAID IN PARIS held deceptive for perfume manufactured in the United States); *National Lead Co. v. Michigan Bulb Co.*, 120 USPQ 115 (Comm'r Pats. 1959) (DUTCH BOY held deceptive for flower bulbs that do not originate in Holland).

A disclaimer of the deceptive matter will not overcome a §2(a) refusal. *See* TMEP §1210.08. A mark that is deceptive under §2(a) may not be registered on either the Principal Register or the Supplemental Register. *See* TMEP §§1210.06(a) and 1210.06(b).

See also TMEP §§1203.02 *et seq.* regarding deceptive marks, and TMEP §1210.05(b) regarding geographical designations used on or in connection with wines or spirits that identify a place other than the origin of the goods.

1210.05(b) Wines and Spirits

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), prohibits the registration of a designation that consists of or comprises “a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after [January 1, 1996].” This provision was added by the Uruguay Round Agreements Act, implementing the Trade Related Intellectual Property (TRIPs) portions of the General Agreement on Tariffs and Trade (GATT). It applies only to geographic indications that were first used in commerce on or after January 1, 1996, one year after the effective date of the legislation implementing GATT.

The examining attorney must refuse registration under §2(a) of any geographical designation that was first used in commerce on or in connection with wines or spirits on or after January 1, 1996, if it identifies a place other than the origin of the goods. Section 2(a) is an absolute bar to the registration of these geographical designations on either the Principal Register or the Supplemental Register. Neither a disclaimer of the geographical designation nor a claim that it has acquired distinctiveness under §2(f) can obviate a §2(a) refusal if the mark consists of or comprises a geographical indication that identifies a place other than the origin of the wines or spirits.

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1210.06 Supplemental Register and Section 2(f)

1210.06(a) Registrability of Geographic Terms on the Supplemental Register

Primarily Geographically Descriptive Marks. A term that is primarily geographically descriptive of the goods or services under §2(e)(2), 15 U.S.C. §1052(e)(2), may be registered on the Supplemental Register, if it is not barred by other section(s) of the Act.

Primarily Geographically Deceptively Misdescriptive Marks. A mark that is found to be primarily geographically deceptively misdescriptive under §2(e)(3), 15 U.S.C. §2(e)(3), may not be registered on the Supplemental Register unless the mark has been in lawful use in commerce since before December 8, 1993, the date of enactment of the North American Free Trade Agreement Implementation Act, Public Law 103-182, 107 Stat. 2057. 15 U.S.C. §1091(a).

Geographically Deceptive Marks. A mark that is deceptive under §2(a), 15 U.S.C. §1052(a), may not be registered on the Supplemental Register. *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992).

1210.06(b) Registrability of Geographic Terms Under Section 2(f)

Primarily Geographically Descriptive Marks. A term that is primarily geographically descriptive of the goods or services under §2(e)(2), 15 U.S.C. §1052(e)(2), may be registered on the Principal Register if it is shown to have acquired distinctiveness under §2(f), 15 U.S.C. §1052(f). *See* TMEP §§1212 *et seq.* regarding §2(f).

Primarily Geographically Deceptively Misdescriptive Marks. A mark that is primarily geographically deceptively misdescriptive under §2(e)(3), 15 U.S.C. §1052(e)(3), may not be registered under §2(f) unless the mark became distinctive of the goods or services in commerce before December 8, 1993, the date of enactment of the North American Free Trade Agreement Implementation Act. *See In re Boyd Gaming Corp.*, 57 USPQ2d 1944 (TTAB 2000); *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996).

Geographically Deceptive Marks. A mark that is deceptive under 15 U.S.C. §1052(a) may not be registered on the Principal Register even under §2(f).

Section 2(f) in Part. An applicant may claim that a geographic component of a mark has acquired distinctiveness under §2(f). *See* TMEP §1212.02(f) regarding claims of acquired distinctiveness as to a portion of a mark. Thus, if the examining attorney requires a disclaimer of matter that is primarily geographically descriptive under §2(e)(2), the applicant may seek to overcome the disclaimer requirement by submitting a showing that the geographic component has acquired distinctiveness under §2(f). If the applicant is able to establish to the satisfaction of the examining attorney that the geographic component has acquired distinctiveness, the examining attorney will approve the mark for publication with a notation that there is a claim of

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distinctiveness under §2(f) as to the geographic component. *See* TMEP §1210.08 for additional information about disclaimer of geographic terms.

1210.07 Geographic Terms Combined With Additional Matter

A geographic composite mark is one composed of geographic matter coupled with additional matter (*e.g.*, wording and/or a design element). When examining such a mark, the examining attorney must determine the primary significance of the composite. *See In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and SAVE VENICE INC. with an image of the winged Lion of St. Mark, for various goods, held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY (“NEW YORK” disclaimed) held primarily geographically deceptively misdescriptive of backpacks, handbags, purses and similar items); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB 1997) (HAVANA SELECT, HAVANA CLASICO, OLD HAVANA, HAVANA PRIMO, and HAVANA CLIPPER primarily geographically deceptively misdescriptive of rum). *See* TMEP §1210.02(b) regarding the “primary” significance of geographic terms.

Depending on the primary significance of the composite, the examining attorney will handle the geographic issue in a geographic composite mark in one of the following ways:

- (1) If the examining attorney finds that the mark, when viewed as a whole, is arbitrary, fanciful or suggestive, he or she will approve the mark for publication without evidence that the mark has acquired distinctiveness under §2(f);
- (2) If the examining attorney finds that the mark is primarily geographically descriptive under §2(e)(2) without a showing of acquired distinctiveness, primarily geographically deceptively misdescriptive under §2(e)(3), or deceptive under §2(a), he or she will refuse registration of the mark as a whole; or
- (3) If the examining attorney finds that the geographic matter is a separable part of the mark, the examining attorney’s action will depend on whether the matter is primarily geographically descriptive, primarily geographically deceptively misdescriptive, or deceptive. *See* TMEP §1210.08 regarding disclaimer of geographic terms, and TMEP §1210.06(b) regarding claims of acquired distinctiveness as to a geographic component of a mark.

See TMEP §§1210.07(a) through 1210.07(e) for guidelines regarding the examination of an application to register a mark comprising a geographic term combined with additional matter.

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1210.07(a) Geographic Terms Combined With Descriptive Matter

Generally, the addition of a highly descriptive or generic term to the name of a geographic place does not alter its primarily geographic significance. *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (CAROLINA APPAREL primarily geographically descriptive of retail clothing store services); *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air); *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (THE WINE SOCIETY OF AMERICA held primarily geographically descriptive of wine club membership services); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN (“PIZZA KITCHEN” disclaimed) held primarily geographically descriptive of restaurant services); *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986) (CAMBRIDGE DIGITAL and design (“DIGITAL” disclaimed) held primarily geographically descriptive of computer systems and parts thereof).

1210.07(b) Marks That Include Primarily Geographically Descriptive Terms Combined With Additional Matter

If a composite mark comprises a geographic term that is primarily geographically descriptive of the goods or services under §2(e)(2), and the mark as a whole would be likely to be perceived as indicating the geographic origin of the goods or services, then the examining attorney must consider: (1) whether the geographic term is a separable element in the mark, and (2) the nature of the additional matter that makes up the composite mark.

If the geographic term is a separable element and the additional matter making up the mark is inherently distinctive as applied to the goods or services (*i.e.*, coined, arbitrary, fanciful or suggestive), the applicant may either: (1) register the mark on the Principal Register with a disclaimer of the geographic term, or (2) establish that the geographic term has acquired distinctiveness under §2(f). *See* TMEP §1210.08 regarding disclaimer of geographic terms, and TMEP §§1210.06(b) and 1212.02(f) regarding §2(f) claims as to a portion of the mark.

However, if the geographic term is not a separable element or if none of the additional matter that makes up the composite mark is inherently distinctive (*e.g.*, it is merely descriptive or incapable), then the examining attorney should refuse registration of the entire mark on the Principal Register pursuant to §2(e)(2).

1210.07(c) Marks That Include Primarily Geographically Deceptively Misdescriptive Terms Combined With Additional Matter

If a composite mark comprises matter that is primarily geographically deceptively misdescriptive within the meaning of §2(e)(3), and the mark as a whole would be

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likely to be perceived as indicating the geographic origin of the goods or services, then the examining attorney should refuse registration of the mark as a whole under §2(e)(3), unless the applicant has established that the primarily geographically deceptively misdescriptive matter acquired distinctiveness under §2(f) before December 8, 1993. A disclaimer of the geographic matter will not overcome the §2(e)(3) refusal. *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999). See TMEP §1210.08 regarding disclaimer of geographic terms, and TMEP §1210.06(b) regarding §2(f).

1210.07(d) Marks That Include Geographically Deceptive Terms Combined With Additional Matter

If a composite mark comprises geographic matter that is deceptive within the meaning of §2(a), and the mark when viewed as a whole would be likely to be perceived as indicating geographic origin, the examining attorney should refuse registration of the mark as a whole under §2(a). See TMEP §1210.05(a) and cases cited therein for further information about geographically deceptive marks.

Composite marks that are geographically deceptive cannot be registered on either the Principal or the Supplemental Register, even with a disclaimer of the geographic component. See TMEP §§1210.06(a), 1210.06(b) and 1210.08.

1210.07(e) Arbitrary, Fanciful or Suggestive Composite Marks

If, when viewed as a whole, a composite mark would not be likely to be perceived as identifying the geographic origin of the goods or services (*i.e.*, the mark as a whole is not primarily geographically descriptive, primarily geographically deceptively misdescriptive, or deceptive), then the mark is regarded as arbitrary, fanciful or suggestive. See *National Lead Co. v. Wolfe*, 223 F.2d 195, 105 USPQ 462 (9th Cir. 1955), *cert. denied*, 350 U.S. 883, 107 USPQ 362 (1955) (DUTCH BOY for paint); *In re Sharky's Drygoods Co.*, 23 USPQ2d 1061 (TTAB 1992) (PARIS BEACH CLUB, applied to T-shirts and sweatshirts, not deceptive under §2(a)); *In re Yardley of London, Inc.*, 165 USPQ 272 (TTAB 1970) (LONDON LASHES for brush-on lash lengthener); *In re International Minerals & Chemical Corp.*, 147 USPQ 262 (TTAB 1965) (KENTUCKY TURF for fertilizer).

1210.08 Disclaimer of Geographic Terms in Composite Marks

Primarily Geographically Descriptive Marks

When appropriate, the applicant will be required to disclaim a separable component of a mark that is primarily geographically descriptive under §2(e)(2). A disclaimer is appropriate in this situation if the geographic component is a separable feature of the mark, and the composite mark includes an inherently distinctive, non-disclaimed component (*e.g.*, coined, arbitrary, fanciful or suggestive wording or design).

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The composite mark must include a nondisclaimed component because a mark cannot be registered if all the components have been disclaimed. *See* TMEP §1213.06. *See, e.g., In re Wine Society of America Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989).

A unitary mark should not be broken up or divided for purposes of disclaiming the parts. A unitary mark is one in which the registrable and unregistrable elements are so integrated or merged together that they cannot be regarded as separable units, for example, a mark formed by combining or hyphenating two terms, one of which would be unregistrable by itself; or where a registrable term and an unregistrable term are joined together to form a mark that has a distinctive nondescriptive meaning of its own; or where the words that have been put together function as a unit, with each relating to the other rather than directly to the goods. *See In re Interstate Bakeries Corp.*, 156 USPQ 702 (TTAB 1968) (requirement for disclaimer of “DANISH” reversed in application to register DANISH VILLAGE for bread). *See* TMEP §§1213.05 *et seq.* regarding unitary marks.

When the examining attorney requires a disclaimer of primarily geographically descriptive matter, the applicant may seek to overcome the disclaimer requirement by submitting a showing that the geographic term has become distinctive under §2(f). *See* TMEP §§1210.06(b) and 1212.02(f).

Primarily Geographically Deceptively Misdescriptive and Deceptive Marks

A mark that includes matter that is primarily geographically deceptively misdescriptive under §2(e)(3) or deceptive under §2(a) is not registrable even with a disclaimer. *See* TMEP §§1210.01(b) and 1210.05(a). *In re Save Venice New York Inc.*, 54 USPQ2d 1106, 1110 (TTAB 2000), *aff'd*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and design held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1541-42 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY (“NEW YORK” disclaimed) held primarily geographically deceptively misdescriptive of backpacks, handbags, purses and similar items); *In re Perry Mfg. Co.*, 12 USPQ2d 1751, 1751-52 (TTAB 1989) (PERRY NEW YORK and design (“NEW YORK” disclaimed) held deceptive for clothing that originates in North Carolina and has no connection with New York, because of the renown of New York in the apparel industry).

Matter that is deceptive or primarily geographically deceptively misdescriptive may be omitted or deleted from the drawing of a mark in appropriate cases. *See* TMEP §807.15.

See TMEP §§1213 *et seq.* for more information about disclaimers.

1210.09 Geographic Certification Marks

Under certain circumstances the name of the place from which goods or services originate may function as a certification mark. When geographic terms are used to certify regional origin, registration of certification marks should not be refused and, in

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applications to register composite certification marks, disclaimers of these geographic terms should *not* be required on the ground of geographical descriptiveness. *See* TMEP §§1306.02 *et seq.* concerning procedures for registration of certification marks that certify regional origin.

When a geographical term used in a composite certification mark is not used to certify regional origin, appropriate refusals and requirements should be made.

1211 Refusal on Basis of Surname

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (e) Consists of a mark which ... (4) is primarily merely a surname.

Under §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), a mark that is primarily merely a surname is not registrable on the Principal Register absent a showing of acquired distinctiveness under §2(f), 15 U.S.C. §1052(f). *See* TMEP §§1212 *et seq.* regarding acquired distinctiveness. Formerly §2(e)(3) of the Act, this section was designated §2(e)(4) when the North American Free Trade Agreement Implementation Act, Public Law 103-182, took effect on January 1, 1994. A mark that is primarily merely a surname may be registrable on the Supplemental Register.

The Trademark Act, in §2(e)(4), reflects the common law that exclusive rights in a surname *per se* cannot be established without evidence of long and exclusive use that changes its significance to the public from that of a surname to that of a mark for particular goods or services. The common law also recognizes that surnames are shared by more than one individual, each of whom may have an interest in using his surname in business; and, by the requirement for evidence of distinctiveness, the law, in effect, delays appropriation of exclusive rights in the name. *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985).

The question of whether a mark is primarily merely a surname depends on the mark's *primary* significance to the purchasing public. *See, e.g., Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats. 1955). Each case must be decided on its own facts, based upon the evidence in the record.

1211.01 “Primarily Merely a Surname”

The legislative history of the Trademark Act of 1946 indicates that the word “primarily” was added to the existing statutory language “merely” with the intent to exclude registration of names such as “Johnson” or “Jones,” but not registration of names such as “Cotton” or “King” which, while surnames, have a primary significance other than as a surname. *See Sears, Roebuck & Co. v. Watson*, 204 F.2d 32, 33-34, 96 USPQ 360, 362 (D.C. Cir. 1953), *cert. denied*, 346 U.S. 829, 99 USPQ 491 (1953); *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats. 1955).

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The question of whether a term is primarily merely a surname depends on the primary, not the secondary, significance to the purchasing public. The Trademark Trial and Appeal Board has identified five factors to be considered in making this determination:

- (1) whether the surname is rare;
- (2) whether the term is the surname of anyone connected with the applicant;
- (3) whether the term has any recognized meaning other than as a surname;
- (4) whether it has the “look and feel” of a surname; and
- (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression.

In re Benthin Management GmbH, 37 USPQ2d 1332, 1333-1334 (TTAB 1995).

1211.01(a) Non-Surname Significance

Often a word will have a meaning or significance in addition to its significance as a surname. The examining attorney must determine the primary meaning of the term to the public. See TMEP §§1211.01(a)(i) through 1211.01(a)(vi) regarding considerations that often arise in determining whether a term is primarily merely a surname.

1211.01(a)(i) Ordinary Language Meaning

If there is a readily recognized meaning of a term, apart from its surname significance, such that the primary significance of the term is not that of a surname, registration should be granted on the Principal Register without evidence of acquired distinctiveness. See *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) (the relatively rare surname HACKLER held not primarily merely a surname, in light of dictionary meaning); *Fisher Radio Corp. v. Bird Electronic Corp.*, 162 USPQ 265 (TTAB 1969) (BIRD held not primarily merely a surname despite surname significance); *In re Hunt Electronics Co.*, 155 USPQ 606 (TTAB 1967) (HUNT held not primarily merely a surname despite surname significance). However, this does not mean that an applicant only has to uncover a non-surname meaning of the proposed mark to obviate a refusal under §2(e)(4). See *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367, 1368 (TTAB 1987) (N. PIQUET (stylized) held primarily merely a surname despite significance of the term “piquet” as “the name of a relatively obscure card game”).

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1211.01(a)(ii) Phonetic Equivalent of Term With Ordinary Language Meaning

A term may be primarily merely a surname even if it is the phonetic equivalent of a word that has an ordinary meaning (e.g., Byrne/burn; Knott/not or knot; Chappell/chapel). See *In re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986) (PICKETT SUITE HOTEL held primarily merely a surname despite applicant's argument that PICKETT is the phonetic equivalent of the word "picket"). Cf. *In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989) (CALISTO held not primarily merely a surname, the Board characterizing the telephone directory evidence of surname significance as "minimal" and in noting the mythological significance of the name "Callisto," stating that it is common knowledge that there are variations in the rendering of mythological names transliterated from the Greek alphabet (distinguishing *In re Pickett Hotel Co.*, *supra*)). Similarly, the fact that a word which has surname significance is also a hybrid or derivative of another word having ordinary language meaning is insufficient to overcome the surname significance unless the perception of non-surname significance would displace the primary surname import of the word. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (DARTY held primarily merely a surname despite applicant's argument that the mark is a play on the word "dart"); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986) (PETRIN held primarily merely a surname despite applicant's argument that the mark represents an abbreviation of "petroleum" and "insulation").

1211.01(a)(iii) Geographical Significance

A term with surname significance may not be primarily merely a surname if that term also has a well-known geographical meaning. *In re Colt Industries Operating Corp.*, 195 USPQ 75 (TTAB 1977) (FAIRBANKS held not primarily merely a surname because the geographical significance of the mark was determined to be just as dominant as its surname significance). However, the fact that a term is shown to have some minor significance as a geographical term will not dissipate its primary significance as a surname. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1943 (TTAB 1993) (HAMILTON held primarily merely a surname).

1211.01(a)(iv) Historical Place or Person

A term with surname significance may not be primarily merely a surname if that term also identifies a historical place or person. See *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (DA VINCI found not primarily merely a surname because it primarily connotes Leonardo Da Vinci); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000) (primary significance of M. C. ESCHER is that of famous deceased Dutch artist). Cf. *In re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986) (PICKETT SUITE HOTEL held primarily merely a surname despite applicant's evidence that PICKETT was the name of a famous Civil War general); *In re Champion International Corp.*,

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229 USPQ 550 (TTAB 1985) (McKINLEY held primarily merely a surname despite being the name of a deceased president).

1211.01(a)(v) Rare Surnames

The rarity of a surname is a factor to be considered in determining whether a term is primarily merely a surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995) (the fact that BENTHIN was a rare surname found to be a factor weighing against a finding that the term would be perceived as primarily merely a surname); *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994) (SAVA not primarily merely a surname, where there was evidence that the term had other meaning, no evidence that the term was the surname of anyone connected with applicant, and the term's use as a surname was very rare); *In re Garan Inc.*, 3 USPQ2d 1537 (TTAB 1987) (GARAN held not primarily merely a surname). However, the fact that a surname is rare does not *per se* preclude a finding that a term is primarily merely a surname. Even a rare surname may be held primarily merely a surname if its primary significance to purchasers is that of a surname. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (DARTY held primarily merely a surname); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990) (REBO held primarily merely a surname); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986) (POSTEN held primarily merely a surname). Regardless of the rarity of the surname, the test is whether the primary significance of the term to the purchasing public is that of a surname.

1211.01(a)(vi) “Look And Feel” of a Surname

There are some names which by their very nature have only a surname significance even though they are rare surnames. *See In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989) (PIRELLI held primarily merely a surname, the Board stating that “certain rare surnames look like surnames and certain rare surnames do not and ... ‘PIRELLI’ falls into the former category....”); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986) (PETRIN held primarily merely a surname). Conversely, there is a category of surnames that are so rare that they do not even have the appearance of surnames. Where these are involved, even in the absence of non-surname significance, a reasonable application of the test of “primary significance to the purchasing public” could result in a finding that such a surname, when used as a mark, would be perceived as arbitrary or fanciful. *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) (HACKLER does not have the look and feel of a surname).

1211.01(b) Surname Combined with Additional Matter

Often a mark will be comprised of a word that, standing by itself, would be primarily merely a surname, coupled with additional matter (*e.g.*, letters, words, designs). The question remains whether the mark sought to be registered would be perceived by the public primarily merely as a surname. *In re Hutchinson Technology Inc.*, 852 F.2d

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552, 7 USPQ2d 1490 (Fed. Cir. 1988). *See* TMEP §§1211.01(b)(i) through 1211.01(b)(vii) for additional information about surnames combined with additional matter.

1211.01(b)(i) Double Surnames

A combination of two surnames is not primarily merely a surname, within the meaning of §2(e)(4), unless there is evidence of record showing that the combination would be perceived by the public primarily merely as a surname. *See In re Standard Elektrik Lorenz A.G.*, 371 F.2d 870, 152 USPQ 563 (C.C.P.A. 1967) (SCHAUB-LORENZ held not primarily merely a surname, the Court noting that there was no evidence submitted that the mark sought to be registered was primarily merely a surname; that the only evidence of surname significance related to the individual “SCHAUB” and “LORENZ” portions of the mark; and that the mark must be considered in its entirety rather than dissected).

1211.01(b)(ii) Stylization or Design Element

A mark comprised of a word that, standing by itself, would be considered primarily merely a surname, but which is coupled with a distinctive stylization or design element, is not considered primarily merely a surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995) (stylized display of term BENTHIN found to be a factor weighing against a finding that the term would be perceived as primarily merely a surname). However, the addition of a nondistinctive design element or stylization to a term that, standing by itself, is primarily merely a surname does not remove the term from that category. The primary significance of the mark, in its entirety, would be merely that of a surname. *See In re Pickett Hotel Co.*, 229 USPQ 760, 763 (TTAB 1986) (PICKETT SUITE HOTEL held primarily merely a surname despite the stylization of the lettering, which was considered “insignificant, in that it is clearly not so distinctive as to create any separate commercial impression in the minds of purchasers of appellant’s services”).

The display of a term in lower-case lettering does not detract from its surname significance. *In re Directional Marketing Corp.*, 204 USPQ 675 (TTAB 1979).

1211.01(b)(iii) Surname Combined with Initials

The addition of initials to a term that, standing by itself, is primarily merely a surname does not remove the term from that category. In fact, the use of the first name initial followed by a surname has been held to reinforce, rather than diminish, the surname significance of a term. *See In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (C.C.P.A. 1953) (S. SEIDENBERG & CO’S. held primarily merely a surname); *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367 (TTAB 1987) (N. PIQUET held primarily merely a surname); *In re Taverniti, SARL*, 225 USPQ 1263 (TTAB 1985), *recon. denied* 228 USPQ 975 (TTAB 1985) (J. TAVERNITI held

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primarily merely a surname); *Ex parte Sears, Roebuck & Co.*, 87 USPQ 400 (PO Ex. Ch. 1950) (J.C. HIGGINS held primarily merely a surname).

1211.01(b)(iv) Surname Combined with Title

A title, such as “Mr.,” “Mrs.” or “Mlle.,” does not diminish the surname significance of a term; rather, it may enhance the surname significance of a term. *In re Revillon*, 154 USPQ 494 (TTAB 1967) (MLLE. REVILLON held primarily merely a surname). *Cf. In re Hilton Hotels Corp.*, 166 USPQ 216 (TTAB 1970) (LADY HILTON held not primarily merely a surname because it suggests a person or lady of nobility).

1211.01(b)(v) Surname in Plural or Possessive Form

The surname significance of a term is not diminished by the fact that the term is presented in its plural or possessive form. *See In re Woolley’s Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (WOOLLEY’S PETITE SUITES for hotel and motel services held primarily merely a surname); *In re McDonald’s Corp.*, 230 USPQ 304, 306 (TTAB 1986) (MCDONALD’S held primarily merely a surname based on a showing of surname significance of “McDonald,” the Board noting that “it is clear that people use their surnames in possessive and plural forms to identify their businesses or trades”); *In re Luis Caballero, S.A.*, 223 USPQ 355 (TTAB 1984) (BURDONS held primarily merely a surname based in part on telephone listings showing surname significance of “Burdon”); *In re Directional Marketing Corp.*, 204 USPQ 675 (TTAB 1979) (DRUMMONDS held primarily merely a surname based on a showing of surname significance of “Drummond”).

1211.01(b)(vi) Surname Combined with Wording

The treatment of marks that include wording in addition to a term that, standing by itself, is primarily merely a surname, depends on the significance of the non-surname wording.

If the wording combined with the surname is incapable of functioning as a mark (*i.e.*, a generic name for the goods or services), the examining attorney should refuse registration on the ground that the entire mark is primarily merely a surname under §2(e)(4). If the policy were otherwise, one could evade §2(e)(4) by the easy expedient of adding the generic name of the goods or services to a word that is primarily merely a surname. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS for pharmaceutical products held primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname where “‘brasserie’ is a generic term for applicant’s restaurant services”); *In re Woolley’s Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (WOOLLEY’S PETITE SUITES for hotel and motel services held primarily merely a surname); *In re Possis Medical, Inc.*, 230 USPQ 72, 73 (TTAB 1986) (POSSIS PERFUSION CUP held primarily merely a surname, the

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Board finding that “[a]pplicant’s argument that PERFUSION CUP is not a generic name for its goods ... is contradicted by the evidence the Examining Attorney has pointed to”); *In re E. Martinoni Co.*, 189 USPQ 589, 590-91 (TTAB 1975) (LIQUORE MARTINONI (stylized) for liqueur held primarily merely a surname, with “liquore” being the Italian word for “liqueur”).

If the wording combined with the surname is capable of functioning as a mark (*i.e.*, matter that is arbitrary, suggestive or merely descriptive of the goods or services), the mark is not considered to be primarily merely a surname under §2(e)(4). However, if the additional wording is merely descriptive or the equivalent, and a disclaimer is otherwise proper, the examining attorney should require a disclaimer of the additional wording. *See In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988) (HUTCHINSON TECHNOLOGY for computer components held not primarily merely a surname when the mark is considered as a whole, the Court remanding the case for entry of a disclaimer of “TECHNOLOGY” before publication).

1211.01(b)(vii) Surname Combined With Domain Name

A surname combined with a top-level domain name (*e.g.*, JOHNSON.COM) is primarily merely a surname under §2(e)(4). *See* TMEP §1215.03.

1211.02 Evidence Relating to Surname Refusal

1211.02(a) Evidentiary Burden - Generally

The burden is initially on the examining attorney to establish a *prima facie* case that a mark is primarily merely a surname. The burden then shifts to the applicant to rebut this showing. *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). The evidence submitted by the examining attorney was found insufficient to establish a *prima facie* case in the following decisions: *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (C.C.P.A. 1975); *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993); *In re Raivico*, 9 USPQ2d 2006 (TTAB 1988); *In re Garan Inc.*, 3 USPQ2d 1537 (TTAB 1987).

There is no rule as to the kind or amount of evidence necessary to make out a *prima facie* showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis. *See, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). The entire record is examined to determine the surname significance of a term. The following are examples of evidence that may be relevant: telephone directory listings; excerpted articles from computerized research databases; evidence in the record that the term is a surname; the manner of use on specimens; dictionary definitions of the term and evidence from dictionaries showing no definition of the term. The quantum of evidence that is persuasive in finding surname significance in one case may be insufficient in another because of the differences in the names

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themselves. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985).

See TMEP §§710 *et seq.* and 1211.02(b) *et seq.* for additional information about evidence.

1211.02(b) Evidentiary Considerations

In appropriate cases, the examining attorney may present evidence that may appear contrary to his or her position, with an appropriate explanation as to why, in view of other evidence presented, this evidence was not considered controlling. In some cases, this may foreclose objections from an applicant and present a more complete picture in the event of an appeal.

See TMEP §§1211.02(b)(i) through 1211.02(b)(vi) regarding types of evidence that may be relevant to a refusal of registration under §2(e)(4).

1211.02(b)(i) Telephone Directory Listings

Telephone directory listings from telephone books or electronic databases are one type of credible evidence of the surname significance of a term. The Trademark Trial and Appeal Board has declined to hold that a minimum number of listings in telephone directories must be found to establish a *prima facie* showing that the mark is primarily merely a surname. *See, e.g., In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986); *In re Wickuler-Kupper-Brauerei KGaA*, 221 USPQ 469 (TTAB 1983).

It is the American public's perception of a term that is determinative. Therefore, foreign telephone directory listings are not probative of the significance of a term to the purchasing public in the United States, regardless of whether the applicant is of foreign origin. *See, e.g., Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205 (TTAB 1988); *In re Stromsholmens Mekaniska Verkstad AB*, 228 USPQ 968 (TTAB 1986); *In re Wickuler-Kupper-Brauerei, supra*.

1211.02(b)(ii) LEXIS-NEXIS® Research Database Evidence

Excerpted articles from the LEXIS-NEXIS® research database are one type of credible evidence of the surname significance of a term. There is no requirement that the examining attorney make of record every story found in a LEXIS-NEXIS® search. However, the examining attorney is presumed to make the best case possible. *See In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987). *See also In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989) (“We must conclude that, because the Examining Attorney is presumed to have made the best case possible, the 46 stories not made of record [the search yielded 48 stories] do not support the position that CALISTO is a surname and, indeed, show that CALISTO has non surname meanings.”) An Office action that includes any evidence obtained from a research data base should include a citation to the research service

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and a clear record of the specific search that was conducted, indicating the libraries or files that were searched and the date of the search (*e.g.*, LEXIS®, NEXIS® library, CURRNT file as of April 28, 1992). The printout summarizing the search should be made a part of the record. Relevant information not included on the printout, such as the number of documents viewed, should be stated in narrative in the Office action. *See* TMEP §710.01(a).

Since it is the American public's perception of a term that is determinative, evidence from foreign publications is given little or no weight. *See In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993).

1211.02(b)(iii) Surname of Person Associated with Applicant

The fact that a term is the surname of an individual associated with the applicant (*e.g.*, an officer or founder) is evidence of the surname significance of the term. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989); *In re Taverniti, SARL*, 225 USPQ 1263 (TTAB 1985), *recon. denied*, 228 USPQ 975 (TTAB 1985).

1211.02(b)(iv) Specimens Confirming Surname Significance of Term

The fact that a term appears on the specimens of record in a manner that confirms its surname significance is evidence of the surname significance of a term. *See Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1208 (TTAB 1988) (DOURTHE found primarily merely a surname, the Board noting applicant's references to "Dourthe" as the name of a particular family and finding the surname significance of the term to be reinforced by the appearance on applicant's wine labels of the name and/or signature of an individual named Pierre Dourthe); *In re Taverniti, SARL*, 225 USPQ 1263, 1264 (TTAB 1985), *recon. denied*, 228 USPQ 975 (TTAB 1985) (J. TAVERNITI held primarily merely a surname, the Board considering, among other factors, the presentation of the mark on the specimens in signature form); *In re Luis Caballero, S.A.*, 223 USPQ 355, 356-57 (TTAB 1984) (BURDONS held primarily merely a surname, the Board weighting heavily the applicant's use of "Burdon" on the specimens as a surname, albeit of a fictitious character ("John William Burdon")).

1211.02(b)(v) Negative Dictionary Evidence

Negative dictionary evidence (*i.e.* evidence that a term is absent from dictionaries or atlases) may demonstrate the lack of non-surname significance of a term. *See In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

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1211.02(b)(vi) Evidence of Fame of a Mark

Evidence of the fame of a mark (*e.g.*, evidence of consumer recognition of a mark, or expenditures made in promoting or advertising a mark) is not relevant unless registration is sought under §2(f). *In re McDonald's Corp.*, 230 USPQ 304, 307 (TTAB 1986) (MCDONALD'S held primarily merely a surname in spite of strong secondary meaning, with the Board stating that. "the word 'primarily' refers to the primary significance of the term, that is, the ordinary meaning of the word, and not to the term's strength as a trademark due to widespread advertising and promotion of the term as a mark to identify goods and/or services.") *See also In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989); *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367 (TTAB 1987).

1212 Acquired Distinctiveness or Secondary Meaning

15 U.S.C. §1052(f). Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act.

If a proposed mark is not inherently distinctive, it may be registered on the Principal Register only upon proof of acquired distinctiveness, or "secondary meaning," that is, proof that it has become distinctive as applied to the applicant's goods or services in commerce. If the applicant establishes, to the satisfaction of the examining attorney, that the matter in question has acquired distinctiveness as a mark in relation to the named goods or services, then the mark is registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f).

Within the context of the Trademark Act, §2(f) may be described as follows:

[U]nlike the first five sections of 15 U.S.C. §1052 which define the grounds upon which a trademark registration is to be refused, Section 2(f) serves as an exception to a rejection under the provisions of one of the other sections, Section 2(e) (citation omitted). Section 2(f) permits registration of marks that, despite not qualifying for registration in light of Section 2(e), have nevertheless "become distinctive of the applicant's goods in commerce." Thus, "Section 2(f) is not a provision on which registration can be refused," ... but is a provision under which an

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applicant has a chance to prove that he is entitled to a federal trademark registration which would otherwise be refused.

Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 1580, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988), quoting *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983).

The purpose and significance of secondary meaning may be described as follows:

A term which is descriptive ... may, through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer. 1 Nims, *Unfair Competition and Trademarks* at §37 (1947). This is what is known as secondary meaning.

The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer (citations omitted). This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.

Ralston Purina Co. v. Thomas J. Lipton, Inc., 341 F. Supp. 129, 133, 173 USPQ 820, 823 (S.D.N.Y. 1972).

There are three basic types of evidence that may be used to establish acquired distinctiveness under §2(f):

- (1) A claim of ownership of one or more prior registrations on the Principal Register of the same mark for goods or services that are the same as or related to those named in the pending application (*see* 37 C.F.R. §2.41(b); TMEP §§1212.04 *et seq.*);
- (2) A statement verified by the applicant that the mark has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is made (*see* 37 C.F.R. §2.41(b); TMEP §§1212.05 *et seq.*);
- (3) Actual evidence of acquired distinctiveness (*see* 37 C.F.R. §2.41(a); TMEP §§1212.06 *et seq.*).

The applicant may submit one or any combination of these types of evidence, which are discussed below. Depending on the mark and the facts in the record, the examining attorney may determine that a claim of ownership of a prior registration(s) or a claim of five years' substantially exclusive and continuous use in commerce is

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insufficient to establish a *prima facie* case of acquired distinctiveness. The applicant may then submit actual evidence of acquired distinctiveness.

1212.01 General Evidentiary Matters

Whether acquired distinctiveness has been established is a question of fact. *See In re Loew's Theatres, Inc.*, 769 F.2d 764, 769, 226 USPQ 865, 869 (Fed. Cir. 1985), and cases cited therein. The record must contain facts or evidence of acquired distinctiveness.

The burden of proving that a mark has acquired distinctiveness is on the applicant. *See Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959).

The applicant may present any competent evidence to establish that a mark has acquired distinctiveness. Actual evidence of acquired distinctiveness may be submitted regardless of the length of time the mark has been used. *Ex parte Fox River Paper Corp.*, 99 USPQ 173 (Comm'r Pats. 1953).

The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985).

Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Seaman & Associates, Inc.*, 1 USPQ2d 1657 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984).

Facts based on events that occurred subsequent to the filing date of the application may be considered. Whether acquired distinctiveness has been established is determined in view of the facts that exist at the time registrability is being considered. *McCormick & Co., Inc. v. Summers*, 354 F.2d 668, 148 USPQ 272 (C.C.P.A. 1966); *General Foods Corp. v. MGD Partners*, 224 USPQ 479 (TTAB 1984); *Kaiser Aluminum & Chemical Corp. v. American Meter Co.*, 153 USPQ 419 (TTAB 1967); *In re Hoffman House Sauce Co.*, 137 USPQ 486 (TTAB 1963).

1212.02 General Procedural Matters

1212.02(a) Situations in which a Claim of Distinctiveness under §2(f) Is Appropriate

A claim of distinctiveness by the applicant under §2(f) is usually made either in response to a statutory refusal to register or in anticipation of such a refusal. A claim

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of distinctiveness is appropriately made in response to, or in anticipation of, only certain statutory refusals to register. For example, it is inappropriate to assert acquired distinctiveness to contravene a refusal under §2(a), (b), (c), (d) or (e)(5), 15 U.S.C. §§1052(a), (b), (c), (d) or (e)(5). Furthermore, acquired distinctiveness may not be asserted to contravene a refusal under §2(e)(3), 15 U.S.C. §1052(e)(3), unless the mark became distinctive of the applicant's goods in commerce before December 8, 1993, the date of enactment of the North American Free Trade Agreement Implementation Act (*see* TMEP §1210.06(b)).

In *In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 1403 n.3, 184 USPQ 345, 347 n.3 (C.C.P.A. 1975), the Court of Customs and Patent Appeals noted as follows:

[T]he judicially developed concept of “secondary meaning,” codified by section 2(f) (15 U.S.C. 1052(f)), relates to descriptive, geographically descriptive, or surname marks which earlier had a primary meaning which did not indicate a single source and were, therefore, unregistrable because of section 2(e) (citation omitted). Additionally, section 2(f) has been applied to permit registration of a mark consisting solely of a design and, therefore, not within the purview of section 2(e).

1212.02(b) Section 2(f) Claim Is, for Procedural Purposes, a Concession that Matter Is Not Inherently Distinctive

For procedural purposes, a claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive (and thus not registrable on the Principal Register absent proof of acquired distinctiveness). Once an applicant has claimed that matter has acquired distinctiveness under §2(f), the issue to be determined is not whether the matter is inherently distinctive but, rather, whether it has acquired distinctiveness. *See, e.g., Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 (TTAB 1986); *In re Chopper Industries*, 222 USPQ 258, 259 (TTAB 1984). However, claiming distinctiveness in the alternative is *not* an admission that the proposed mark is not inherently distinctive. TMEP §1212.02(c).

For the purposes of establishing that the subject matter is not inherently distinctive, the examining attorney should not rely on this concession alone, but should rely on other appropriate evidence.

See TMEP §1212.02(d) regarding unnecessary §2(f) claims.

1212.02(c) Claiming §2(f) Distinctiveness in the Alternative

An applicant may argue the merits of an examining attorney's refusal and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness under §2(f). Unlike the situation in which an applicant initially seeks registration

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under §2(f) or amends its application without objection, the alternative claim does not constitute a concession that the matter sought to be registered is not inherently distinctive. See *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986).

When an applicant claims acquired distinctiveness in the alternative, the examining attorney should treat separately the questions of (1) the underlying basis of refusal and; (2) assuming the matter is determined to be registrable, whether acquired distinctiveness has been established. In the event of an appeal, the Board will use the same analysis, provided the evidence supporting the §2(f) claim is in the record and the alternative grounds have been considered and finally decided by the examining attorney. *In re Harrington*, 219 USPQ 854, 855 n.1 (TTAB 1983).

In *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 (TTAB 1983), the Board outlined its procedure in situations where the applicant maintains the position that the underlying refusal is improper and alternatively seeks registration pursuant to §2(f) in the interest of advancing the prosecution of the application:

If we decide that the mark as applied to the services is arbitrary or suggestive of the services, as applicant claims, we must reverse the refusal of registration under Section 2(e)(1) and we need not consider any of the affidavits or other material made of record by applicant in support of its Section 2(f) claim of distinctiveness. If, on the other hand, we find the mark to be merely descriptive of the services and, in fact, so highly descriptive of them that no amount of evidence could persuade us that the mark has become distinctive, we must affirm the refusal of registration. Similarly, in this situation, we need not consider any of the affidavits or other material made of record by applicant in its Section 2(f) claim of distinctiveness. If we find that the mark is merely descriptive of the goods for purposes of Section 2(e)(1), but not so highly descriptive as to be incapable of functioning as a service mark to identify applicant's services and distinguish them from like services of others, we must determine whether the evidence in support of applicant's claim of distinctiveness is sufficient to warrant registration under the provisions of Section 2(f) of the Trademark Act.

Similarly, the applicant may seek registration on the Principal Register under §2(f) and, in the alternative, on the Supplemental Register. Depending on the facts of the case, this approach may have limited practical application. If the examining attorney finds that the matter sought to be registered is not a mark within the meaning of §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127 (*e.g.*, is generic or purely ornamental), the examining attorney will refuse registration on both registers.

However, if the issues are framed in the alternative (*i.e.*, whether the matter sought to be registered has acquired distinctiveness under §2(f) or, in the alternative, whether it is capable of registration on the Supplemental Register), and it is ultimately determined that the matter is a mark within the meaning of the Act (*e.g.*, that the matter is merely descriptive rather than generic), then the evidence of secondary

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meaning will be considered. If it is determined that the applicant's evidence is sufficient to establish that the mark has acquired distinctiveness, the application will be approved for publication on the Principal Register under §2(f). If the evidence is determined to be insufficient, the mark may be registered on the Supplemental Register.

Accordingly, the applicant may submit an amendment to the Supplemental Register, and continue to argue entitlement to registration on the Principal Register in an appeal.

If the applicant files a notice of appeal in such a case, the examining attorney should forward the application to the Trademark Trial and Appeal Board to institute the appeal. The Board will suspend action on the appeal and remand the application to the examining attorney to determine registrability on the Supplemental Register.

If the examining attorney determines that the applicant is entitled to registration on the Supplemental Register, the examining attorney will return the application to the Board to resume action on the appeal with respect to registration on the Principal Register. The examining attorney should also send a letter notifying the applicant of the acceptance of the amendment and telling the applicant that the application is being referred to the Board for resumption of the appeal. If the examining attorney determines that the applicant is not entitled to registration on the Supplemental Register, the examining attorney will issue a nonfinal action refusing registration on the Supplemental Register. If the applicant fails to overcome the refusal, the examining attorney will return the application to the Board to resume action on the appeal with respect to entitlement to registration on either the Principal or the Supplemental Register.

Rather than framing the issues in the alternative (*i.e.*, whether the matter has acquired distinctiveness pursuant to §2(f) or, in the alternative, whether it is capable of registration on the Supplemental Register), the applicant may amend its application between the Principal and Supplemental Registers. 37 C.F.R. §2.75. *See generally In re Educational Communications, Inc.*, 231 USPQ 787 (TTAB 1986); *In re Broco*, 225 USPQ 227 (TTAB 1984).

See TMEP §§816.02 and 1102.03 regarding amending a §1(b) application to the Supplemental Register.

1212.02(d) Unnecessary §2(f) Claims

If the applicant specifically requests registration under §2(f), but the examining attorney considers the entire mark to be inherently distinctive and the claim of acquired distinctiveness to be unnecessary, the examining attorney should so inform the applicant and inquire whether the applicant wishes to delete the statement or to rely on it.

If the applicant specifically requests registration of the entire mark under §2(f), but the examining attorney believes that part of the mark is inherently distinctive, the

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examining attorney should give the applicant the option of limiting the §2(f) claim to the matter that is not inherently distinctive. (See TMEP §1212.02(f) regarding claims of §2(f) distinctiveness as to a portion of a mark.) However, if the applicant wishes, a claim of acquired distinctiveness under §2(f) may be made as to an entire mark or phrase that contains both inherently distinctive matter and matter that is not inherently distinctive. *In re Del E. Webb Corp.*, 16 USPQ2d 1232, 1234 (TTAB 1990).

If the application contains statements that seem to relate to acquired distinctiveness or §2(f) but do not actually amount to a request for registration under §2(f), and the examining attorney does not believe that resort to §2(f) is necessary, the examining attorney may treat the statements as surplusage. If it is necessary to communicate with the applicant about another matter, the examining attorney should inform the applicant that the statements are being treated as surplusage. If it is otherwise unnecessary to communicate with the applicant, the examining attorney may mark the statements “Do Not Print” and approve the application for publication.

1212.02(e) Disclaimers in Applications Claiming Distinctiveness under §2(f)

Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), states, in part, “The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” See *In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766, 768 (TTAB 1986) (“[W]e conclude that it is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f).”). Cf. *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977).

1212.02(f) Section 2(f) Claim in Part (as to a Portion of the Mark)

A claim of acquired distinctiveness may apply to a portion of a mark. The applicant must clearly identify the portion of the mark for which distinctiveness is claimed. The standards for establishing acquired distinctiveness are the same whether the claim of distinctiveness pertains to the entire mark or to a portion of it. See TMEP §§1212.09 *et seq.* regarding claims of acquired distinctiveness in intent-to-use applications under §1(b) of the Act.

Generally, the element that is the subject of the §2(f) claim must present a distinct commercial impression apart from the other elements of the mark. That is, it must be a separable element in order for the applicant to assert that it has acquired distinctiveness as a mark.

If the examining attorney determines that the claim of distinctiveness as to a portion of the mark is appropriate, the examining attorney should ensure that the record reflects that the §2(f) claim applies to the mark “in part” and that the relevant portion of the mark is identified.

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If a claim of distinctiveness applies to only part of a mark and the examining attorney determines (1) that the claimed portion of the mark is unregistrable even under §2(f) (e.g., because it is generic or functional), or (2) that, although the claimed portion is registrable, the applicant has failed to establish acquired distinctiveness, the examining attorney may require a disclaimer of that portion of the mark, if a disclaimer is otherwise appropriate. *See In re Lillian Vernon Corp.*, 225 USPQ 213 (TTAB 1985) (requirement for disclaimer of PROVENDER affirmed in application to register PROVENDER and design for “mail order services in the gourmet, bath and gift item field,” “provender” meaning “food” (claim of §2(f) distinctiveness in part held unacceptable)). *Cf. In re Chopper Industries*, 222 USPQ 258 (TTAB 1984) (requirement for disclaimer of CHOPPER reversed in application to register CHOPPER 1 and design for wood log splitting axes (claim of §2(f) distinctiveness in part held acceptable)).

1212.02(g) Examining Attorney’s Role in Suggesting §2(f) or Appropriate Kind/Amount of Evidence

In a first action refusing registration, the examining attorney should suggest, where appropriate, that the applicant amend its application to seek registration under §2(f). For example, this should be done as a matter of course, if otherwise appropriate, in cases where registration is refused under §2(e)(4), on the ground that the mark is primarily merely a surname, and the applicant has recited dates of use that indicate that the mark has been in use in commerce for at least five years.

If the examining attorney determines that an applicant’s evidence is insufficient to establish that the mark has acquired distinctiveness, the examining attorney should suggest, where appropriate, that the applicant submit additional evidence. *See In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 220 n.2 (TTAB 1984) (Noting that applicant was specifically invited to seek registration pursuant to §2(f) but, after amending its application to do so, was refused registration on the ground that the mark was incapable of acquiring distinctiveness, the Board stated that, in fairness to applicant, this practice should be avoided where possible).

The examining attorney should not “require” that the applicant submit evidence of secondary meaning. There would be no practical standard for a proper response to this requirement; nor would there be a sound basis for appeal from the requirement. *See In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983) (“Section 2(f) is not a provision on which registration can be refused.”).

The examining attorney should not specify the kind or the amount of evidence sufficient to establish that a mark has acquired distinctiveness. It is the responsibility of the applicant to submit evidence to establish that the mark has acquired distinctiveness. *See* TMEP §1212.01. However, the examining attorney may make a suggestion as to a course of action if the examining attorney believes this would further the prosecution of the application.

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1212.02(h) Non-Final and Final Refusals

If an application is filed under §2(f) of the Trademark Act and the examining attorney determines that (1) the mark is not inherently distinctive, and (2) the applicant's evidence of secondary meaning is insufficient to establish that the mark has acquired distinctiveness, the examining attorney will issue a non-final action refusing registration on the Principal Register pursuant to the appropriate section of the Trademark Act (*e.g.*, §2(e)(1)), with a finding that the applicant's evidence of secondary meaning is insufficient to overcome the stated refusal. The examining attorney should suggest, where appropriate, that the applicant submit additional evidence. *See* TMEP §1212.02(g) concerning the examining attorney's role in suggesting a claim of distinctiveness under §2(f).

If an application is not filed under §2(f) and the examining attorney determines that the mark is not inherently distinctive, the examining attorney should issue a non-final action refusing registration on the Principal Register under the appropriate section of the Act (*e.g.*, §2(e)(1)). The examining attorney should suggest, where appropriate, that the applicant amend its application to claim distinctiveness under §2(f).

Thereafter, if the applicant amends its application to seek registration under §2(f), a new issue is raised as to the sufficiency of the applicant's evidence of secondary meaning (*see* TMEP §714.05(a)(1)). The underlying statutory basis for refusal remains the same (*e.g.*, §2(e)(1)), but the issue changes from whether the underlying refusal is warranted to whether the matter has acquired distinctiveness. If the examining attorney is persuaded that a *prima facie* case of acquired distinctiveness has been established, the examining attorney will approve the application for publication under §2(f). If the examining attorney determines that the applicant's evidence is insufficient to establish that the matter has acquired distinctiveness, the examining attorney will issue a second non-final action repeating the underlying statutory basis for refusal (*e.g.*, §2(e)(1)), and explaining that the applicant's evidence is insufficient to overcome the stated refusal.

The examining attorney cannot issue a final refusal on the underlying statutory basis of the original refusal, upon an applicant's initial assertion of a §2(f) claim. The mere assertion of distinctiveness under §2(f) raises a new issue. *See In re Educational Communications, Inc.*, 231 USPQ 787, 787 n.2 (TTAB 1986). Even if the applicant has submitted, in support of the §2(f) claim, a statement of five years' use that is technically defective (*e.g.*, not verified or comprising incorrect language), the assertion of §2(f) distinctiveness still constitutes a new issue.

Exception: The examining attorney may issue a final refusal upon an applicant's initial assertion of a §2(f) claim if the amendment is irrelevant to the outstanding refusal. *See* TMEP §714.05(a)(1). *See also* TMEP §§1212.02(a) and 1212.02(i) regarding situations where it is and is not appropriate to submit a claim of acquired distinctiveness to overcome a refusal.

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After the examining attorney has issued a non-final action refusing registration on the Principal Register with a finding that the applicant's evidence of secondary meaning is insufficient to overcome the stated refusal, the applicant may elect to submit additional arguments and/or evidence regarding secondary meaning. If, after considering this submission, the examining attorney is persuaded that the applicant has established a *prima facie* case of acquired distinctiveness, the examining attorney will approve the application for publication under §2(f). If the examining attorney is not persuaded that the applicant has established a *prima facie* case of acquired distinctiveness, and the application is otherwise in condition for final refusal, the examining attorney will issue a final refusal pursuant to the appropriate section of the Act (e.g., §2(e)(1)), with a finding that the applicant's evidence of acquired distinctiveness is insufficient to overcome the stated refusal. *See In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983) ("Section 2(f) is not a provision on which registration can be refused....").

In any action in which the examining attorney indicates that the evidence of record is insufficient to establish that the mark has acquired distinctiveness, the examining attorney should specify the reasons for this determination. *See In re Interstate Folding Box Co.*, 167 USPQ 241, 242 (TTAB 1970); *In re H. A. Friend & Co., Inc.*, 158 USPQ 609 (TTAB 1968).

1212.02(i) Section 2(f) Claim with Respect to Incapable Matter

If matter is generic, functional or purely ornamental, or otherwise fails to function as a mark, the matter is unregistrable. *See, e.g., In re Bongrain International Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) ("If a mark is generic, incapable of serving as a means 'by which the goods of the applicant may be distinguished from the goods of others' ... it is not a trademark and can not be registered under the Lanham Act."); *H. Marvin Ginn Corp. v. International Association of Fire Chiefs*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), and cases cited therein ("A generic term ... can never be registered as a trademark because such a term is 'merely descriptive' within the meaning of §2(e)(1) and is incapable of acquiring *de jure* distinctiveness under §2(f). The generic name of a thing is in fact the ultimate in descriptiveness."). *See also In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986) (BRAND NAMES FOR LESS, for retail store services in the clothing field, "should remain available for other persons or firms to use to describe the nature of their competitive services.").

An underlying basis of refusal common in each of the situations referred to above is the failure of the matter to function as a mark within the meaning of the Trademark Act (15 U.S.C. §§1051, 1052 and 1127). *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

It is axiomatic that matter may not be registered unless it is used as a mark, namely, "in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in question." *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987). *See, e.g., In re Melville Corp.*, 228 USPQ 970,

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970 n.2 (TTAB 1986) (“If matter proposed for registration does not function as a mark, it is not registrable in accordance with Sections 1 and 2 of the Act because the preambles of those sections limit registration to subject matter within the definition of a trademark.”); *In re Whataburger Systems, Inc.*, 209 USPQ 429, 430 (TTAB 1980) (“[A] designation may not be registered either as a trademark or as a service mark unless it is used as a mark, in such a manner that its function as an indication of origin may be readily perceived by persons encountering the goods or services in connection with which it is used.”).

Therefore, where the examining attorney has determined that matter sought to be registered is not registrable because it is not a mark within the meaning of the Trademark Act, a claim that the matter has acquired distinctiveness under §2(f) as applied to the applicant’s goods or services does not overcome the refusal. It would be logically inconsistent to find otherwise. *See, e.g., TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1007 (2001) (“Functionality having been established, whether MDI’S dual spring design has acquired secondary meaning need not be considered.”); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484-85, 222 USPQ 1, 3 (Fed. Cir. 1984) (“Evidence of distinctiveness is of no avail to counter a de jure functionality rejection.”); *In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984) (“Long use of a slogan which is not a trademark and would not be so perceived does not, of course, transform the slogan into a trademark.”); *In re Mancino*, 219 USPQ 1047, 1048 (TTAB 1983) (“Since the refusal ... was based on applicant’s failure to demonstrate technical service mark use, the claim of distinctiveness under Section 2(f) was of no relevance to the issue in the case.”).

As discussed above, evidence of acquired distinctiveness will not alter the determination that matter is unregistrable. Nevertheless, the evidence submitted by the applicant should be reviewed to determine whether it has any bearing on the underlying basis of refusal.

See also In re Wakefern Food Corp., 222 USPQ 76, 79 (TTAB 1984) (the Board, while finding applicant’s evidence relating to public perception of WHY PAY MORE! entitled to relatively little weight, noting that the evidence is relevant to the issue of whether the slogan functions as a mark for applicant’s supermarket services).

1212.03 Evidence of Distinctiveness Under §2(f)

37 C.F.R. §2.41. Proof of distinctiveness under section 2(f).

(a) When registration is sought of a mark which would be unregistrable by reason of section 2(e) of the Act but which is said by applicant to have become distinctive in commerce of the goods or services set forth in the application, applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, affidavits, or declarations in accordance with §2.20, depositions, or other appropriate evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying

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types of media and attaching typical advertisements), and affidavits, or declarations in accordance with §2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods.

(b) In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. Also, if the mark is said to have become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness is made, a showing by way of statements which are verified or which include declarations in accordance with §2.20, in the application may, in appropriate cases, be accepted as prima facie evidence of distinctiveness. In each of these situations, however, further evidence may be required.

“To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 n. 11, 214 USPQ 1, 4 n. 11 (1982).

1212.04 Prior Registrations as Proof of Distinctiveness

Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), provides that the examining attorney may accept, as *prima facie* evidence of acquired distinctiveness, ownership by the applicant of one or more prior registrations of the same mark on the Principal Register or under the Act of 1905. See TMEP §1212.04(b) as to what constitutes the “same mark,” and TMEP §§1212.09 *et seq.* concerning §1(b) applications.

The rule states that ownership of existing registrations to establish acquired distinctiveness “may” be considered acceptable in “appropriate cases,” and that the Office may, at its option, require additional evidence of distinctiveness. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

The following are general guidelines regarding claiming ownership of prior registrations as a method of establishing acquired distinctiveness.

1212.04(a) Sufficiency of Claim vis-à-vis Nature of the Mark

The examining attorney has the discretion to determine whether the nature of the mark sought to be registered is such that a claim of ownership of a prior registration for the same or similar goods or services is enough to establish acquired distinctiveness. For example, if the mark sought to be registered is deemed to be highly descriptive or misdescriptive of the goods or services named in the application, the examining attorney may require additional evidence of acquired distinctiveness. See *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (claim of ownership of a prior registration held insufficient to establish acquired distinctiveness where registration was refused as primarily geographically deceptively

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misdescriptive); *In re Kerr-McGee Corp.*, 190 USPQ 204 (TTAB 1976) (claim of ownership of prior registrations held insufficient to establish acquired distinctiveness where registration was refused on ground that the subject matter was merely an ornamental border or “carrier” for words and symbols appearing within).

1212.04(b) “Same Mark”

A proposed mark is the “same mark as a previously-registered mark for the purpose of 37 C.F.R. §2.41(b) if it is the “legal equivalent” of such a mark. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). *See also Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475, 1477 (TTAB 1988) (“The words GOLDEN RING, while they are used to describe the device, are by no means identical to or substantially identical to the gold ring device trademark.”); *In re Best Products Co., Inc.*, 231 USPQ 988, 989 n.6 (TTAB 1986) (“[W]e infer in the instant case that the differences between the marks BEST & Des. and BEST JEWELRY & Des., and between the identifications of services in their respective registrations, were deemed to be immaterial differences.”); *In re Loew’s Theatres, Inc.*, 223 USPQ 513, 514 n.5 (TTAB 1984), *aff’d*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (“We do not, however, agree with the Examining Attorney that a minor difference in the marks (*i.e.*, here, merely that the mark of the existing registration is in plural form) is a proper basis for excluding any consideration of this evidence under the rule.”); *In re Flex-O-Glass, Inc.*, 194 USPQ 203, 205-06 (TTAB 1977) (“[P]ersons exposed to applicant’s registered mark ... would, upon encountering [applicant’s yellow rectangle and red circle design] ..., be likely to accept it as the same mark or as an inconsequential modification or modernization thereof.... [A]pplicant may ‘tack on’ to its use of the mark in question, the use of the registered mark ... and therefore may properly rely upon its registration in support of its claim of distinctiveness herein.”).

See, e.g., Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991) regarding the concept of “tacking” with reference to prior use of a legally equivalent mark.

1212.04(c) Relatedness of Goods or Services

The examining attorney should determine whether the goods or services named in the application are sufficiently similar to the goods or services named in the prior registration(s). *See Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475, 1478 (TTAB 1988) (“Applicant’s almost total reliance on the distinctiveness which its gold ring device has achieved vis-à-vis rifle scopes and handgun scopes is simply not sufficient by itself to establish that the same gold ring device has become distinctive vis-à-vis binoculars and spotting scopes.”); *In re Best Products Co., Inc.*, 231 USPQ 988, 989 n.6 (TTAB 1986) (“[W]e infer in the instant case that the differences between the marks BEST & Des. and BEST JEWELRY & Des., and

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between the identifications of services in their respective registrations [“mail order and catalog showroom services” and “retail jewelry store services”], were deemed to be immaterial differences.”); *In re Owens-Illinois Glass Co.*, 143 USPQ 431, 432 (TTAB 1964) (applicant’s ownership of prior registration of LIBBEY for cut-glass articles held acceptable as *prima facie* evidence of distinctiveness of identical mark for plastic tableware, the Board stating, “Cut-glass and plastic articles of tableware are customarily sold in the same retail outlets, and purchasers of one kind of tableware might well be prospective purchasers of the other.”); *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308, 309 (TTAB 1960) (applicant’s ownership of prior registration of LYTLE for various services, including the planning, preparation and production of technical publications, held acceptable as *prima facie* evidence of distinctiveness of identical mark for brochures, catalogues and bulletins).

1212.04(d) Registration Must Be in Full Force and Effect and on Principal Register or under Act of 1905

Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), states that ownership of a prior registration “on the Principal Register or under the Act of 1905” may be accepted as *prima facie* evidence of distinctiveness. Therefore, claims of acquired distinctiveness under §2(f) cannot be based on ownership of registrations on the Supplemental Register. See *In re Canon, Inc.*, 219 USPQ 820 (TTAB 1983).

Moreover, a claim of acquired distinctiveness cannot be based on a registration that is cancelled or expired. See *In re BankAmerica Corp.*, 229 USPQ 852, 853 (TTAB 1986). When an examining attorney considers a §2(f) claim based on ownership of one or more prior registrations, the examining attorney should confirm, in the records of the Office, that the claimed registrations were issued on the Principal Register or under the Act of 1905 and that they are in full force and effect.

1212.04(e) Form of §2(f) Claim Based on Ownership of Prior Registrations

The following language may be used to claim distinctiveness under §2(f) on the basis of ownership of one or more prior registrations:

The mark has become distinctive of the goods (or services) as evidenced by ownership of U.S. Registration No(s). _____ on the Principal Register for the same mark for related goods or services.

37 C.F.R. §2.41(b).

If the applicant is relying solely on its ownership of one or more prior registrations as proof of acquired distinctiveness, the §2(f) claim does not have to be verified. Therefore, an applicant or an applicant’s attorney may authorize amendment of an application to add such a claim through an examiner’s amendment, if otherwise appropriate.

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1212.05 Five Years of Use as Proof of Distinctiveness

Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), provides that “proof of substantially exclusive and continuous use” of a designation “as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made” may be accepted as *prima facie* evidence that the mark has acquired distinctiveness as used with the applicant’s goods in commerce. *See also* 37 C.F.R. §2.41(b).

The Trademark Act previously required that the relevant five-year period precede the filing date of the application. The Trademark Law Revision Act of 1988, Public Law 100-667, 102 Stat. 3935, revised §2(f) of the Act to provide for a *prima facie* showing of acquired distinctiveness based on five years’ use running up to the date the claim is made. Under the revised provision, any five-year claim submitted on or after November 16, 1989, is subject to the new time period. This applies even if the application was filed prior to that date.

Section 2(f) of the Act, and 37 C.F.R. §2.41(b) state that reliance on a claim of five years’ use to establish acquired distinctiveness “may” be acceptable in “appropriate cases.” The Office may, at its option, require additional evidence of distinctiveness. Whether a claim of five years’ use will be deemed acceptable to establish that the mark has acquired distinctiveness depends largely on the nature of the mark in relation to the specified goods or services.

The following are general guidelines regarding the statutorily suggested proof of five years’ use as a method of establishing acquired distinctiveness.

1212.05(a) Sufficiency of Claim Vis-à-Vis Nature of the Mark

For most surnames, the statement of five years’ use will be sufficient to establish acquired distinctiveness.

The amount of evidence necessary to establish secondary meaning varies -- “the greater the degree of description a term has, the heavier the burden to prove it has attained secondary meaning.” *In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 n. 4 (Fed. Cir. 1990); *Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988).

Accordingly, for marks refused under §§2(e)(1) or 2(e)(2), whether the statement of five years’ use is sufficient in and of itself to establish acquired distinctiveness depends on the degree to which the mark is descriptive or misdescriptive. If the mark is highly descriptive or misdescriptive of the goods or services named in the application, the statement of five years’ use alone will be deemed insufficient to establish acquired distinctiveness. *See In re Kalmbach Publishing Co.*, 14 USPQ2d 1490 (TTAB 1989) (applicant’s sole evidence of acquired distinctiveness, a claim of use since 1975, held insufficient to establish that the highly descriptive, if not generic, designation RADIO CONTROL BUYERS GUIDE had become distinctive of applicant’s magazines); *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987) (“[T]o

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support registration of PROTECTIVE EQUIPMENT [for burglar and fire alarms and burglar and fire alarm surveillance services] on the Principal Register a showing considerably stronger than a prima facie statement of five years' substantially exclusive use is required."). *Cf. In re Synergistics Research Corp.*, 218 USPQ 165 (TTAB 1983) (applicant's declaration of five years' use held sufficient to support registrability under §2(f) of BALL DARTS for equipment sold as a unit for playing a target game, in view of lack of evidence that the term is highly descriptive (*e.g.*, no dictionary evidence of any meaning of BALL DARTS and no evidence of use of the term by competitors or the public)).

For matter that does not inherently function as a mark because of its nature (*e.g.*, nondistinctive product container shapes, overall color of a product, mere ornamentation), evidence of five years' use is not sufficient to show acquired distinctiveness. In such a case, actual evidence that the mark is perceived as a mark for the relevant goods or services would be required to establish distinctiveness. *See generally In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (color pink as uniformly applied to applicant's fibrous glass residential insulation); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984) (configuration of pistol grip water nozzle for water nozzles); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142 (TTAB 1990) (color green for medical instruments); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990) (configuration of a pillow-pack container for ear plugs and configuration of a pillow-pack container with trade dress (white circle surrounded by blue border) for ear plugs); *In re Star Pharmaceuticals, Inc.*, 225 USPQ 209 (TTAB 1985) (color combination of drug capsule and seeds therein for methyltestosterone); *In re Craigmyle*, 224 USPQ 791 (TTAB 1984) (configuration of halter square for horse halters).

1212.05(b) "Substantially Exclusive and Continuous"

The five years of use does not have to be exclusive, but may be "substantially" exclusive. This makes allowance for use by others that may be inconsequential or infringing, which does not necessarily invalidate the applicant's claim. *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307 (Fed. Cir. 1999).

The existence of other applications to register the same mark, or other known uses of the mark, does not automatically eliminate the possibility of using this method of proof, but the examining attorney should inquire as to the nature of such use and be satisfied that it is not substantial or does not nullify the claim of distinctiveness. *See Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1403, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances."); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1357-58 (TTAB 1989) ("[T]he existence of numerous third party users of a mark, even if junior, might well have a material impact on the Examiner's decision to accept a party's claim of distinctiveness."); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588-89 (TTAB

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1987) (“[L]ong and continuous use alone is insufficient to show secondary meaning where the use is not substantially exclusive.”); *Ex parte The Kalart Co. Inc.*, 88 USPQ 221 (PO Ex. Ch. 1951).

The use of the mark during the five years must be continuous, without a period of “nonuse” or suspension of trade in the goods or services in connection with which the mark is used.

1212.05(c) Use “as a Mark”

The substantially exclusive and continuous use must be “as a mark.” 15 U.S.C. §1052(f). *See In re Craigmyle*, 224 USPQ 791 (TTAB 1984) (registrability under §2(f) not established by sales over a long period of time where there was no evidence that the subject matter had been used as a mark); *In re Kwik Lok Corp.*, 217 USPQ 1245, 1248 (TTAB 1983) (declarations as to sales volume and advertising expenditures held insufficient to establish acquired distinctiveness. “The significant missing element in appellant’s case is evidence persuasive of the fact that the subject matter has been used *as a mark*.”).

1212.05(d) Form of the Proof of Five Years’ Use

If the applicant chooses to seek registration under §2(f), 15 U.S.C. §1052(f), by using the statutory suggestion of five years of use as proof of distinctiveness, the applicant should submit a claim of distinctiveness that reads as follows, if accurate:

The mark has become distinctive of the goods (or services) through the applicant’s substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.

The claim of five years of use is generally required to be supported by an affidavit, or a declaration in accordance with 37 C.F.R. §2.20, signed by the applicant. *See* 37 C.F.R. §2.41(b). The affidavit or declaration can be signed by a person properly authorized to sign on behalf of applicant under 37 C.F.R. §2.33(a). *See* TMEP §804.04.

The following are guidelines regarding the form and language appropriate for a claim of five years of use:

- (1) Use of the precise statutory wording is desirable, but variations may be accepted if they do not affect the essential allegations.
- (2) The wording “substantially exclusive and continuous use in commerce” is essential.
- (3) It must be clear from the record that the five years of use has been in commerce that may lawfully be regulated by Congress. *See Blanchard & Co., Inc. v. Charles Gilman & Son, Inc.*, 145 USPQ 62 (D. Mass. 1965),

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aff'd, 353 F.2d 400, 147 USPQ 263 (1st Cir. 1965), *cert. denied* 383 U.S. 968, 149 USPQ 905 (1966).

- (4) The use of the mark must cover the five years before the date of the statement of five years' use. Thus wording that indicates that the use referred to is before the date of the statement is essential. Its omission can only be excused if the facts in the record clearly show that the use includes the five years before the date of the statement.
- (5) The affidavit or declaration should include a statement that the mark has become distinctive or that the applicant believes that the mark has become distinctive, but absence of this statement is not fatal. *See* TMEP §1212.07 for examples of various ways in which an applicant may assert a §2(f) claim.
- (6) The affidavit or declaration should contain a reference to distinctiveness as applied to the applicant's goods or services, or to use with the applicant's goods or services, because the distinctiveness created by the five years' use must relate to the goods or services specified in the application. If there is doubt that the distinctiveness pertains to either all or any of the goods or services specified in the application, the examining attorney should inquire regarding that issue. While a clarifying response does not have to be verified, a substitute statement must be verified, *i.e.*, supported by an affidavit or a declaration under 37 C.F.R. §2.20, signed by the applicant.

1212.06 Establishing Distinctiveness by Actual Evidence

Under Trademark Rule 2.41(a), 37 C.F.R. §2.41(a), an applicant may, in support of registrability, submit affidavits, declarations under 37 C.F.R. §2.20, depositions or other appropriate evidence showing the duration, extent and nature of the applicant's use of a mark in commerce that may lawfully be regulated by Congress, advertising expenditures in connection with such use, letters or statements from the trade and/or public, or other appropriate evidence tending to show that the mark distinguishes the goods or services.

Establishing acquired distinctiveness by actual evidence was explained as follows in *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985):

An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner's method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.

The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services necessarily depends on the nature of the mark and the circumstances surrounding the use of the mark in each case.

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Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Capital Formation Counselors*, 219 USPQ 916 (TTAB 1983).

In considering a claim of acquired distinctiveness, the issue is whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public, not whether the mark is capable of becoming distinctive. *In re Redken Laboratories, Inc.*, 170 USPQ 526 (TTAB 1971); *In re Fleet-Wing Corp.*, 122 USPQ 335 (TTAB 1959).

The following are some examples of different types of evidence that have been used, alone or in combination, to establish acquired distinctiveness. No single evidentiary factor is determinative. The value of a specific type of evidence and the amount necessary to establish acquired distinctiveness will vary according to the facts of the specific case.

1212.06(a) Long Use of the Mark

Long use of the mark is one relevant factor to consider in determining whether a mark has acquired distinctiveness. See *In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986) (§2(f) claim of acquired distinctiveness of SPRAYZON for “cleaning preparations and degreasers for industrial and institutional use” found persuasive where applicant had submitted declaration of its president supporting sales figures and attesting to over eighteen years of substantially exclusive and continuous use); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (evidence submitted by applicant held insufficient to establish acquired distinctiveness of PACKAGING SPECIALISTS, INC., for contract packaging services, notwithstanding, *inter alia*, continuous and substantially exclusive use for sixteen years, deemed “a substantial period but not necessarily conclusive or persuasive”).

1212.06(b) Advertising Expenditures

Large scale expenditures in promoting and advertising goods and services under a particular mark are significant to indicate the extent to which a mark has been used. However, proof of an expensive and successful advertising campaign is not in itself enough to prove secondary meaning. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars -- two million of which were spent on promotions and promotional items which included the phrase THE BEST BEER IN AMERICA -- found insufficient to establish distinctiveness, in view of the highly descriptive nature of the proposed mark); *Mattel, Inc. v. Azrak-Hamway International, Inc.*, 724 F.2d 357, 221 USPQ 302, 305 n. 2 (2d Cir. 1983). The ultimate test in determining whether a designation has acquired distinctiveness is applicant's success, rather than its efforts, in educating the public to associate the proposed mark with a single source. The examining attorney must examine the advertising material to determine how the

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term is being used, the commercial impression created by such use, and what the use would mean to purchasers. *In re Redken Laboratories, Inc.*, 170 USPQ 526, 529 (TTAB 1971) (evidence adduced by applicant pursuant to §2(f) held insufficient to establish acquired distinctiveness of THE SCIENTIFIC APPROACH, for lectures concerning hair and skin treatment, notwithstanding ten years of use, over \$500,000 in promotion and sponsorship expenses, and the staging of over 300 shows per year). *See also In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (refusal to register OFFICE MOVERS, INC., for moving services, affirmed notwithstanding §2(f) claim based on, *inter alia*, evidence of substantial advertising expenditures. “There is no evidence that any of the advertising activity was directed to creating secondary meaning in applicant’s highly descriptive trade name.”); *In re Kwik Lok Corp.*, 217 USPQ 1245 (TTAB 1983) (evidence held insufficient to establish acquired distinctiveness for configuration of bag closures made of plastic, notwithstanding applicant’s statement that advertising of the closures involved several hundred thousands of dollars, where there was no evidence that the advertising had any impact on purchasers in perceiving the configuration as a mark). *Cf. In re Haggard Co.*, 217 USPQ 81, 84 (TTAB 1982) (background design of a black swatch held registrable pursuant to §2(f) for clothing where applicant had submitted, *inter alia*, evidence of “very substantial advertising and sales,” the Board finding the design to be, “because of its serrated left edge, something more than a common geometric shape or design”).

If the applicant prefers not to specify the extent of its expenditures in promoting and advertising goods and services under the mark because this information is confidential, the applicant may indicate the types of media through which the goods and services have been advertised (*e.g.*, national television) and how frequently the advertisements have appeared.

1212.06(c) Affidavits or Declarations Asserting Recognition of Mark as Source Indicator

Affidavits or declarations that assert recognition of the mark as a source indicator are relevant in establishing acquired distinctiveness. The value of the affidavits or declarations depends on the statements made and the identity of the affiant or declarant. *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988) (conclusionary declaration from applicant’s vice-president held insufficient without the factual basis for the declarant’s belief that the design had become distinctive). Proof of distinctiveness requires more than proof of the existence of a relatively small number of people who associate a mark with the applicant. *In re The Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) (“Because these affidavits were sought and collected by applicant from ten customers who have dealt with applicant for many years, the evidence is not altogether persuasive on the issue of how the average customer for paints perceives the words ‘PAINT PRODUCTS CO.’ in conjunction with paints and coatings.”). *See also In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987) (affidavit of applicant’s counsel expressing his belief that the mark has acquired secondary meaning accorded “no probative value whatsoever”

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because, among other reasons, the statement is subject to bias); *In re Petersen Mfg. Co.*, 2 USPQ2d 2032 (TTAB 1987) (declarations from customers which stated that designs used by applicant indicate to the declarant that the applicant is the source of the goods, but which did not refer to or identify the designs with any specificity, not considered persuasive); *In re Bose Corp.*, 216 USPQ 1001, 1005 (TTAB 1983), *aff'd*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (retailer's statement that he has been in contact with many purchasers of loudspeaker systems of whom a substantial number would recognize depicted design as originating with applicant deemed competent evidence of secondary meaning); *In re Flex-O-Glass, Inc.*, 194 USPQ 203, 206 (TTAB 1977) ("[T]he fact that the affidavits may be similar in format and expression is of no particular significance ... since the affiants have sworn to the statements contained therein.").

1212.06(d) Survey Evidence, Market Research and Consumer Reaction Studies

Survey evidence, market research and consumer reaction studies are relevant in establishing acquired distinctiveness and secondary meaning. *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 37, 59 USPQ2d 1720, 1730 (1st Cir. 2001) ("Although survey evidence is not required, 'it is a valuable method of showing secondary meaning,'" citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 41, 49 USPQ2d 1225, 1235 (1st Cir. 1998)).

To show secondary meaning, the survey must show that the public views the proposed mark as an indication of the source of the product or service. *Boston Beer Co. L.P. v. Slesar Bros. Brewing Co., Inc.*, 9 F.3d 175, 28 USPQ2d 1778 (1st Cir. 1993) (survey found insufficient to establish acquired distinctiveness where survey demonstrates product-place association rather than product-source association). The applicant must document the procedural and statistical accuracy of this type of evidence and carefully frame the questions contained therein. See *In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) ("[T]he survey asked the wrong question. The issue is not whether the term 'Office Movers' identifies a specific company. Rather, it is whether the term 'OFFICE MOVERS, INC.' identifies services which emanate from a single source."); *General Foods Corp. v. Ralston Purina Co.*, 220 USPQ 990, 994 n.7 (TTAB 1984) ("[W]here ... [reports of market research, consumer reaction studies] have been conducted for marketing reasons rather than directly to assist in resolving the issues in proceedings before us, their value will almost always depend on interpretations of their significance by witnesses or other evidence."); *Specialty Brands, Inc. v. Spiceseas, Inc.*, 220 USPQ 73, 74 n.4 (TTAB 1983) (testimony concerning survey results, unsupported by documentation, considered unreliable hearsay).

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1212.06(e) Miscellaneous Considerations Regarding Evidence Submitted to Establish Distinctiveness

1212.06(e)(i) First or Only User

When the applicant is the only source of the goods or services, use alone does not automatically represent trademark recognition and acquired distinctiveness. *See, e.g., J. Kohnstam, Ltd. v. Louis Marx & Co., Inc.*, 280 F.2d 437, 126 USPQ 362 (C.C.P.A. 1960); *In re Mortgage Bankers Association of America*, 226 USPQ 954 (TTAB 1985); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983); *In re Meier's Wine Cellars, Inc.*, 150 USPQ 475 (TTAB 1966); *In re G. D. Searle & Co.*, 143 USPQ 220 (TTAB 1964), *aff'd*, 360 F.2d 650, 149 USPQ 619 (C.C.P.A. 1966).

1212.06(e)(ii) State Trademark Registrations

State trademark registrations are of relatively little probative value. *See, e.g., In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 370 (TTAB 1985), *recon. denied*, 229 USPQ 716 (TTAB 1986) (“While applicant’s design may be registrable under the provisions of California trademark law, it is the federal trademark statute and the cases interpreting it by which we must evaluate the registrability of applicant’s asserted mark.”); *In re Craigmyle*, 224 USPQ 791, 794 (TTAB 1984).

1212.06(e)(iii) Design Patent

The fact that a device is the subject of a design patent does not, without more, mean that it functions as a mark or has acquired distinctiveness. *See, e.g., In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 370 (TTAB 1985), *recon. denied*, 229 USPQ 716 (TTAB 1986).

1212.06(e)(iv) Acquiescence to Demands of Competitors

Acquiescence to demands of competitors to cease use of a term can be equally viewed as simply a desire to avoid litigation. *See, e.g., In re Wella Corp.*, 565 F.2d 143, 144 n.2, 196 USPQ 7, 8 n.2 (C.C.P.A. 1977); *In re Consolidated Cigar Corp.*, 13 USPQ2d 1481 (TTAB 1989).

1212.07 Form of Application Asserting Distinctiveness

To base a registration on acquired distinctiveness under §2(f), 15 U.S.C. §1052(f), an applicant must indicate its intent to do so.

The indication of the applicant’s intent to rely on §2(f) can take a variety of forms, for example, a statement that registration is requested under §2(f); a statement that the mark has become distinctive, or that the applicant believes the mark has become distinctive of the goods or services in commerce; the statement relating to five years’

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use in commerce as suggested in §2(f); or a statement that evidence is being submitted in support of acquired distinctiveness.

If it is unclear from the application whether a claim of distinctiveness under §2(f) has been made, the examining attorney should inquire whether the applicant is seeking registration under §2(f). *See* TMEP §1212.02(d) concerning unnecessary §2(f) claims.

If the statement requesting registration under §2(f) and the evidence submitted to establish acquired distinctiveness are in the application when filed, the §2(f) statement and proof are supported by the verification of the application.

If a claim of distinctiveness pursuant to §2(f) is submitted as an amendment, or if additional evidence is added in an amendment, the nature of the proof submitted to establish acquired distinctiveness determines whether a verification is necessary.

A claim of ownership of one or more prior registrations as proof of distinctiveness does not have to be verified. *See* TMEP §1212.04(e).

If the applicant claims that the mark has become distinctive of the applicant's goods or services through substantially exclusive and continuous use of the mark in commerce by the applicant for the five years before the date on which the claim of distinctiveness is made, the applicant must submit this claim in the form of an affidavit, or a declaration in accordance with 37 C.F.R. §2.20, signed by the applicant. 15 U.S.C. §1052(f); 37 C.F.R. §2.41(b); TMEP §1212.05(d). *See* 37 C.F.R. §2.33(a) and TMEP §804.04 regarding persons properly authorized to sign on behalf of applicant.

If an application is amended to add a §2(f) claim relying on other types of evidence, there may be considerable flexibility as to form. While statements by the applicant regarding advertising or sales figures or other facts that may show acquired distinctiveness would normally be presented in the form of affidavits, or declarations under 37 C.F.R. §2.20, signed by the applicant, verification may not be required for other types of evidence. The examining attorney will determine whether the evidence relied on is of a nature that requires that it be verified by the applicant.

1212.08 Section 44 Applications and Distinctiveness

In applications claiming a right of priority under §44(d), 15 U.S.C. §1126(d), or based on a foreign registration under §44(e), 15 U.S.C. §1126(e), registration may be sought under §2(f) on a showing that the mark has acquired distinctiveness in commerce that may lawfully be regulated by Congress. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). Dates of first use do not have to be stated in an application based solely on §44. However, reference to length of use or information as to specific dates of use will be important as part of the evidence presented in support of the claim of acquired distinctiveness.

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The applicant may not rely on use other than use in commerce that may be regulated by the United States Congress in establishing acquired distinctiveness. Use solely in a foreign country is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999).

1212.09 Intent-to-Use Applications and Distinctiveness

1212.09(a) Section 2(f) Claim Requires Prior Use

Section 2(f), 15 U.S.C. §1052(f), is limited by its terms to “a mark used by the applicant.” A claim of distinctiveness under §2(f) is normally not filed in a §1(b) application before the applicant files an amendment to allege use or a statement of use, because a claim of acquired distinctiveness, by definition, requires prior use.

However, an intent-to-use applicant who has used the mark on related goods or services may file a claim of acquired distinctiveness under §2(f) before filing an amendment to allege use or statement of use, if the applicant can establish that, as a result of the applicant’s use of the mark on other goods or services, the mark has become distinctive of the goods or services in the intent-to-use application, and that this previously created distinctiveness will transfer to the goods and services in the intent-to-use application when use in commerce begins. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

The Trademark Trial and Appeal Board has set forth the requirements for showing that a mark in an intent-to-use application has acquired distinctiveness:

The required showing is essentially twofold. First, applicant must establish, through the appropriate submission, the acquired distinctiveness of the same mark in connection with specified other goods and/or services in connection with which the mark is in use in commerce. All of the rules and legal precedent pertaining to such a showing in a use-based application are equally applicable in this context.... Second, applicant must establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods or services in connection with which the mark has acquired distinctiveness and the goods or services recited in the intent-to-use application to warrant the conclusion that the previously created distinctiveness will transfer to the goods or services in the application upon use.

In re Rogers, 53 USPQ2d 1741, 1744 (TTAB 1999).

To satisfy the first element, the applicant must establish acquired distinctiveness as to the other goods or services by appropriate evidence, such as ownership of a prior registration for the same mark for related goods or services (*see* TMEP §§1212.04 *et seq.*), a *prima facie* showing of acquired distinctiveness based on five years’ use of the same mark with related goods or services (*see* TMEP §§1212.05 *et seq.*), or actual

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evidence of acquired distinctiveness for the same mark with respect to the other goods or services (*see* TMEP §§1212.06 *et seq.*).

To satisfy the second element, applicant must submit evidence showing “the extent to which the goods or services in the intent-to-use application are related to the goods or services in connection with which the mark is distinctive, and that there is a strong likelihood that the mark's established trademark function will transfer to the related goods or services when use in commerce occurs.” *In re Rogers* at 1745.

The fact that a mark is famous in connection with certain goods or services does *not* necessarily lead to the conclusion that, upon use, distinctiveness will transfer to use of the mark in connection with unrelated goods or services in an intent-to-use application. In *Rogers*, the Board stated that:

The owner of a famous mark must still establish a strong likelihood of transference of the trademark function to the goods or services identified in the intent-to-use application. This factually-based determination will still involve establishing some degree of relationship between the goods or services for which the mark is famous and the goods or services in the intent-to-use application.

53 USPQ2d at 1745-1746.

An applicant whose application is based on use in commerce under 15 U.S.C. §1051(a) may also base a claim of acquired distinctiveness under §2(f) on long use of the mark on related goods or services, if the applicant meets the requirements set forth above.

1212.09(b) Claim of §2(f) “in Part” in §1(b) Application

An intent-to-use applicant may also file a claim of acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f), as to part of a mark before filing an acceptable amendment to allege use or statement of use. The claim must indicate that the applicant has already used the relevant part of the mark in commerce on or in connection with the specified goods or services or other goods or services as discussed above. *See* TMEP §1212.02(f) regarding claims of §2(f) distinctiveness “in part.”

Evidence in support of such a claim may consist of (1) ownership of a prior registration covering the relevant part of the mark and the same or related goods or services (*see* TMEP §§1212.04 *et seq.*); (2) a *prima facie* showing of distinctiveness based on five years’ use of the relevant part of the mark with the same or related goods or services (*see* TMEP §§1212.05 *et seq.*); or (3) actual evidence of acquired distinctiveness of the relevant part of the mark with respect to the same or related goods or services (*see* TMEP §§1212.06 *et seq.*). The examining attorney should consider the claim in the same manner as any other claim under §2(f).

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If the examining attorney determines that the applicant has established acquired distinctiveness as to the relevant part of the mark, the examining attorney should withdraw any refusal related to the nondistinctive character of that part of the mark.

1212.10 Printing “§2(f)” Notations

Currently, when a mark is registered under §2(f), the Office prints a “2(f)” notation in the *Official Gazette* and on the certificate of registration. However, there was a period of time in the past when the Office did not print this notation. Therefore, the absence of a “§2(f)” notation on an older registration does not necessarily mean that the mark was registered without resort to §2(f).

1213 Disclaimer of Elements in Marks

15 U.S.C. §1056. Disclaimers.

(a) The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) No disclaimer, including those made under subsection (e) of section 7 of this Act, shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.

In a trademark application or registration, a disclaimer is a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark. A disclaimer may be included in an application as filed or may be added by amendment, *e.g.*, to comply with a requirement by the examining attorney.

The purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone, without creating a false impression of the extent of the registrant's right with respect to certain elements in the mark. As stated in *Horlick's Malted Milk Co. v. Borden Co.*, 295 F. 232, 234, 1924 C.D. 197, 199 (D.C. Cir. 1924):

[T]he fact that a mark contains descriptive words is not enough to warrant a refusal to register it. Unless it consists only of such words, it may not be refused a place on the registry of the Patent Office.

The significance of a disclaimer is conveyed in the following statement:

As used in trade mark registrations, a disclaimer of a component of a composite mark amounts merely to a statement that, in so far as that particular registration is concerned, no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the

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composite; and the particular registration represents only such rights as flow from the use of the composite mark.

Sprague Electric Co. v. Erie Resistor Corp., 101 USPQ 486, 486-87 (Comm'r Pats. 1954).

A disclaimer may be limited to pertain to only certain classes, or to only certain goods or services.

1213.01 History of Disclaimer Practice

There was no statutory authority for disclaimer prior to 1946. As various court decisions were rendered, Office practice fluctuated from, first, registering the composite mark without a qualifying statement; later, requiring a statement in the application disclaiming the unregistrable matter in the mark; and, finally, requiring removal of the unregistrable matter from the mark on the drawing. This fluctuation ended with the decision of *Estate of P.D. Beckwith v. Comm'r of Pats.*, 252 U.S. 538, 1920 C.D. 471 (1920), in which the United States Supreme Court held that to require the removal of descriptive matter from a composite mark was erroneous, and commended the practice of a statement of disclaimer. Thus the practice of disclaimer was established officially in the Office, although still without statutory support.

The Trademark Act of 1946 created a statutory basis for the practice of disclaimer in §6, 15 U.S.C. §1056.

1213.01(a) Discretion in Requiring Disclaimer

When first incorporated in the Trademark Act in 1946, §6 stated that the Director *shall* require unregistrable matter to be disclaimed. Under the impetus of the mandatory word “shall,” it became customary to require a disclaimer for every occurrence, in any type of combination, of every term or symbol which by itself might be refused registration in the first instance under the 1946 Act.

In 1962, §6 was amended to state that the Director *may* require the applicant to disclaim an unregistrable component of a mark otherwise registrable. The change from “shall” to “may” justifies the exercise of greater discretion by examining attorneys in determining whether a disclaimer is necessary.

Examining attorneys should keep in mind the basic purpose of disclaimers, which is to make of record that a significant element of a composite mark is not being appropriated apart from the composite. The examining attorney should not require that an element of a mark be disclaimed when a disclaimer would be unnecessary, *e.g.*, when the form or degree of integration of an element in the composite makes it obvious that no claim is being made in any element apart from the composite.

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1213.01(b) Refusal to Register Because of Failure to Disclaim

Failure to comply with a requirement to disclaim was held to be a basis for refusal to register before the Act of 1946. *See In re American Cyanamid & Chemical Corp.*, 99 F.2d 964, 39 USPQ 445 (C.C.P.A. 1938). Failure to comply with a requirement to disclaim also was held to justify a refusal after the 1946 Act. *See In re Hercules Fasteners, Inc.*, 203 F.2d 753, 97 USPQ 355 (C.C.P.A. 1953); *Ex parte Knomark Mfg. Co., Inc.*, 118 USPQ 182 (PO Ex. Ch. 1958). Even after amendment of the pertinent language of §6 of the 1946 Act to the discretionary wording “may require the applicant to disclaim,” registration may be refused if an applicant does not comply with a requirement for a disclaimer made by the examining attorney. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (C.C.P.A. 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

If an applicant fails to comply with the examining attorney’s requirement for a disclaimer, the examining attorney should make the requirement final if the application is otherwise in condition for a final action.

1213.01(c) Voluntary Disclaimer of Registrable or Unregistrable Matter

Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), was amended in 1962 to add the sentence, “An applicant may voluntarily disclaim a component of a mark sought to be registered.” Disclaimers volunteered by applicants generally should conform to the guidelines set forth in this Manual. *See* TMEP §§1213.08 *et seq.*

In *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm’r Pats. 1991), the Commissioner held that §6 of the Act permits an applicant to disclaim matter voluntarily, regardless of whether the matter is registrable or unregistrable. The Commissioner specifically overruled all previous Office authority holding otherwise. (Previous practice prohibited the entry of disclaimers of registrable components of marks.) Therefore, if an applicant offers a disclaimer of any matter in a mark, the Office will accept the disclaimer.

The *MCI* decision states emphatically that the entry of a voluntary disclaimer does *not* render registrable a mark that is otherwise unregistrable under relevant sections of the Trademark Act, such as §2(d) and §2(e). The examining attorney must evaluate the entire mark, including any disclaimed matter, to determine registrability. Furthermore, the decision notes that the applicant may not disclaim the entire mark. *See* TMEP §1213.06.

An applicant may volunteer a disclaimer in the mistaken belief that a disclaimer would be required when, in fact, Office policy would not require a disclaimer. If this appears to be the case, the examining attorney should offer the applicant the opportunity to withdraw the disclaimer.

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1213.02 “Composite” Marks

A “composite” mark may consist of a word or words combined with a design or designs; it may consist solely of words, when there are separable word elements; or it may consist solely of separable design elements. An unregistrable component of a composite mark is subject to disclaimer. However, if a composite mark (or portion thereof) is “unitary,” an individual component of the mark (or of the unitary portion) that would otherwise be unregistrable need not be disclaimed. *See* TMEP §§1213.05 *et seq.*

The same principles apply to disclaimer of an unregistrable component of a mark, whether the mark is a combination of wording and designs or consists entirely of wording or entirely of designs.

1213.03 Disclaimer of Unregistrable Components of Marks

1213.03(a) “Unregistrable Components” in General

Estate of P.D. Beckwith v. Comm’r of Pats., 252 U.S. 538, 1920 C.D. 471 (1920), and other disclaimer decisions before the Trademark Act of 1946 dealt with disclaiming descriptive or generic matter. Section 6 of the Act referred initially to “unregistrable matter” and, since the 1962 amendment, now refers to “an unregistrable component.”

Typically an unregistrable component of a registrable mark is the name of the goods or services, other matter that does not indicate source, or matter that is merely descriptive or deceptively misdescriptive of the goods or services, or primarily geographically descriptive of them.

Office practice does not require disclaimer of a surname. *Ex parte Norquist Products, Inc.*, 109 USPQ 399 (Comm’r Pats. 1956) (disclaimer of “NORQUIST” found unnecessary in application to register mark comprising “NORQUIST CORONET” on an oval background featuring a coronet, for tables and chairs). In that decision, the Commissioner stated as follows:

Section [2(e)(4)] of the statute does not contemplate the dissection of a composite mark to determine whether a word which constitutes an integral part of the mark is primarily merely a surname. Rather, it contemplates an examination of the mark in its entirety and an evaluation of the commercial impression created by the entire mark. A word which is primarily merely a surname may lose that significance when it appears in a distinctive composite.

Norquist, at 400. The addition of other registrable matter creates a composite mark with an overall impression that is not primarily merely that of a surname. If the additional matter is minimal or unregistrable, then the mark is primarily merely a surname and refusal under §2(e)(4) of the Act, 15 U.S.C. §1052(e)(4) (formerly §2(e)(3), 15 U.S.C. §1052(e)(3)), should be made. *See In re E. Martinoni Co.*,

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189 USPQ 589 (TTAB 1975). *See* TMEP §§1211.01(b) *et seq.* regarding the combination of a surname with additional matter.

In cases where registration of a mark is barred under the Trademark Act (*e.g.*, under §§2(a), 2(b), 2(c), 2(d) and 2(e)(3)), a disclaimer of an unregistrable component will not render the mark registrable. *See, e.g., American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTAB 1984) (“While the disclaimer is appropriate to indicate that respondent claims no proprietary right in the disclaimed words, the disclaimer does not affect the question of whether the disclaimed matter deceives the public, since one cannot avoid the Section 2(a) deceptiveness prohibition by disclaiming deceptive matter apart from the mark as a whole.”). *See* TMEP §1213.10 concerning disclaimers with regard to likelihood of confusion, and TMEP §1210.08 regarding disclaimer of geographic terms in composite marks.

1213.03(b) Generic Matter and Matter Which Does Not Function as a Mark

If a mark is comprised in part of matter that, as applied to the goods and services, is generic or does not function as a mark, the matter must be disclaimed to permit registration on the Principal Register (including registration under §2(f) of the Act) or on the Supplemental Register. If, however, matter that would otherwise be generic or would not function as a mark is part of a unitary mark or part of a separable unitary element of a mark, the examining attorney should not require a disclaimer of the matter. *See* TMEP §1213.05.

See TMEP §1212.02(e) regarding disclaimers of unregistrable components in applications to register marks on the Principal Register under §2(f). *See also In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766, 768 (TTAB 1986) (“[I]t is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f).”).

Regarding disclaimers of unregistrable components in applications to register marks on the Supplemental Register, *see In re Water Gremlin Co.*, 635 F.2d 841, 845 n.6, 208 USPQ 89, 91 n.6 (C.C.P.A. 1980) (“Section 6 is equally applicable to the Supplemental Register.”); *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977) (mark comprising stylized lettering of BALSAM, with disclaimer of “BALSAM,” found registrable on Supplemental Register for hair conditioner and hair shampoo); *In re Carolyn’s Candies, Inc.*, 206 USPQ 356, 360 (TTAB 1980) (“Section 6 of the Trademark Act of 1946, which provides for the disclaimer of ‘unregistrable matter’, does not limit the disclaimer practice to marks upon the Principal Register.”).

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1213.03(c) Pictorial Representations of Descriptive Matter

An accurate pictorial representation of descriptive matter is equivalent to the written expression and, therefore, must be disclaimed pursuant to the same rules applicable to merely descriptive wording. *See Thistle Class Association v. Douglass & McLeod, Inc.*, 198 USPQ 504 (TTAB 1978) (thistle design found synonymous to the word “thistle,” which is used in a descriptive sense to designate a class of sailboats).

No disclaimer of highly stylized pictorial representations of descriptive matter should be required because the design element creates a distinct commercial impression. *See In re LRC Products Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984) (outline of two gloved hands held arbitrary and fanciful), and cases cited therein.

1213.03(d) Entity Designations

Words or abbreviations in a trade name designating the legal character of an entity (*e.g.*, Corporation, Corp., Co., Inc., Ltd., etc.) must be disclaimed because an entity designation has no source-indicating capacity. *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1215 (TTAB 2000) (“PRESS,” as applied to a printing or publishing establishment, “is in the nature of a generic entity designation which is incapable of serving a source-indicating function”); *In re The Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) (“PAINT PRODUCTS CO.” is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a company”); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984) (“the element ‘INC.’ [in PACKAGING SPECIALISTS, INC.] being recognized, in trademark evaluation, to have no source indication or distinguishing capacity”).

The only exception to this practice is where the entity designation is used in an arbitrary manner (*e.g.*, “THE LTD.” or “KIDS INC.” for clothing). In this case the term has trademark significance and a disclaimer should not be required.

1213.04 Trade Names

Unregistrable components of trade names or company names shall be disclaimed pursuant to the same rules that apply generally to trademarks. *See In re Martin’s Famous Pastry Shoppe, Inc.*, 221 USPQ 364 (TTAB 1984), *aff’d on other grounds*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

1213.05 “Unitary” Marks

A mark or portion of a mark is considered “unitary” when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements. If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic or otherwise, is required.

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For example, a descriptive word can be combined with nondescriptive wording in such a way that the descriptive significance of the word in relation to the goods is lost and the combination functions as a unit. This happens when the combination itself has a new meaning. An example is the term “Black Magic,” which has a distinct meaning of its own as a whole. The word “black” is not intended to have color significance in relation to the goods, and should not be disclaimed even if the mark is applied to goods that are black in color.

In the following cases, marks were considered unitary: *B. Kuppenheimer & Co., Inc. v. Kayser-Roth Corp.*, 326 F.2d 820, 822, 140 USPQ 262, 263 (C.C.P.A. 1964) (KUPPENHEIMER and SUP-PANTS combined so that they shared the double “P,” making “an indivisible symbol rather than two divisible words”); *In re Hampshire-Designers, Inc.*, 199 USPQ 383 (TTAB 1978) (DESIGNERS PLUS+ for sweaters held unitary; thus, no disclaimer of “DESIGNERS” deemed necessary); *In re J.R. Carlson Laboratories, Inc.*, 183 USPQ 509 (TTAB 1974) (E GEM for bath oil containing vitamin E held unitary; thus, no disclaimer of “E”).

But see the following cases, where marks were found *not* to be unitary: *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991) (EUROPEAN FORMULA above a circular design on a dark square or background considered not unitary); *In re Lean Line, Inc.*, 229 USPQ 781 (TTAB 1986) (LEAN LINE for low calorie foods considered not unitary; requirement for disclaimer of “LEAN” held proper); *In re IBP, Inc.*, 228 USPQ 303 (TTAB 1985) (IBP SELECT TRIM for pork considered not unitary; refusal of registration in the absence of a disclaimer of “SELECT TRIM” affirmed); *In re Uniroyal, Inc.*, 215 USPQ 716 (TTAB 1982) (UNIROYAL STEEL/GLAS for vehicle tires considered not unitary; requirement for disclaimer of “STEEL/GLAS” deemed appropriate); *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981) (PHACTS POCKET PROFILE, for personal medication history summary and record forms, considered not unitary; refusal to register in the absence of a disclaimer of “POCKET PROFILE” affirmed. “A disclaimer of a descriptive portion of a composite mark is unnecessary only where the form or degree of integration of that element in the composite makes it obvious that no claim other than of the composite would be involved. That is, if the elements are so merged together that they cannot be regarded as separable elements, the mark is a single unitary mark and not a composite mark and no disclaimer is necessary.”); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977) (PRESTO BURGER for electrical cooking utensils not unitary; requirement for disclaimer of “BURGER” affirmed).

The examining attorney must exercise discretion in determining whether a mark or portion of a mark is unitary, in which case a disclaimer of a nondistinctive component should not be required. It is not always easy to articulate why matter is unitary. However, if one cannot spell out exactly why a mark is unitary, then the mark is probably not unitary and nondistinctive elements within the mark must be disclaimed. In general, a mark is unitary if the whole is something more than the sum of its parts.

See TMEP §§1213.05(a) through (f) for examples of different types of unitary marks.

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1213.05(a) Compound Word Marks

A compound word mark is comprised of two or more distinct words or words and syllables that are represented as one word (*e.g.*, BOOKCHOICE, PROSHOT, MAXIMACHINE, PULSAIR). Often, in compound word marks, the words or syllables are distinguished or highlighted by capitalizing the first letter of each (*e.g.*, TimeMaster) or by presenting them in differing color, script or size (*e.g.*, RIBtype).

A compound word mark that is appropriately represented by a typed drawing may be presented as one unitary term (*e.g.*, BOOKCHOICE) or as separate words (BOOK CHOICE). The examining attorney should determine whether the mark may be presented as separate words. *See* TMEP §807.08 regarding drawings for compound word marks.

All compound word marks, as defined above, are considered unitary, and a disclaimer of a component will not be required *unless* the mark is appropriately presented in the application in a typed drawing as two or more separate words. A compound word mark that is appropriately presented in a typed drawing as two or more separate words is not considered unitary per se and a disclaimer of unregistrable components may be required.

1213.05(a)(i) Telescoped Words

A telescoped mark is one that comprises two or more words that share letters (*e.g.*, HAMERICAN, ORDERRECORDER, SUPERINSE, VITAMINSURANCE, POLLENERGY). *See* TMEP §807.08 regarding drawings for telescoped marks.

A telescoped word is considered unitary. Therefore, no disclaimer of an individual portion of a telescoped word is required, regardless of whether the mark is shown in a typed or special-form drawing.

However, if a telescoped word is itself unregistrable, a disclaimer of the telescoped word may be required. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (affirming refusal to register FIRSTIER and design for banking services in the absence of a disclaimer of “FIRST TIER,” in view of evidence that the term describes a class of banks). *See* TMEP §1213.08(c) regarding disclaimers of misspelled words in general.

1213.05(a)(ii) Compound Words Formed with Hyphen or Other Punctuation

When a compound word is formed by hyphenating two words or terms, one of which would be unregistrable alone, no disclaimer is necessary. *“X” Laboratories, Inc. v. Odorite Sanitation Service of Baltimore, Inc.*, 106 USPQ 327, 329 (Comm’r Pats. 1955) (requirement for a disclaimer of “TIRE” deemed unnecessary in application to register TIRE-X for a tire cleaner).

Word marks consisting of two terms joined by an asterisk (*e.g.*, RIB*TYPE), a slash (*e.g.*, RIB/TYPE) or a raised period (*e.g.*, RIB°TYPE) are analogous to hyphenated

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words. Therefore no disclaimer of portions of marks formed by asterisks, slashes or raised periods is necessary. (While hyphens, asterisks and slashes may be used in typed drawings, raised periods may not. Therefore, a mark comprised in part of a raised period must be represented by a special-form drawing to depict the raised period. However, if otherwise appropriate, the mark may be represented in a typed drawing by substituting a hyphen for the raised period. *See* TMEP §§807.06 *et seq.* regarding typed drawings.)

1213.05(b) Slogans

A registrable slogan is one that is used in a trademark sense. A registrable slogan is considered unitary and should not be broken up for purposes of requiring a disclaimer.

If an unregistrable slogan is a component of a registrable mark, then the examining attorney should require that the slogan be disclaimed.

If a mark consists entirely of a slogan that is merely descriptive or that is not being used as a mark, then registration should be refused. *See In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA'S FRESHEST ICE CREAM for flavored ices, etc., held incapable of distinguishing applicant's goods and unregistrable on the Supplemental Register); *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984) (WHY PAY MORE! held to be an unregistrable common commercial phrase).

1213.05(c) “Double Entendre”

A “double entendre” is a word or expression capable of more than one interpretation. For trademark purposes, a “double entendre” is an expression that has a double connotation or significance *as applied to the goods or services*. The mark that comprises the “double entendre” will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.

A true “double entendre” is unitary by definition. An expression that is a “double entendre” should not be broken up for purposes of requiring a disclaimer. *See In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983), where the Board found inappropriate a requirement for a disclaimer of “LIGHT” apart from the mark “LIGHT N' LIVELY” for reduced calorie mayonnaise, stating as follows:

The mark “LIGHT N' LIVELY” as a whole has a suggestive significance which is distinctly different from the merely descriptive significance of the term “LIGHT” per se. That is, the merely descriptive significance of the term “LIGHT” is lost in the mark as a whole. Moreover, the expression as a whole has an alliterative lilting cadence which encourages persons encountering it to perceive it as a whole.

See also In re Symbra'ette, Inc., 189 USPQ 448 (TTAB 1975) (SHEER ELEGANCE for panty hose held to be a registrable unitary expression; thus, no disclaimer of “SHEER” considered necessary).

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The following cases illustrate situations where marks were considered to be “double entendres” and, therefore, registrable unitary marks: *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE for bakery products); *In re Simmons Co.*, 189 USPQ 352 (TTAB 1976) (THE HARD LINE for mattresses and bed springs); *In re Delaware Punch Co.*, 186 USPQ 63 (TTAB 1975) (THE SOFT PUNCH for noncarbonated soft drink); *In re National Tea Co.*, 144 USPQ 286 (TTAB 1965) (NO BONES ABOUT IT for fresh pre-cooked ham).

The multiple interpretations that make an expression a “double entendre” must be associations that the public would make fairly readily. *See In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (EXPRESSERVICE held merely descriptive for banking services, despite applicant’s argument that the term also connotes the Pony Express, the Board finding that, in the relevant context, the public would not make that association).

If all meanings of a “double entendre” are merely descriptive in relation to the goods, then the mark comprising the “double entendre” should be refused registration as merely descriptive.

1213.05(d) Incongruity

If two or more terms are combined in a mark to create an incongruity (*e.g.*, URBAN SAFARI, MR. MICROWAVE, DR. GRAMMAR), the mark is unitary and no disclaimer of nondistinctive individual elements is necessary.

1213.05(e) Sound Patterns

At times a mark will form a unitary whole through a rhyming pattern, use of alliteration or some other use of sound that creates a distinctive impression. In such a case, the mark is regarded as unitary and individual elements should not be disclaimed. *See In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983) (LIGHT N’ LIVELY found to be a unitary term not subject to disclaimer). *Compare In re Lean Line, Inc.*, 229 USPQ 781, 782 (TTAB 1986) (LEAN LINE not considered unitary; “there is nothing in the record to suggest that the mere fact that both words which form the mark begin with the letter ‘L’ would cause purchasers to miss the merely descriptive significance of the term ‘LEAN’ or consider the entire mark to be a unitary expression.”)

1213.05(f) Display of Mark

The visual presentation of a mark may be such that the words and/or designs form a unitary whole. In such a case, disclaimer of individual nondistinctive elements is unnecessary. *See, e.g., In re Texsun Tire and Battery Stores, Inc.*, 229 USPQ 227, 229 (TTAB 1986) (“[T]he portion of the outline of the map of Texas encircled as it is with the representation of a tire and surrounded by a rectangular border results in a unitary composite mark which is unique and fanciful.”).

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1213.06 Entire Mark May Not Be Disclaimed

An entire mark may not be disclaimed. If a mark is not registrable as a whole, a disclaimer will not make it registrable. There must be something in the combination of elements in the mark, or something of sufficient substance or distinctiveness over and above the matter being disclaimed, which would make the composite registrable after the import of the disclaimer is taken into account. *See In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984); *Ex parte Ste. Pierre Smirnoff Fls, Inc.*, 102 USPQ 415 (Comm'r Pats. 1954).

In Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991), the Court of Appeals for the Federal Circuit stated as follows:

[U]nder traditional disclaimer practice, an applicant could not disclaim all elements of a composite mark. Section 1056(a) codified this policy. A mark which must be entirely disclaimed has no 'unregistrable component,' but is instead entirely nonregistrable. In other words, a mark which must be entirely disclaimed has no 'otherwise registrable' parts. Therefore, such marks do not qualify as composite marks for which the Commissioner may require a disclaimer.

1213.07 Removal Rather than Disclaimer

When it is not clear that matter forms part of a mark, the examining attorney must consider whether it is appropriate for the applicant to amend the drawing of the mark to remove the matter, rather than to disclaim it. *See* TMEP §807.15 regarding deletion of matter from the mark on a drawing. An applicant may not amend the drawing if the amendment would constitute a material alteration of the mark. 37 C.F.R. §2.72; TMEP §807.14(a).

There are circumstances under which the applicant may remove matter from the mark shown in the drawing, or may elect not to include certain matter on the drawing in the application as filed, if the overall commercial impression is not altered. *See Institut National Des Appellations D'Origine v. Vintners International Co. Inc.*, 958 F.2d 1574, 1582, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992); *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (C.C.P.A. 1950). However, matter may not be omitted from the drawing if the omission would result in an incomplete representation of the mark, sometimes referred to as "mutilation." *See* TMEP §807.14(b). In other words, the matter presented for registration must convey a single distinct commercial impression. If a mark is not unitary in this sense, it cannot be registered. *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991).

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1213.08 Form of Disclaimers

1213.08(a) Wording of Disclaimer

1213.08(a)(i) Standardized Printing Format for Disclaimer

Since November 9, 1982, disclaimers for marks published for opposition and those registered on the Supplemental Register are printed in a standardized form in the *Official Gazette*, regardless of the text submitted. Disclaimers are in the standardized format in certificates of registration on the Supplemental Register issued as of that date. Disclaimers are in the standardized format in certificates of registration on the Principal Register issued as of February 1, 1983. The disclaimed matter is taken from the disclaimer of record and inserted into the standardized disclaimer format for printing and data base purposes. The standardized disclaimer text is as follows:

No claim is made to the exclusive right to use _____, apart from the mark as shown.

See notice at 1022 TMOG 44 (September 28, 1982). *See also In re Owatonna Tool Co.*, 231 USPQ 493, 495 (Comm'r Pats. 1983) (“[T]he use of the standardized form is solely for the purpose of printing and data base purposes, not for the limitation of registrant’s rights.”).

For the record only, examining attorneys continue the past practice of accepting disclaimers with additional statements pertaining to reservation of common law rights, although §6 of the Trademark Act of 1946 states that no disclaimer shall prejudice or affect the applicant’s or registrant’s rights then existing or thereafter arising in the disclaimed matter. Disclaimers with these additional statements can be entered by examiner’s amendment. The examining attorney must inform the applicant or attorney who authorizes the amendment that the disclaimer will be printed in the standardized format.

1213.08(a)(ii) Unacceptable Wording for Disclaimer

Wording that claims matter, rather than disclaims it, is not acceptable. A disclaimer should be no more than a statement that identifies matter to which the applicant may not have exclusive rights apart from what is shown on the drawing.

Therefore, statements that the applicant “claims” certain matter in the association shown are not acceptable. The examining attorney should require correction of this wording and of variations that amount to the same thing. Likewise, a statement that the mark is “not claimed except in the association shown,” or similar wording, is not acceptable, and the examining attorney should require correction. *See Textron Inc. v. Pilling Chain Co., Inc.*, 175 USPQ 621, 622 (TTAB 1972), concerning an application which included the statement, “The mark is not to be claimed except in the setting presented.” The Board found this wording unacceptable, noting, “The alleged disclaimer filed by applicant is in such vague terms that it actually disclaims nothing.” *Id.*

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1213.08(b) Disclaimer of Unregistrable Matter in Its Entirety

Unregistrable matter must be disclaimed in its entirety. For example, when requiring a disclaimer of terms which form a grammatically or otherwise unitary expression (e.g., “SHOE FACTORY, INC.”), the examining attorney must require that they be disclaimed in their entirety. *See, e.g., In re Wanstrath*, 7 USPQ2d 1412, 1413 (Comm’r Pats. 1987) (denying petitioner’s request to substitute separate disclaimers of “GLASS” and “TECHNOLOGY” for the disclaimer of “GLASS TECHNOLOGY” in its registration of GT GLASS TECHNOLOGY in stylized form, the Commissioner finding “GLASS TECHNOLOGY” to be a unitary expression and noting, “Disclaimers of individual components of complete descriptive phrases are improper.”); *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 804 n.3 (TTAB 1984) (“CERTIFIED HEARING AID AUDIOLOGIST” found to be “a unitary expression that should be disclaimed in its entirety”); *In re Surelock Mfg. Co., Inc.*, 125 USPQ 23, 24 (TTAB 1960) (proposed disclaimer of “THE” and “RED” and “CUP” held unacceptable to comply with requirement for disclaimer of “THE RED CUP,” the Board concluding, “A disclaimer of the individual components of the term ‘THE RED CUP,’ under the circumstances, is meaningless and improper.”).

This standard should be construed strictly; therefore, disclaimer of individual words separately will usually be appropriate only when the words being disclaimed are separated by registrable wording.

1213.08(c) Disclaimer of Misspelled Words

Marks often comprise words that may be characterized as “misspelled.” For example, marks may comprise terms that are “telescoped” (*see* TMEP §1213.05(a)(i)) or terms that are phonetic equivalents of particular words but spelled in a manner that varies from the ordinary spelling of such words.

If a mark comprises a word or words that are misspelled but nonetheless must be disclaimed, the examining attorney should require disclaimer of the word or words in the correct spelling. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Newport Fastener Co. Inc.*, 5 USPQ2d 1064, 1067 n. 4 (TTAB 1987). The entry of a disclaimer does not necessarily render registrable a mark that is otherwise unregistrable.

If the examining attorney has not required any disclaimer of misspelled wording because a disclaimer is not necessary under Office policy, the applicant may provide a disclaimer of the wording as spelled in the mark or in its correct spelling voluntarily. In such a case, the examining attorney should accept the disclaimer. Again, the disclaimer does not necessarily render an otherwise unregistrable mark registrable. The examining attorney must consider the entire mark, including the disclaimed matter, to determine whether the entire mark is registrable.

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1213.08(d) Disclaimer of Non-English Words

Non-English wording that comprises an unregistrable component of a mark is subject to disclaimer. *See Bausch & Lomb Optical Co. v. Overseas Finance & Trading Co. Inc.*, 112 USPQ 6, 8 (Comm'r Pats. 1956) (noting that “Kogaku,” the transliteration of the Japanese word for “optical,” was properly disclaimed).

If non-English wording that is translated must be disclaimed, the actual non-English wording should be disclaimed, not the English translation. The applicant must disclaim the wording that actually appears in the mark, not the translated version.

See TMEP §§809 *et seq.* regarding translation of non-English wording in marks.

1213.09 Mark of Another May Not Be Registered with Disclaimer

Normally, a mark that includes a mark registered by another person must be refused registration under 15 U.S.C. §1052(d) based on likelihood of confusion. A refusal of registration under §2(d) may not be avoided by disclaiming the mark of another. *Cf. In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662 (C.C.P.A. 1979) (permitting disclaimer of informational phrase indicating that applicant’s employees are represented by certain labor organizations). *See* TMEP §1213.10 regarding disclaimer in relation to likelihood of confusion.

1213.10 Disclaimer in Relation to Likelihood of Confusion

A disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1538-39 (Comm’r Pats. 1991).

Typically, disclaimed matter will not be regarded as the dominant, or most significant, feature of a mark. However, since the Trademark Act permits an applicant to voluntarily disclaim registrable matter (*see* TMEP §1213.01(c)), disclaimed matter may be dominant or significant in some cases. As noted in *In re MCI Communications Corp.*, 21 USPQ2d at 1539, “Examining Attorneys will continue to consider the question of likelihood of confusion, under Section 2(d) of the statute, in relation to the marks as a whole, including any voluntarily disclaimed matter.”

1213.11 Acquiring Rights in Disclaimed Matter

In *Estate of P.D. Beckwith v. Comm’r of Pats.*, 252 U.S. 538, 545, 1920 C.D. 471, 477 (1920), the United States Supreme Court stated, regarding registration of a mark

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with a disclaimer, that “the registrant would be precluded by his disclaimer from setting up in the future any exclusive right to the disclaimed part of it.” Subsequently, that principle was applied literally; registrants were prohibited from asserting in an application that disclaimed matter had acquired secondary meaning. *See Shaler Co. v. Rite-Way Products, Inc.*, 43 USPQ 425 (6th Cir. 1939).

The situation was changed by the Trademark Act of 1946, which provided that “disclaimer shall not prejudice or affect the applicant’s or owner’s rights then existing or thereafter arising in the disclaimed matter, nor shall such disclaimer prejudice or affect the applicant’s or owner’s rights of registration on another application of later date if the disclaimed matter has become distinctive of the applicant’s or owner’s goods or services.” In 1962, the statutory provision was amended to read, “No disclaimer ... shall prejudice or affect the applicant’s or registrant’s rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.” 15 U.S.C. §1056(b).

It is now clear that, aside from generic matter, disclaimed matter is not forever barred from registration, and it can subsequently be considered for registration on either the Principal Register or the Supplemental Register. When an application is filed seeking registration of matter previously disclaimed, it should be examined in the same manner as other applications. *See Quaker Oil Corp. v. Quaker State Oil Refining Corp.*, 161 USPQ 547 (TTAB 1969), *aff’d*, 453 F.2d 1296, 172 USPQ 361 (C.C.P.A. 1972); *Victor Tool & Machine Corp. v. Sun Control Awnings, Inc.*, 299 F. Supp. 868, 162 USPQ 389 (E.D. Mich. 1968), *aff’d*, 411 F.2d 792, 162 USPQ 387 (6th Cir. 1969).

Whether or not previously disclaimed matter has become eligible for registration depends on the circumstances and the evidence adduced in the examination process. *Helena Rubinstein, Inc. v. Ladd*, 219 F. Supp. 259, 138 USPQ 106 (D.D.C. 1963), *aff’d*, 141 USPQ 623 (D.C. Cir. 1964); *Roux Distributing Co., Inc. v. Duart Mfg. Co. Ltd.*, 114 USPQ 511 (Comm’r Pats. 1957).

1214 “Phantom” Elements in Marks

In some applications, the applicant seeks to register a “phantom” element (*i.e.*, a word, alpha-numeric designation, or other component that is subject to change) as part of a mark. The applicant represents the changeable or “phantom” element by inserting a blank, or by using dots, dashes, underlining, or a designation such as “XXXX.”

Examples include marks incorporating a date (usually a year), a geographic location, or a model number that is subject to change. While these are some of the most common examples of the types of elements involved, there are many variations.

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1214.01 Single Application May Seek Registration of Only One Mark

Where an applicant seeks registration of a mark with a changeable or “phantom” element, the examining attorney should refuse registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the application seeks registration of more than one mark. *See In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres Inc.*, 56 USPQ2d 1538 (TTAB 2000).

In *International Flavors*, the applicant filed three applications to register the designations “LIVING xxxx,” “LIVING xxxx FLAVOR,” and “LIVING xxxx FLAVORS,” for essential oils, flavor substances, and fragrances. Each application included a statement that “[t]he meaning of ‘xxxx’ is for a specific herb, fruit, plant or vegetable.” In upholding the refusal of registration, the Federal Circuit noted that under §22 of the Trademark Act, 15 U.S.C. §1072, registration serves as constructive notice to the public of the registrant’s ownership of the mark and therefore precludes another user from claiming innocent misappropriation as a trademark infringement defense. To make this constructive notice meaningful, the mark as registered must accurately reflect the mark that is used in commerce, so that someone who searches the register for a similar mark will locate the registration. The court stated that “phantom marks” with missing elements “encompass too many combinations and permutations to make a thorough and effective search possible” and, therefore, the registration of these marks does not provide adequate notice to competitors and the public. *International Flavors*, 51 USPQ2d at 1517-18. *Cf. In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001) (hologram used on trading cards in varying shapes, sizes, contents and positions constitutes more than one “device” as contemplated by §45 of the Trademark Act).

See also TMEP §807.03 regarding the requirement that an application be limited to one mark.

1214.02 Agreement of Mark on Drawing With Mark on Specimens or Foreign Registration

Where an applicant seeks registration of a “phantom mark,” the examining attorney should also consider whether the mark on the drawing is a substantially exact representation of the mark as used on the specimens in a use-based application, or the mark in the home country registration in an application based on Trademark Act §44, 15 U.S.C. §1126. *See* TMEP §§807.14 and 807.14(b).

The applicant may amend the mark to overcome a refusal on the ground that the mark on the drawing does not agree with the mark as used on the specimens, or with the mark in the foreign registration, if the amendment is not a material alteration of the mark. *See* TMEP §807.14(a) regarding material alteration.

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1214.03 “Phantom Marks” in Intent-to-Use Applications

In an intent-to-use application for which no allegation of use has been filed, it may be unclear whether the applicant is seeking registration of a mark with a changeable element. If an intent-to-use application indicates that the applicant is seeking registration of a “phantom mark” (*e.g.*, if the application includes a statement that “the blank line represents a date that is subject to change”), the examining attorney should issue a refusal of registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the application seeks registration of more than one mark, as discussed above. If it is unclear whether an applicant is seeking registration of a “phantom” mark, the examining attorney should advise the applicant that if the specimens filed with an amendment to allege use under §1(c) of the Trademark Act, 15 U.S.C. §1051(c), or a statement of use under §1(d) of the Act, 15 U.S.C. §1051(d), show that applicant is seeking registration of a mark with a changeable element, registration will be refused on the ground that the application seeks registration of more than a single mark. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided before the applicant files an allegation of use, the Office is not precluded from refusing registration on this basis.

1215 Marks Composed, in Whole or in Part, of Domain Names

Since the implementation of the Internet domain name system, the Office has received a growing number of applications for marks composed of domain names. Although the majority of these applications are for computer services such as Internet content providers (organizations that provide web sites with information about a particular topic or field) and online ordering services, a substantial number are for marks used on other types of services or goods.

1215.01 Background

A domain name is part of a Uniform Resource Locator (URL), which is the address of a site or document on the Internet. In general, a domain name is comprised of a second-level domain, a “dot,” and a top-level domain (TLD). The wording to the left of the “dot” is the second-level domain, and the wording to the right of the “dot” is the TLD.

Example: If the domain name is “ABC.com,” the term “ABC” is a second-level domain and the term “com” is a TLD.

A domain name is usually preceded in a URL by “http://www.” The “http://” refers to the protocol used to transfer information, and the “www” refers to World Wide Web, a graphical hypermedia interface for viewing and exchanging information.

Generic TLDs. The following are examples of generic TLDs that are designated for use by the public:

.com commercial, for-profit organizations

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.edu	4-year, degree-granting colleges/universities
.gov	U.S. federal government agencies
.int	international organizations
.mil	U.S. military organizations, even if located outside the U.S.
.net	network infrastructure machines and organizations
.org	miscellaneous, usually non-profit organizations and individuals

Each of the above TLDs is intended for use by a certain type of organization. For example, the TLD “.com” is for use by commercial, for-profit organizations. However, the administrator of the .com, .net, .org and .edu TLDs does not check the requests of parties seeking domain names to ensure that such parties are a type of organization that should be using those TLDs. On the other hand, .mil, .gov, and .int TLD applications are checked, and only the U.S. military, the U.S. government, or international organizations are allowed in the respective domain space.

Country Code TLDs. Country code TLDs are for use by each individual country. For example, the TLD “.ca” is for use by Canada, and the TLD “.jp” is for use by Japan. Each country determines who may use their code. For example, some countries require that users of their code be citizens or have some association with the country, while other countries do not.

1215.02 Use as a Mark

When a trademark, service mark, collective mark or certification mark is composed, in whole or in part, of a domain name, neither the beginning of the URL (“http://www.”) nor the TLD have any source-indicating significance. Instead, those designations are merely devices that every Internet site provider must use as part of its address. Today, advertisements for all types of products and services routinely include a URL for the web site of the advertiser, and the average person familiar with the Internet recognizes the format for a domain name and understands that “http,” “www,” and a TLD are a part of every URL.

1215.02(a) Use Applications

A mark composed of a domain name is registrable as a trademark or service mark only if it functions as a source identifier. The mark as depicted on the specimens must be presented in a manner that will be perceived by potential purchasers to indicate source and not as merely an informational indication of the domain name address used to access a web site. *See In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998).

In *Eilberg*, the Trademark Trial and Appeal Board (Board) held that a term that only serves to identify the applicant’s domain name or the location on the Internet where the applicant’s web site appears, and does not separately identify applicant’s services, does not function as a service mark. The applicant’s proposed mark was WWW.EILBERG.COM, and the specimens showed that the mark was used on letterhead and business cards in the following manner:

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PATENTS, TRADEMARKS
AND COPYRIGHTS

WWW.EILBERG.COM

(The specimen submitted was the business card of William H. Eilberg, Attorney at Law, 820 Homestead Road, P.O. Box 7, Jenkintown, Pennsylvania 19046, 215-855-4600, email whe@eilberg.com.)

The Board affirmed the examining attorney's refusal of registration on the ground that the matter presented for registration did not function as a mark, stating that:

[T]he asserted mark, as displayed on applicant's letterhead, does not function as a service mark identifying and distinguishing applicant's legal services and, as presented, is not capable of doing so. As shown, the asserted mark identifies applicant's Internet domain name, by use of which one can access applicant's Web site. In other words, the asserted mark WWW.EILBERG.COM merely indicates the location on the Internet where applicant's Web site appears. It does not separately identify applicant's legal services as such. *Cf. In re The Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986).

This is not to say that, if used appropriately, the asserted mark or portions thereof may not be trademarks or [service marks]. For example, if applicant's law firm name were, say, EILBERG.COM and were presented prominently on applicant's letterheads and business cards as the name under which applicant was rendering its legal services, then that mark may well be registrable.

49 USPQ2d at 1957.

The examining attorney must review the specimens in order to determine how the proposed mark is actually used. It is the perception of the ordinary customer that determines whether the asserted mark functions as a mark, not the applicant's intent, hope or expectation that it does so. *See In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960).

If the proposed mark is used in a way that would be perceived as nothing more than an Internet address where the applicant can be contacted, registration must be refused. Examples of a domain name used only as an Internet address include a domain name used in close proximity to language referring to the domain name as an address, or a

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domain name displayed merely as part of the information on how to contact the applicant.

Example: The mark is WWW.ABC.COM for on-line ordering services in the field of clothing. Specimens of use consisting of an advertisement that states “visit us on the web at www.ABC.com” do not show service mark use of the proposed mark.

Example: The mark is ABC.COM for financial consulting services. Specimens of use consisting of a business card that refers to the service and lists a phone number, fax number, and the domain name sought to be registered do not show service mark use of the proposed mark.

If the specimens of use fail to show the domain name used as a mark and the applicant seeks registration on the Principal Register, the examining attorney must refuse registration on the ground that the matter presented for registration does not function as a mark. The statutory bases for the refusals are §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, for trademarks; and §§1, 3 and 45 of the Act, 15 U.S.C. §§1051, 1053 and 1127, for service marks.

If the applicant seeks registration on the Supplemental Register, the examining attorney must refuse registration under Trademark Act §23, 15 U.S.C. §1091.

1215.02(b) Advertising One’s Own Products or Services on the Internet is not a Service

Advertising one’s own products or services is not a service. *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970). See TMEP §§1301.01(a)(ii) and 1301.01(b)(i). Therefore, businesses that create a web site for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity. In examination, the issue usually arises when the applicant describes the activity as a registrable service, *e.g.*, “providing information about [a particular field],” but the specimens of use make it clear that the web site merely advertises the applicant’s own products or services. In this situation, the examining attorney must refuse registration because the mark is used to identify an activity that does not constitute a “service” within the meaning of the Trademark Act. Trademark Act §§1, 3 and 45, 15 U.S.C. §§1051, 1053 and 1127.

1215.02(c) Agreement of Mark on Drawing with Mark on Specimens of Use

In viewing a domain name mark (*e.g.*, ABC.COM or HTTP://WWW.ABC.COM), consumers look to the second level domain name for source identification, not to the top-level domain (TLD) or the terms “http://www.” or “www.” Therefore, it is usually acceptable to depict only the second level domain name on the drawing page, even if the specimens of use show a mark that includes the TLD or the terms “http://www.” or “www.” *Cf. Institut National des Appellations D’Origine v.*

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Vintners Int’l Co., Inc., 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992) (CHABLIS WITH A TWIST held to be registrable separately from CALIFORNIA CHABLIS WITH A TWIST as shown on labels); *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989) (refusal to register TINEL-LOCK based on specimens showing “TRO6AI-TINEL-LOCK-RING” reversed). *See also* 37 C.F.R. §§2.51(a)(1) and (b)(1), and TMEP §§807.14 *et. seq.*

Example: The specimens of use show the mark HTTP://WWW.ABC.COM. The applicant may elect to depict only the term “ABC” on the drawing page.

Sometimes the specimens of use fail to show the entire mark sought to be registered (*e.g.*, the drawing of the mark is HTTP://WWW.ABC.COM, but the specimens only show ABC). If the drawing of the mark includes a TLD, or the terms “http://www.,” or “www.,” the specimens of use must also show the mark used with those terms. Trademark Act §1(a)(3)(C), 15 U.S.C. §1051(a)(3)(C).

Example: If the drawing of the mark is ABC.COM, specimens of use that only show the term ABC are unacceptable.

See TMEP §§807.14(a) and 1215.08 through 1215.08(b) regarding material alteration.

1215.02(d) Marks Comprised Solely of TLDs for Domain Name Registry Services

If a mark is composed solely of a TLD for “domain name registry services” (*e.g.*, the services of registering .com domain names), registration should be refused under Trademark Act §§1, 3 and 45, 15 U.S.C. §§1051, 1053 and 1127, on the ground that the TLD would not be perceived as a mark. The examining attorney should include evidence from the NEXIS® database, the Internet, or other sources to show that the proposed mark is currently used as a TLD or is under consideration as a new TLD.

If the TLD merely describes the subject or user of the domain space, registration should be refused under Trademark Act §2(e)(1), 15 U.S.C. §2(e)(1), on the ground that the TLD is merely descriptive of the registry services.

1215.02(e) Intent-to-Use Applications

A refusal of registration on the ground that the matter presented for registration does not function as a mark relates to the manner in which the asserted mark is used. Generally, in an intent-to-use application, a mark that includes a domain name will not be refused on this ground until the applicant has submitted specimens of use with either an amendment to allege use under Trademark Act §1(c), or a statement of use under Trademark Act §1(d), 15 U.S.C. §1051(c) or (d). However, the examining attorney should include an advisory note in the first Office action that registration may be refused if the proposed mark, as used on the specimens, identifies only an Internet address. This is done strictly as a courtesy. If information regarding this

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possible ground for refusal is not provided to the applicant prior to the filing of the allegation of use, the Office is not precluded from refusing registration on this basis.

1215.03 Surnames

If a mark is composed of a surname and a TLD, the examining attorney must refuse registration because the mark is primarily merely a surname under Trademark Act §2(e)(4), 15 U.S.C. §1052(e)(4), absent a showing of acquired distinctiveness under Trademark Act §2(f), 15 U.S.C. §1052(f). A TLD has no trademark significance. If the primary significance of a term is that of a surname, adding a TLD to the surname does not alter the primary significance of the mark as a surname. *Cf. In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (C.C.P.A. 1953) (S. SEIDENBERG & CO'S. held primarily merely a surname); *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS for pharmaceutical products held primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname where "brasserie" is a generic term for applicant's restaurant services). *See also* TMEP §1211.01(b)(vi) regarding surnames combined with additional wording.

1215.04 Descriptiveness

If a proposed mark is composed of a merely descriptive term(s) combined with a TLD, the examining attorney should refuse registration under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. This applies to trademarks, service marks, collective marks and certification marks.

Example: The mark is SOFT.COM for facial tissues. The examining attorney must refuse registration under §2(e)(1).

Example: The mark is NATIONAL BOOK OUTLET.COM for retail book store services. The examining attorney must refuse registration under §2(e)(1).

The TLD will be perceived as part of an Internet address, and does not add source identifying significance to the composite mark. *Cf. In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998) (PATENT & TRADEMARK SERVICES INC. is merely descriptive of legal services in the field of intellectual property; the term "INC." merely indicates the type of entity that performs the services, and has no significance as a mark); *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988) (PAINT PRODUCTS CO. is no more registrable as a trademark for goods emanating from a company that sells paint products than it would be as a service mark for retail paint store services offered by such a company).

See also TMEP §1209.03(m).

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1215.05 Generic Refusals

If a mark is composed of a generic term(s) for the applicant's goods or services and a TLD, the examining attorney must refuse registration on the ground that the mark is generic and the TLD has no trademark significance. Marks comprised of generic terms combined with TLDs are not eligible for registration on the Supplemental Register, or on the Principal Register under Trademark Act §2(f), 15 U.S.C. §1052(f). This applies to trademarks, service marks, collective marks and certification marks.

Example: TURKEY.COM for frozen turkeys is unregistrable on either the Principal or Supplemental Register.

Example: BANK.COM for banking services is unregistrable on either the Principal or Supplemental Register.

See TMEP §1209.01(c)(i) regarding the test for establishing that a term is generic.

The examining attorney generally should not issue a refusal in an application for registration on the Principal Register on the ground that a mark is a generic name for the goods or services unless the applicant asserts that the mark has acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). Absent a claim of acquired distinctiveness, the examining attorney should issue a refusal on the ground that the mark is merely descriptive of the goods or services under §2(e)(1), 15 U.S.C. §1052(e)(1), and provide an advisory statement that the matter sought to be registered appears to be a generic name for the goods or services. See TMEP §1209.02.

See also TMEP §§1209.03(m).

1215.06 Marks Containing Geographical Matter

The examining attorney should examine marks containing geographic matter in the same manner that any mark containing geographic matter is examined. See generally TMEP §§1210 *et seq.* Depending on the manner in which it is used on or in connection with the goods or services, a proposed domain name mark containing a geographic term may be primarily geographically descriptive under §2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), primarily geographically deceptively misdescriptive under §2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), deceptive under 15 U.S.C. §1052(a), and/or merely descriptive or deceptively misdescriptive under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When a geographic term is used as a mark for services that are provided on the Internet, sometimes the geographic term describes the subject of the service rather than the geographic origin of the service. Usually this occurs when the mark is composed of a geographic term that describes the subject matter of information services (*e.g.*, NEW ORLEANS.COM for “providing vacation planning information about New Orleans, Louisiana by means of the global computer network”). In these

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cases, the examining attorney should refuse registration under §2(e)(1) because the mark is merely descriptive of the services. *See* TMEP §1210.02(d).

1215.07 Disclaimers

Trademark Act §6(a), 15 U.S.C. §1056(a), provides for the disclaimer of “an unregistrable component of a mark otherwise registrable.” The guidelines on disclaimer discussed in TMEP §§1213 *et seq.* apply to domain name mark applications.

If a composite mark includes a domain name composed of unregistrable matter (*e.g.*, a merely descriptive or generic term and a TLD), disclaimer is required.

If a disclaimer is required and the domain name includes a misspelled or telescoped word, the correct spelling must be disclaimed. *See* TMEP §§1213.05(a)(i) and 1213.08(c).

A compound term composed of arbitrary or suggestive matter combined with a “dot” and a TLD is considered unitary, and therefore no disclaimer of the TLD is required. *See* examples below and TMEP §§1213.05 *et seq.* regarding unitary marks.

<i>Mark</i>	<i>Disclaimer</i>
ABC BANK.COM	BANK.COM
ABC FEDERALBANK.COM	FEDERAL BANK.COM
ABC GROCERI STOR.COM	GROCERY STORE.COM
ABC.COM	no disclaimer
ABC.BANK.COM	no disclaimer
ABCBANK.COM	no disclaimer

1215.08 Material Alteration

Amendments may not be made to the drawing of the mark if the character of the mark is materially altered. 37 C.F.R. §2.72. In determining whether an amendment is a material alteration, the controlling question is always whether the new and old forms of the mark create essentially the same commercial impression. *See* TMEP §807.14(a).

1215.08(a) Adding or Deleting TLDs in Domain Name Marks

Generally, an applicant may add or delete a TLD to/from the drawing of a domain name mark (*e.g.*, COOPER amended to COPPER.COM, or COOPER.COM amended

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to COOPER) without materially altering the mark. A mark that includes a TLD will be perceived by the public as a domain name, while a mark without a TLD will not. However, the public recognizes that a TLD is a universally used part of an Internet address. As a result, the essence of a domain name mark is created by the second level domain name, not the TLD. The commercial impression created by the second-level domain name usually remains the same whether the TLD is present or not.

Example: Amending a mark from PETER to PETER.COM would *not* materially change the mark because the essence of both marks is still PETER, a person's name.

Similarly, substituting one TLD for another in a domain name mark, or adding or deleting a "dot" or "http://www." or "www." to a domain name mark is generally permitted.

Example: Amending a mark from ABC.ORG to ABC.COM would *not* materially change the mark because the essence of both marks is still ABC.

1215.08(b) Adding or Deleting TLDs in Other Marks

If a mark that is not used as an Internet domain name includes a TLD, adding or deleting the TLD may be a material alteration.

Example: Deleting the term .COM from the mark ".COM ☼" used on sports magazines would materially change the mark.

1215.09 Likelihood of Confusion

When analyzing whether a domain name mark is likely to cause confusion with another pending or registered mark, the examining attorney must consider the marks as a whole, but generally should accord little weight to the TLD portion of the mark. *See* TMEP §1207.01(b)(iii).

1215.10 Marks Containing the Phonetic Equivalent of a Top-Level Domain

Marks that contain the phonetic equivalent of a TLD (*e.g.*, ABC DOTCOM) are treated in the same manner as marks composed of a TLD. If a disclaimer is necessary, the disclaimer must be in the form of the TLD and not the phonetic equivalent. *See* TMEP §1213.08(c) regarding disclaimer of misspelled words.

Example: The mark is INEXPENSIVE RESTAURANTS DOT COM for providing information about restaurants by means of a global computer network. Registration should be refused because the mark is merely descriptive of the services under 15 U.S.C. §1052(e)(1).

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Example: The mark is ABC DOTCOM. The applicant must disclaim the TLD “.COM” rather than the phonetic equivalent “DOTCOM.”

1216 Effect of Applicant’s Prior Registrations

1216.01 Decisions Involving Prior Registrations Not Controlling

Trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Products Corp.*, 406 F.2d 1389, 160 USPQ 730 (C.C.P.A. 1969); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001); *In re Styleclick.com Inc.*, 58 USPQ2d 1523 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000).

Each case must be decided on its own facts. The Office is not bound by the decisions of the examiners who examined the applications for the applicant’s previously registered marks, based on different records. *See In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (incontestable registration of CASH MANAGEMENT ACCOUNT for credit card services did not automatically entitle applicant to registration of the same mark for broader financial services); *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that mark DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars); *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001) (applicant’s ownership of registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of “Best” in applications seeking registration of BEST! SUPPORT PLUS and BEST! SUPPORT PLUS PREMIER for the same services plus additional services); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994) (examining attorney not precluded from refusing registration of ULTRA for “gasoline, motor oil, automotive grease, general purpose grease, machine grease and gear oil,” even though applicant owned registrations of same mark for “motor oil” and “gasoline for use as automotive fuel, sold only in applicant’s automotive service stations”); *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992) (disclaimer of the unitary term “MEDICAL DISPOSABLES” required, notwithstanding applicant’s ownership of a prior registration in which a piecemeal disclaimer of the words “MEDICAL” and “DISPOSABLES” was permitted); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991) (likelihood of confusion found between applicant’s EL GALLO for fresh tomatoes and peppers and the previously registered mark ROOSTER for fresh citrus fruit, notwithstanding applicant’s ownership of an expired registration of the same mark for the same goods); *In re Lean Line, Inc.*, 229 USPQ 781 (TTAB 1986) (LEAN found merely descriptive of low-calorie foods, even though applicant had registered the term for other goods and services and a third party had registered the term “LEAN CUISINE” with no disclaimer); *In re McDonald’s Corp.*, 229 USPQ 555 (TTAB 1985) (Board not bound to allow registration of APPLE PIE TREE for restaurant services merely because applicant had succeeded in registering the character and

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name as trademarks and the character as a service mark); *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS incapable of distinguishing the services of arranging and conducting seminars in the field of business law, notwithstanding applicant's ownership of a registration on the Supplemental Register for the same mark for books, pamphlets and monographs); *In re Local Trademarks, Inc.*, 220 USPQ 728 (TTAB 1983) (refusal of registration on the ground that WHEN IT'S TIME TO ACT did not identify advertising services upheld; Board not bound to allow registration simply because applicant owned registrations bearing similar recitations of services); *In re Pilon*, 195 USPQ 178 (TTAB 1977) (title of chapter or section of book not registrable, even though applicant owned prior registrations of marks comprising chapter titles). *See also In re Wilson*, 57 USPQ2d 1863 (TTAB 2001) ("Reasoned decisionmaking" doctrine, which prohibits a federal agency from creating conflicting lines of precedent governing identical situations, did not entitle applicant to registration of PINE CONE BRAND for packaged fresh citrus fruit, even though Office issued registration for similar PINE CONE mark in 1933 despite then-existing registration for PINE CONE mark that was cited against applicant).

1216.02 Effect of "Incontestability" in *Ex Parte* Examination [R-1]

Section 15 of the Trademark Act, 15 U.S.C. §1065, provides a procedure by which a registrant's exclusive right to use a mark in commerce on or in connection with the goods or services covered by the registration can become incontestable. *See* TMEP §§1605 *et seq.* for information about the requirements for filing an affidavit of incontestability under §15.

In *Park 'N Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327 (1985), the Supreme Court held that the owner of a registered mark may rely on incontestability to enjoin infringement, and that an incontestable registration therefore cannot be challenged on the ground that the mark is merely descriptive.

In *In re American Sail Training Association*, 230 USPQ 879 (TTAB 1986), the Trademark Trial and Appeal Board held that an examining attorney could not require a disclaimer of "TALL SHIPS" in an application for registration of the mark RETURN OF THE TALL SHIPS, where the applicant owned an incontestable registration for the mark TALL SHIPS for the identical services. This would be a collateral attack on an incontestable registration. However, this applies only where both the marks and the goods or services are identical. In *American Sail Training*, the Board noted that the matter required to be disclaimed was "identical to the subject matter of applicant's incontestable registration," and that "the services described in applicant's application are identical to those recited in the prior incontestable registration." 230 USPQ at 880.

Ownership of an incontestable registration does *not* give the applicant a right to register the same mark for different goods or services, even if they are closely related to the goods or services in the incontestable registration. *See In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (applicant's

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ownership of incontestable registration of the word mark SAVE VENICE for newsletters, brochures and fundraising services did not preclude examining attorney from refusing registration of a composite mark consisting of the phrases THE VENICE COLLECTION and SAVE VENICE INC. with an image of the winged Lion of St. Mark for different goods; “[a] registered mark is incontestable only in the form registered and for the goods or services claimed.”); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (incontestable registration of CASH MANAGEMENT ACCOUNT for credit card services did not automatically entitle applicant to registration of the same mark for broader financial services); *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 7 n. 5 (Fed. Cir. 1985) (incontestable status of registration for one speaker design did not establish non-functionality of another speaker design with shared feature); *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that mark DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars); *In re Best Software Inc.*, ___ USPQ2d ___, ___ Serial No. 75/496,422 (TTAB April 3, 2002) (applicant’s ownership of incontestable registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of “BEST” in applications seeking registration of BEST! IMPERATIV HRMS “for goods which, although similar, are nevertheless somewhat different”); *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001) (applicant’s ownership of incontestable registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of “BEST” in applications seeking registration of BEST! SUPPORT PLUS and BEST! SUPPORT PLUS PREMIER for the same services plus additional services); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), *aff’d*, 883 F.2d 1026 (Fed. Cir. 1989) (examining attorney could properly refuse registration on the ground that a mark is primarily merely a surname even if applicant owned incontestable registration of same mark for unrelated goods); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986) (examining attorney could refuse registration of the mark BANK OF AMERICA for computerized financial data processing services under §§2(e)(1) and 2(e)(2), despite applicant’s ownership of incontestable registrations of the same mark for related services).

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Res Judicata

A prior adjudication against an applicant, in connection with the same mark, on the basis of the same facts and issues, constitutes a proper ground of refusal as *res judicata*. Prior adjudications include decisions of the Trademark Trial and Appeal Board or any of the reviewing courts. The refusal is appropriate only after the time for further court review has expired and no such review has been sought or, if sought, the review action has been terminated. However, the applicant may not be precluded under the doctrine of *res judicata* from again seeking registration if the facts and circumstances have changed since the adverse decision. See *In re Honeywell Inc.*, 8 USPQ2d 1600 (TTAB 1988); *In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988); *In re Minnetonka, Inc.*, 3 USPQ2d 1711 (TTAB 1987).

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When refusing registration on the basis of *res judicata*, the examining attorney also must raise all other issues that are pertinent to the application.

When all matters other than the question of *res judicata* have been attended to, but review action on the prior adjudication is not yet terminated, the examining attorney may suspend action on the application pending termination. *See* TMEP §716.02(d).